

# DIGEST OF DECISIONS

OF

LAW AND PRACTICE

IN THE

PATENT OFFICE

AND THE

UNITED STATES AND STATE COURTS

IN

PATENTS, TRADE-MARKS, COPYRIGHTS, AND LABELS

1886-1898

BY

AMOS W. HART

OF THE BAR OF THE DISTRICT OF COLUMBIA

CHICAGO  
CALLAGHAN AND COMPANY  
1898

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## PREFACE.

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Although previous digests have been restricted to the decisions of the Commissioner of Patents alone, or to those of the courts alone, the expediency and even desirability of covering both in one volume, and under the same titles, as in the present case, is believed to need neither argument nor apology.

The period covered is a most interesting and important one in patent, trademark, and copyright practice.

The sources chiefly drawn upon have been the Official Gazette, the MS. or unpublished decisions of the Commissioner of Patents, and the Federal Reporter; but numerous references have been made to other authorities.

With the multiplicity of decisions cited and subjects considered therein, the simple classifications of former digests have been quite out of the question. If the present classifications shall seem at first somewhat complex and strange here and there, it should be considered as due in large measure to the necessity of the case. It is hoped the median line has been followed, in at least the majority of instances, between the inclusion of too many syllabi under one title, and the division of the same under too many titles.

The critical and historical notes to be found under numerous titles and syllabi are believed to be a desirable innovation. In many cases they may serve to link former with present practice, and in some others to dispense with the necessity of more extended research.

A. W. H.

WASHINGTON, D. C.,  
May, 1898.

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# DIGEST OF DECISIONS.

## ABANDONMENT.

### I. OF APPLICATION.

### II. OF INVENTION, IN GENERAL.

### III. OF INVENTION, BY FAILURE TO CLAIM IT.

#### I. OF APPLICATION.

1. When an application has become abandoned by statutory limitation and it is shown to the satisfaction of the commissioner that both applicant and his attorney, acting in the utmost good faith, using such care and diligence as are generally used and observed by prudent and careful men in relation to their most important business, and relying upon the ordinary and trustworthy agencies usually employed in such cases, have unsuccessfully endeavored within the time of limitation to comply with a requirement of the office, the case should be reinstated. *Ex parte Pratt*, 39 O. G. 1549, C. D. 1887.

2. A trustworthy and reliable employee in an attorney's office is such an agency, and if unexpectedly, through his unforeseen neglect and omission to obey the instructions of his principal, there occurs a failure, it may be said to be "unavoidable" within the meaning of the statute, all the other conditions of good faith being present. *Id.*

3. The office, although not inclined to extend this freedom of construction, will not, except upon greater consideration, restrict it. *Id.*

4. Applicant having failed to prosecute his case within two years from the date of the last action by the office, and no definite action having been determined upon by him or his attorney within the time, and the two years' limit having expired without any attempt at definite action, *held*, that applicant's showing of unavoidable delay in prosecuting his application must cover the entire period of two years. *Ex parte Root*, 40 O. G. 811, C. D. 1887.

5. Under section 4894, which provides for the latter class of cases, an applicant who has

failed to prosecute his case for two years is permitted to revive it by establishing to the satisfaction of the commissioner of patents that the delay was unavoidable. *Ex parte Barnitz*, 41 O. G. 575, C. D. 1887.

6. The assignee requested postponement of official action until the application should be called up by him. *Held*, that the application must be considered as abandoned under the statute, the period of such suspension extending beyond two years. *Ex parte Norton*, 42 O. G. 296, C. D. 1888.

7. Amendments which do not remove objections or relieve the application from its condition as subject to appeal will not save the application from abandonment. *Ex parte Edison*, 45 O. G. 461, C. D. 1888.

8. Such amendments, if entered, call for no action on the part of the office, and do not change the status of the application. The application would still be in condition for appeal upon the claims which remained in the case. *Id.*

9. Such amendments should be accompanied by an appeal, and the *appeal* would constitute the proper action such as the condition of the application demanded. *Id.*

10. When an applicant, who is also patentee of an invention other than that involved in controversy, alludes in his patent to abandoned claims in a former application, the only effect that can be given to such reference is as evidence of continued interest in the subject-matter of the earlier application and of diligence in seeking to perfect and patent the invention; but such an allusion can have no effect whatever in that direction when the former application had been for nearly two years unprosecuted, and all the claims therein which had any relationship to his pending application had been deliberately stricken out and positively abandoned at the time the patent was issued. *Beach v. Fowler*, 48 O. G. 821, C. D. 1889.

11. A broad distinction is to be recognized between constructive abandonment of an ap-

plication and constructive abandonment of an invention. The former may exist, and frequently does exist, without involving the latter. *Ex parte Fowler and Fowler*, 49 O. G. 562, C. D. 1889.

12. Where it appeared that on the last day upon which an application could be prosecuted without forfeiture under Revised Statutes, section 4894, amendments apparently of no considerable importance were offered, including one or two formal corrections in the claims which had been required by the examiner, and that such amendments were made in good faith for the purpose of prosecuting the application, *held*, that the action, so far as it went, was a proper action, and there was not such utter failure to prosecute within the two years as would warrant a judgment forfeiting rights. *Ex parte Todd*, 49 O. G. 732, C. D. 1889.

13. Where an application is filed or deposited unaccompanied by the first government fee, and applicant seeks to pay said fee after the lapse of two years from such filing or depositing, *held*, that said fee must be paid within the limit of two years from the date of such filing and depositing, or in default thereof the application is to be regarded as abandoned, under section 4894 of the Revised Statutes, in the absence of facts showing that the delay was unavoidable. *Ex parte Fenno*, 52 O. G. 1665, C. D. 1890.

14. When an examiner makes a definite requirement of an applicant, with a suggestion as to other things that are desired, it is the requirement, and not the suggestion, that applicant must act on within two years in order to avoid abandonment. *Ex parte Hume*, 56 O. G. 123, C. D. 1891.

15. Applicant filed his application September 16, 1879, and after various amendments filed a substitute specification January 25, 1885. On February 13, 1885, the examiner required division, which requirement was not finally complied with until July 20, 1891, the only action between these dates consisting of objections to the requirements by the applicant and their reiteration by the office, the last letter from the office repeating requirements being of July 25, 1889. *Held*, that the examiner's letters must be taken as satisfying section 4894 of the Revised Statutes and as saving the case from abandonment. *Ex parte Hunter*, 56 O. G. 909, C. D. 1891.

16. Section 4894 of the Revised Statutes, requiring that an application shall be completed and prepared for examination within two years

after filing, gives ample time to the applicant, and public policy demands that this office shall consider it as exhausting the liberality which the law requires as regards forfeitures. *Ex parte Price*, 56 O. G. 1000, C. D. 1891.

17. To negative abandonment it is necessary for applicant to show that the delay for the whole period from the last official action to the filing of the petition was unavoidable. The mere failure of applicant's attorneys to notify him of his rights after the last official action and the alleged neglect on their part to prosecute the case are not sufficient excuses. *Ex parte Murray*, 56 O. G. 1060, C. D. 1891.

18. A petition for the revival of an abandoned application should aver facts showing that the delay for the whole period from the last official action to the filing of the petition was unavoidable. *Ex parte Edison*, 56 O. G. 1061, C. D. 1891.

19. A misunderstanding of the attorneys of the different parties in interest of an invention as to their duties is not sufficient to warrant a holding that a delay of over two years in the prosecution of a case was unavoidable. *Ex parte Macphail*, 56 O. G. 1062, C. D. 1891.

20. W. filed an application in 1884, which became abandoned November 17, 1887, by reason of two years' lack of prosecution. In March, 1887, he had reduced the improvement to practice in public, and in January, 1889, his present application was filed. *Held*, that the reduction to practice before the abandonment of the first application and the filing of the second application within two years thereafter saved his rights from dedication to the public. *Witherow v. Robert*, 59 O. G. 787, C. D. 1892.

21. Where an applicant has delayed four years to meet an office requirement and seeks a revival of his abandoned application, ill health and financial reverses covering only the first year of his neglect do not form a sufficient excuse. *Ex parte Clarke*, 61 O. G. 286, C. D. 1892.

22. Where an applicant allowed two years to lapse without response to an office action, and his application thereby became abandoned, and he subsequently moved a revival of it on the ground of error on the part of the examiner in not originally holding his claims patentable, *held*, that a possible error by the examiner does not cure the applicant's own laches, and, it not appearing that the delay was unavoidable, the motion must be denied. *Ex parte Hien*, 62 O. G. 316, C. D. 1893.

23. The two years within which the law re-

quires an inventor to act if he would save his invention from abandonment relate to a *completed* invention and have no reference to the conception and maturing of the invention. *Brungger v. Smith*, 62 O. G. 1513, C. D. 1893.

24. There is a material difference between the abandonment of an invention and the abandonment of an application for letters patent thereon by failure to comply with section 4894 of the Revised Statutes. The first gives the invention to the public, and, once done, the act is irretrievable; but, besides the power conferred upon the commissioner of patents to relieve an applicant from an abandonment of his application under the statute, a new application may be filed for the invention so long as the invention itself has not been abandoned. *\*Western Electric Co. v. Sperry Electric Co.*, 65 O. G. 597, C. D. 1893.

25. Where after final rejection the applicant replies that the last action of the office is not understood, *held*, that such response is not such as the condition of the case requires. The office will not scrutinize the record to find a way of saving an application from abandonment that has already been pending for more than eleven years, especially where the art during that period has rapidly developed and where the grant of a patent upon claims now in the case might be a menace to meritorious and more diligent inventors. *Ex parte Hunter*, 66 O. G. 1449, C. D. 1894.

26. Where it appears that at no time while the case has been before the office has it been placed by the examiner in condition for appeal to the examiners-in-chief upon its merits, *held*, that although the action of the appellant had been irregular the case has not become abandoned under second paragraph of rule 171. *Ex parte Blessing*, 71 O. G. 1027, C. D. 1895.

27. The fact that an inventor is dead and that his executor has not asserted his rights does not deprive an application of standing before the office. It cannot be considered abandoned until the expiration of the time allowed by law for amendments. *Decker v. Loosley*, 77 O. G. 2140, C. D. 1896.

28. Re-issue cases are abandoned after two years of inactivity, like other cases, by operation of section 4894. (*Ex parte Galusha*, C. D. 1873, 55, overruled.) *Ex parte Messinger*, 78 O. G. 1903, C. D. 1897.

29. Where a letter of abandonment not containing the consent of the assignee is accepted upon the representation that it was impossible to communicate with such assignee and obtain

his consent, but where the assignee afterward appears and objects to the abandonment, *held*, that the abandonment must be considered void and of no effect. *Ex parte Weidemann*, 81 O. G. 2245, C. D. 1897.

30. The tacitly favorable action of one examiner upon a question of abandonment should at least be persuasive upon his successor. *Ex parte Burson*, 81 O. G. 2246, C. D. 1897.

## II. OF INVENTION, IN GENERAL.

31. The law governing the questions of dedication or abandonment of a patented invention is that in force at the date of the application for the original patent. *\*Beedle v. Bennett*, 39 O. G. 1326, C. D. 1887.

32. A delay of more than two years in making application for a patent after an experimental use by the inventor of the particular invention will, under certain circumstances, rebut presumptions of dedication or abandonment which might arise under the law in force at the time of the application. *\*Id.*

33. The process was invented in 1877. An application for patent was filed some four years later. *Held*, the invention was not abandoned by the delay. *\*United States Electric Lighting Co. v. Consolidated Electric Light Co.*, 33 Fed. Rep. 869 (1888).

34. The fact of the abandonment of the manufacture prior to the date of the complainant's invention of asphalt blocks composed of a composition containing the same ingredients as the alleged infringing blocks, presumably because the blocks were not a commercial success, proves nothing, it not appearing that the composition of matter produced by the practice of the complainant's process had ever been tested to prove its possession of new or useful qualities which similar compositions had not before possessed. *\*Van Camp v. Maryland Pavement Co.*, 43 O. G. 884, C. D. 1888.

35. An invention may exist in a state of conception or experiment, or in a state of completion and reduction to practice. In its former state it may be abandoned; but whether abandoned or not the subject is not taken out of the field of invention so as to prevent other inventors pursuing the same invention. When, however, the completed invention, reduced to practice, subject of knowledge and use, is abandoned by the inventor, whether before or after patent, it is abandoned to the public and is no longer the subject of new or original invention. *\*Webster v. Sanford*, 44 O. G. 567, C. D. 1888.

36. It is not to be conceded that the inventions represented in the abandoned applications of the patent office are the property of the public. Until the invention has been two years in public use or on sale the inventor has lost no part of his inchoate property in his invention, either through failure to complete his application or to prosecute his completed application within the period of two years prescribed by the Revised Statutes, section 4894. *Ex parte Fowler & Fowler*, 49 O. G. 562, C. D. 1889.

37. Abandonment is never presumed, but must always be strictly proved. *Clark v. Broad*, 57 O. G. 1426, C. D. 1891.

38. Where the first form of a machine was never put into use by reason of being defective, and there was a delay of ten years, largely due to pecuniary reasons, before a working machine was completed, these facts do not show abandonment. *\*Shaw Stocking Co. v. Pearson*, 58 O. G. 948, C. D. 1892.

39. The establishment of abandonment or of two years' public use requires proof so clear as to put the matter beyond all reasonable doubt. *Bury v. Thompson*, 58 O. G. 1255, C. D. 1892.

40. Where an inventor had forgotten an invention or laid it aside as worthless—abandoned it—he had the right to take it up again and proceed as if he had then first made the discovery, so long as its abandonment was unknown to the public. *\*Western Electric Co. v. Sperry Electric Co.*, 65 O. G. 597, C. D. 1893.

41. Before applying for the patent, Hall had experimented with a carbon anode; but in his application as first filed, he recited that there were certain disadvantages in its use, and it was not claimed by him until after priority of invention of the process had been awarded him in an interference with an application in which the carbon anode had been included. *Held*, that this was not an abandonment of the carbon anode to the public. *\*Pittsburgh Reduction Co. v. Cowles Electric Smelting & Aluminum Co.*, 69 O. G. 789, C. D. 1894.

42. Where T. reduced the invention to practice in 1886, successfully tested it, then laid it aside, filed an application therefor in the same year, which application his attorney permitted to become abandoned without his consent, and in 1893, after learning that another party had an application pending for the same subject-matter, filed another application therefor, *held* not to constitute abandonment of the invention. *Thomson v. Priest, v. Wetmore*, 71 O. G. 1769, C. D. 1895.

43. Where it appeared that the device had never been manufactured for sale and use, but had been abandoned, *held*, that the device was not patentable, and a patent granted after previous rejection of the application, and only granted to give applicant the benefit of a doubt, was invalid. *\*Carter Machine Co. v. P. H. Hanes & Co.*, 74 O. G. 1277, C. D. 1896.

44. Delay in applying for a patent after an invention is made will not constitute abandonment where the inventor has used reasonable diligence to perfect the invention and avail himself of its benefits, and there is no general standard by which such diligence is to be established; but it must be reasonable under all the circumstances of the particular case. The character of the invention; the health, the means, the liberty of the inventor; his occupation upon kindred or subordinate inventions,—are proper subjects for consideration. Such reasonable diligence does not involve uninterrupted effort nor the concentration of his entire energies upon the single enterprise. *\*Von Schmidt v. Bowers*, 80 O. G. 347, C. D. 1897.

### III. OF INVENTION, BY FAILURE TO CLAIM IT.

45. Campbell's acquiescence for nine or ten years in Hartshorn's original claim is regarded as an abandonment by him of any right to such claim, and he cannot resume the same. It is no answer to this view that the invention was not dedicated to the public by Campbell because it was covered in the interim by Hartshorn's claim, since Hartshorn never had a right to the claim. As Campbell had the right to an interference with Hartshorn when the original applications were pending and did not avail himself of that right, but acquiesced in the claim of Hartshorn, he cannot afterward claim that which he voluntarily abandoned. *\*Hartshorn v. Saginaw Barrel Co.*, 38 O. G. 540, C. D. 1887.

46. A part of an invention described, but not claimed, in a patent is virtually abandoned and dedicated to public use. *\*Eames v. Andrews*, 39 O. G. 1319, C. D. 1887.

47. The presumption of dedication to the public may be rebutted by a reservation of the right to apply for the unclaimed features in a second application or by filing a subsequent application. *Ex parte Roberts*, 40 O. G. 573, C. D. 1887.

48. The law conclusively infers from the issuance of a patent that the inventor dedicated to the public the unclaimed features of the invention. *Id.*

49. Description of a process in an application for a machine patent does not constitute an abandonment or dedication to the public of such process so as to estop the inventor from subsequently obtaining a patent for the process if applied for in two years. \**Eastern Paper Bag Co. v. Standard Paper Bag Co.*, 41 O. G. 231, C. D. 1887.

50. In the absence of evidence of any attempt to secure by the original patent the inventions covered by the first eight claims of the re-issue, these inventions must be regarded as abandoned or waived, so far as the re-issue in question is concerned, subject, however, to the right to have made a new application for a patent to cover them. \**Parker & Whipple Co. v. Yale Clock Co.*, 41 O. G. 811, C. D. 1887.

51. Although the patent may show features which were patentable, and which, if properly patented, would render the defendants liable as infringers, such matters are abandoned to the public by the act of the patentee in accepting a claim which fails to comprehend the same. \**Toepfer v. Goetz*, 41 O. G. 933, C. D. 1887.

52. The respondent contended that a certain contrivance, for which letters patent No. 269,480 were granted, was shown in a prior patent to the same patentee. *Held*, it was not clear that this contrivance was shown in the prior patent. *Held*, following *McMillan v. Rees*, 17 O. G. 1222, 1 Fed. Rep. 722, even if this contrivance were shown in the prior patent, that this did not constitute a dedication to the public. \**Vulcanite Paving Co. v. American Artificial Stone Pavement Co.*, 42 O. G. 828, C. D. 1888.

53. Description of a process in an application for a machine patent does not constitute an abandonment or dedication to the public of such process so as to estop the inventor from subsequently obtaining a patent for the process if applied for within two years from the date of the machine patent. \**Eastern Paper Bag Co. v. Nixon*, 45 O. G. 1571, C. D. 1888.

54. If an applicant should take out his patent for the machine without defining or claiming his process, he probably would unconsciously dedicate the process to the public. *Ex parte Young*, 46 O. G. 1635, C. D. 1889.

55. A patentee who shows but does not claim a certain invention which is distinct and separate from that claimed in his prior patent, and which could not have been prosecuted in that

application and ought not to have been shown in such patent, does not necessarily dedicate such unclaimed invention to the public. *Ex parte Johnston*, 46 O. G. 1641, C. D. 1889.

56. Where the invention described and not claimed in a prior patent to the same inventors is absolutely independent of the invention actually claimed in the first patent, there can be no presumption of dedication from the failure to make reservation or to file a concurrent application. *Ex parte Mullen and Mullen*, 50 O. G. 837, C. D. 1890.

57. A prior patent granted to applicants for certain details in the construction of old and well-known grain-drills, the claims of which were based upon a feed-regulating device which was special to the structure shown and described, *held* to be no bar to a subsequent application for an improvement in grain-drill teeth, which subject-matter was disclosed but not claimed in said prior patent, for the reason that the two inventions were independent, and hence there was no dedication from failure to claim such improvement. *Id.*

58. Where the invention described and not claimed in a prior patent to the same inventor might have been lawfully claimed in the first patent, there is a presumption of dedication from the failure to make reservation or to file a concurrent application. *Ex parte Beggs*, 50 O. G. 1130, C. D. 1890.

59. Where applicant sought in his present application to cover matter shown and described in a patent previously granted to himself and which might have been lawfully claimed therein, and attempted to justify his present application on the ground that it was a continuation of an abandoned application filed earlier, but pending concurrently with the application upon which the patent issued, and it appeared that in said patent he alluded to the earlier application and stated that it was his intention not to abandon any rights therein asserted, and it further appeared that the subject-matter of the present application could not have been claimed in the said abandoned application, *held*, that the prior patent was a bar to the present application, but otherwise if the matter shown and described but not claimed in the patent had been claimed in the earlier application. *Id.*

60. *Held*, the delay of a month and a half between the issue of applicant's patent and the filing of a new application by him for matter shown but not claimed in the patent did not amount to abandonment of the invention. *Ex*

parte Scott, 50 MS. D., May, 1892 (Simonds, Com'r).

61. It is the duty of the office to lean toward the side of liberality when strict construction works a forfeiture. *Id.*

62. The mere disclosure of a thing in an application raises no presumption that the applicant is the inventor of the thing disclosed but not claimed. *Van Depoele v. Daft*, 58 O. G. 520, C. D. 1892.

63. Where an applicant for a patent already has a prior patent three and a half years old which fully describes the invention claimed in the subsequent application, but does not claim it or make any reservation thereof, *held* to constitute abandonment. *Zipernowsky v. Edison*, 58 O. G. 803, C. D. 1892.

64. When an applicant claims an improvement which is shown but not claimed in his prior patent, and the application was pending before the patent issued, the office is not justified by existing court decisions in finding that the disclosure in the patent bars the claim in the application. *Rennyson v. Merritt*, 58 O. G. 1415, C. D. 1892.

65. Where the patent in suit described a composition of matter and claimed only a sheet of material or fabric coated with such composition, *held*, that the composition must be regarded as disclaimed and as being public property and that there was no invention in applying it to paper, as claimed. \**Underwood v. Gerber*, 63 O. G. 1063, C. D. 1893.

66. An applicant is estopped now reviving a claim after having canceled the same claim ten years before in an application that was patented. *Ex parte Flomerfeldt*, 59 MS. D. 57, March, 1896 (Seymour, Com'r).

67. Failure to claim or suggest an alleged invention is sufficient to place evidence as to its prior use either in the rule of abandoned experiments or within the requirement of proof beyond a reasonable doubt. \**A. B. Dick Co. v. Henry*, 75 O. G. 1204, C. D. 1896.

68. If at the date of the issue of a patent the patentee has another application pending which describes and claims what he describes, but does not claim in the patent issued, the presumption of dedication to the public does not arise. \**Independent Electric Co. v. Jeffrey Mfg. Co.*, 78 O. G. 797, C. D. 1897.

#### ABANDONED EXPERIMENTS.

1. It appearing that Dr. Cushman did, with the aid of others, in 1851, construct a device

containing magnetic coils substantially identical in principle, construction and working with the Bell telephone, through which he transmitted articulate sounds short distances, but that the transmission was faint, the words difficult to hear, and the attempts to talk through it often failures; that the proof of its operation at a distance greater than the ordinary acoustic telephone would carry depended on the uncorroborated testimony of Dr. C.; that the device was set up in Racine, Wis., in a public place, where any one could use it, but that it attracted no attention, nor did it suggest to any one its practical value; that in 1854 and 1855 attempts were made to improve it without substantial success; that it was exhibited in 1867 to several wealthy and intelligent men with a view to patent and render it available, but the experiments were unsatisfactory; that the device was given to an electrician to experiment with and patent, but he died, and the device cannot now be found; that no contemporaneous newspaper accounts appear of these experiments, and that it was not until after Dr. C. had seen the Bell telephone operate and become familiar with it did he give it out that he was the first inventor,—*held*, that what was done by Dr. C. must be treated as an abandoned experiment. \**American Bell Telephone Co. v. American Cushman Telephone Co.*, 45 O. G. 1191, C. D. 1888.

2. A machine which had operated at least once to accomplish its desired result, and subsequently was worked satisfactorily several times without change, is not an abandoned experiment, although several changes not relating to the main operating parts of the machine were suggested, and the use of the machine was discontinued after it had once accomplished its desired result, because the persons using it had turned their attention to other matters. \**Bromley Bros. Carpet Factory v. Stewart*, 61 O. G. 1481, C. D. 1892.

3. Where from the date of the first application until the date of the application for the invention in its final form the machine on which both applications were based was preserved and in use, either partly or wholly dismantled or entirely assembled for the purpose of obtaining a patent, and with a view to its mechanical perfection for actual commercial use, *held*, that such machine does not present the case of a dismantled and abandoned experiment recalled to memory by the successful effort of a later inventor. \**Coffee v. Guerrant*, 63 O. G. 279, C. D. 1894.

4. The witnesses' efforts must be relegated to

that class of unsuccessful and abandoned experiments which, as we have repeatedly held, do not affect the validity of a subsequent patent. (Corn Planter Patent, 6 O. G. 392, 23 Wall. 181, 211; Coffin v. Ogden, 5 O. G. 270, 18 Wall. 120, 124.) \*Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

5. Where B. in 1883 set up in his boiler-room a fire-extinguisher substantially embodying the invention in issue and successfully used the same, *held*, that the invention was complete at the close of that test and that his subsequent search for still better expansible compounds for his tubes did not convert his successful test into an abandoned experiment. Buell v. Shaffer, 71 O. G. 1453, C. D. 1895.

6. Inoperative devices are frequently set up as anticipations; but they are usually such as have proven to be so far failures that the inventor has not taken out patents for them, and are resuscitated for the purpose of showing that other machines similar to the one patented have been invented before. \*Dashiell v. Grosvenor, 75 O. G. 507, C. D. 1896.

7. The fact that only one device was made and operated for only a short time and that it was then laid aside and not used again until other parties were making and advertising the device raises the presumption that such use was merely experimental and that what was done amounted to no more than an abandoned experiment. \*Wurts v. Harrington, 79 O. G. 337, C. D. 1897.

8. The fact that in a room ordinarily used to contain complete devices ready for the market there was exhibited a certain device is not conclusive proof that such device was complete and on sale. \*Id.

(See Seymour v. Osborn, 20 Wall. 353; Corn Planter Patent, 6 O. G. 392, 23 Wall. 181.)

## AFFIDAVITS.

(See DEPOSITIONS; OATH.)

### I. IN GENERAL.

### II. TO OVERCOME REFERENCES.

### III. TO OBTAIN INTERFERENCE.

### IV. BEFORE NOTARIES AND CONSULAR OFFICERS.

#### I. IN GENERAL.

1. Where it appeared that certain affidavits which had been filed in a case had been lost or mislaid, *held*, that copies might be received

and placed on record. Ex parte Palmer, 44 MS. D. (2 G. W. D.), Sept., 1890 (Fisher, Acting Com'r).

2. Affidavits alleging public use or sale of an invention should, by machine, model, or drawing, clearly show what the thing alleged to be in public use or on sale was, and the allegations should be as to specific acts, leaving the office to determine the question whether they establish a public use or sale under the statute. Ex parte Shettler, 60 O. G. 158, C. D. 1892.

## II. TO OVERCOME REFERENCES.

3. Where applicant requested that he be put into interference with a certain unexpired domestic patent upon which he had not been rejected, and it appeared that he had been rejected upon a prior foreign patent granted to the same person for the same invention covered by the domestic patent, and had filed an affidavit stating that the invention was made before the foreign patent, without reciting the facts upon which he relied to prove that he antedated the foreign patent, *held*, that the affidavit was not such as was required by rule 75 to overcome the foreign reference, and the request must be denied. *Held* further, that rule 94 (2) was not applicable to such a case. Ex parte Boyer, 49 O. G. 1985, C. D. 1889.

4. An applicant cannot be held to have complied with the requirements of rule 75 when he merely avers that he conceived the invention and disclosed it to others, without stating by what agency the disclosure was made and the details of which it consisted. The mere statement that he disclosed the invention is of no avail, either to constitute evidence of disclosure or to impart sufficiency to a statement of facts in themselves inadequate. Ex parte Donovan, 52 O. G. 309, C. D. 1890.

5. When claims are rejected upon references and facts are submitted tending to show completed invention by the applicant at an earlier date than the references, the question of novelty is presented. The office says that a patent should not be granted for want of novelty, and this applicant denies and presents the proof upon which he relies. Upon such a question applicant is entitled to the judgment in turn of the examiners-in-chief, the commissioner, and the supreme court of the District of Columbia. No sound principle can justify the practice of deflecting that particular inquiry from the main current of discussion and decision relat-



ing to the merits of the application, which lawfully terminates only with the decree of the supreme court of the District. *Id.*

6. If the examiner be of opinion that the affidavit is insufficient, he should reject for such reason. No appeal, however, should be taken until final rejection has been had upon all the grounds relied upon by the examiner for refusing patent. *Id.*

7. If sketches or models of the invention were made, applicant should so state, and produce and describe them; if made and lost and their contents remembered, they should be reproduced and furnished in place of the originals. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures were made, the witness should state as nearly as possible the language used in imparting knowledge of the invention to others. *Id.*

(See *Pullman's Palace Car Co. v. Boston & Albany R. R. Co.*, 53 O. G. 1255, C. D. 1890. Also *Deering v. Winona Harvester Works*, 69 O. G. 1641, C. D. 1894.)

8. A patent granted subsequently to applicant's filing date, but on an application filed prior thereto, which patent shows and describes but does not claim the invention, is a proper reference, and the applicant should be required, under rule 75, to overcome by affidavit the presumption of prior invention which the office always recognizes in favor of the earlier application and of the patent granted thereon, even though the same be issued subsequently to the filing date of the second application. *Ex parte Eddleblute*, 52 O. G. 751, C. D. 1890.

9. When an application has been rejected on reference to a patent showing and describing but not claiming the invention under consideration, the applicant should not be required to file an affidavit under rule 75 when his application was in the office prior to the filing of the application upon which such patent was granted. *Ex parte Bonna*, 52 O. G. 751, C. D. 1890.

10. Where certain claims stood rejected on a prior English patent, and the applicant, without admitting or denying the pertinency of the reference, filed an affidavit in supposed compliance with rule 75, and the affidavit stated, among other things, that the applicant, prior to a certain date, had made drawings which would enable a skilled mechanic to make an operative machine, and that, prior to the same date, he disclosed the drawings to others, and the examiner held that the affidavit was not

sufficient in itself to overcome the reference, and that the drawings should be filed, as should affidavits of the people to whom the drawings were disclosed, properly identifying them, *held*, that the action of the examiner should be sustained so far as it related to the drawings. *Ex parte Hurlbut*, 52 O. G. 1062, C. D. 1890.

11. *Held* further, that the requirement that the affidavits of the persons to whom the drawings were disclosed should be furnished must be complied with. *Id.*

12. In all such cases the examiner's discretion must be exercised, care being taken on the one hand not to be too exacting toward the applicant, nor, on the other hand, to excuse the applicant from presenting the facts upon which he relies to show completed invention in this country before the date of reference. *Id.*

13. Rule 75 provides that on filing the proper antedating oath the unexpired patent shall cease to be a bar. *Reed v. Landman*, 55 O. G. 275, C. D. 1891.

14. Where it was necessary to introduce an affidavit in an *ex parte* case under rule 75, the attorney set up great difficulty and hardship in obtaining applicant's signature to the necessary papers, and offered the deposition of the applicant taken in prior interference proceedings and alleged to cover the matter in controversy; *held* admissible as an affidavit under the rule. *Ex parte Keller*, 61 O. G. 1790, C. D. 1892.

15. A deposition taken in an interference proceeding is an affidavit within the meaning of rule 75, and the examiner should receive it as such. The question of its sufficiency is another matter. *Id.*

16. An oath made during pendency of application that the invention was made prior to date of a British patent, *held* sufficient to sustain patent on said invention, *Deering v. Winona Harvester Works*, 69 O. G. 1641, C. D. 1894.

17. An affidavit which seeks to overcome a foreign patent cited as a reference must make a showing of facts, as required by rule 75, that the invention was completed in this country before the date of the foreign patent. *Ex parte Grosselin*, 76 O. G. 1573, C. D. 1896.

18. The affidavit required by rule 75 does not necessarily mean the same affidavit as that required by rule 76. The latter rule is a general one, and the affidavits therein referred to include not only the special affidavit provided for by rule 75, but all other affidavits "supporting or traversing references or objections." *Id.*

19. In an affidavit under rule 75, total omission of a statement of facts as to the time and circumstances of the conception of the invention and its development to completion prior to the filing date of the reference is fatal. \*Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

20. An affidavit under rule 75 may be aided and supplemented by a preliminary statement made in an interference in which the application is involved. Schmertz v. Appert, 77 O. G. 1784, C. D. 1896.

21. An affidavit under rule 75 should contain not merely the deponent's conclusion that he had invented prior to the time of the reference sought to be overcome, but should state the facts supporting such conclusion. Id.

22. An affiant under rule 75, when his application becomes involved in interference, is entitled to invoke the doctrine of priority of mere conception. Even though he can show evidence of nothing but mental acts prior to the date of the reference sought to be overcome, it is the duty of the office to consider whether his conception was sufficiently clear and distinct and whether under all the circumstances of the case his progress was marked by due diligence. This can only be done upon the full record of the case. Id.

### III. TO OBTAIN INTERFERENCE.

23. The affidavit required by paragraph 2 of rule 94 does not call for the showing of facts required by rule 75 and is merely an *ex parte* matter. The right to call for such showing is discretionary with the office. Ries v. Thomson, 57 O. G. 1598, C. D. 1891.

24. The affidavit required by paragraph 2 of rule 94 must identify the invention in controversy and state that affiant made it before the patentee's application was filed; but it does not call for a statement of facts showing date of invention. The right to call for such a showing is discretionary with the office. (Citing Ries v. Thomson, 57 O. G. 1598.) *Ex parte* Davis, 62 O. G. 1516, C. D. 1893.

25. Rule 94 applies to a case in which the rejection is based upon the very patent with which the interference is to be had in case a satisfactory affidavit is filed to overcome it as a reference. *Ex parte* Boyer, 49 O. G. 1985, C. D. 1889.

### IV. BEFORE NOTARIES AND CONSULAR OFFICERS.

26. A notary who is not authorized by the laws of his country to administer oaths or take

affidavits lacks the requisite authority to administer the oath required by Revised Statutes, section 4892. §Opinion of Attorney-General, 60 O. G. 1481, C. D. 1892.

27. A preliminary statement affirmed before a United States consul will not be stricken out merely because no venue or indication of the place where such affirmation was made appears save in the seal of the consulate impressed upon the paper. Frym v. Heilbrunner, 81 O. G. 2245, C. D. 1897.

28. The purpose of the venue is to show that the officer administering the affidavit acted within his jurisdiction. It will be presumed that he so acted in the absence of any showing to the contrary. This presumption is strengthened by his use of a consular seal. Id.

29. The usual test of the sufficiency of an affidavit as to the possibility of assigning perjury cannot be applied to a paper executed before a United States consul abroad when the latter cannot be brought within the jurisdiction of the federal court. Id.

## AMENDMENT.

- I. IN GENERAL.
- II. DELAY IN FILING.
- III. OF DRAWING.
- IV. ELECTION AND DIVISION.
- V. AFTER FINAL REJECTION.
- VI. NEW MATTER.
- VII. UPON RECOMMENDATION OF EXAMINERS-IN-CHIEF OR COMMISSIONER.

### I. IN GENERAL.

(See EXAMINATION OF APPLICATION; GENUS AND SPECIES.)

1. Amendments which do not remove objections nor relieve the application from its condition as subject to appeal call for no action on the part of the office and do not change the status of the application. *Ex parte* Edison, 45 O. G. 461, C. D. 1888.

2. Rule 133 applies to the whole original application and does not preclude an applicant from amending so as to cover every part or feature of the invention originally shown which might have been claimed when the application was filed. *Ex parte* Regan, 45 O. G. 589, C. D. 1888.

3. An amendment presented in good faith which does not respond to *every* requirement of the office may be entered to save an application from becoming abandoned, conditioned upon applicant's complying within a reasonable

time with *all* the requirements or taking his appeal therefrom. *Ex parte Sullivan*, 45 O. G. 709, C. D. 1888.

4. An amendment which was only in part responsive to the official action, but was apparently made in good faith, *held* sufficient to save application from abandonment. *Ex parte Todd*, 41 MS. D., Oct., 1889 (Mitchell, Com'r).

5. No requirement of amendment insisted upon as a condition precedent to further examination can be either legal or permissible which tends in the minutest degree to prevent the applicant from obtaining a full investigation of his rights on appeal. *Ex parte Rogers*, 49 O. G. 1361, C. D. 1889.

6. The substitution of the descriptive term "absorptive substance," after the original application was filed, for the original language "mechanically applied, porous, granular, spongy or equivalent lead," *held* not to invalidate the patent, since it did not change the invention. \**Brush Electric Co. v. Julien Electric Co.*, 41 Fed. Rep. 679 (1890).

7. If, as matter of language, the amended claim does not present the same idea or invention presented by the previous claim, an amendment has been made in matter of substance, and the applicant is entitled to a second rejection upon the amended claim. *Ex parte Griswold*, 50 O. G. 838, C. D. 1890.

8. Where the admission of an amendment would necessitate division the examiner should refuse to incorporate it; but where the departure from the claim originally presented is not such as to require division, the amendment should be incorporated and rejected. *Ex parte Bailey*, 52 O. G. 608, C. D. 1890.

9. Although the present practice permits the joinder in proper cases of apparatus and process, it places limitations upon amendments to applications for inventions of one class which seek to incorporate inventions of the other. *Ex parte Carpenter*, 47 MS. D. (3 G. W. D.), June, 1891 (Mitchell, Com'r).

10. Amendments, without new oaths, in correction or amplification by attorneys in the specification and claims upon which the patents were granted are allowable. Whether proposed amendments come within the scope of what is proper in that behalf rests largely in the discretion of the commissioner. \**Wirt v. Hicks*, 55 O. G. 867, C. D. 1891.

11. Where an inventor when filing his application entertains an idea as to the importance of a particular feature of operation of a device, but before the patent issues, without

changing the drawing or modifying the structure in the least, repudiates by amendment that idea, *held*, that he had a right to change the specification, even though he did so in view of a patent applied for and issued while his application was on file, so long as he did not change the invention. \**Western Electric Co. v. Sperry Electric Co.*, 65 O. G. 597, C. D. 1893.

12. Where claims are amended, the amendment may not be held as not involving a matter of substance merely because such amendment does not avoid the references. *Ex parte Pfeffer*, 66 O. G. 845, C. D. 1894.

13. When an application is amended by the assignees of the invention so as to change the word "cement" to "hydraulic cement," in a claim for a conduit for electric conductors, by such amendment, when the application was stated both originally and as amended to be for "an improvement in underground conduits for electric wires," the assignees did what they would have had a right to do in re-issue, and their act does not amount to a perversion of the application to a different invention. \**National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co.*, 75 O. G. 1361, C. D. 1896.

14. Where an amendment was presented canceling claims and amending others and the examiner admitted the amendment so far as it related to the cancellation of claims, but refused to admit that part relating to the amendment of claims, *held*, that such practice is incorrect and the examiner instructed to reinstate the claims canceled, so as to give applicant a chance to appeal on such claims if he chooses. An amendment should be either entered as an entirety or refused admission as an entirety. *Ex parte Stern*, 76 O. G. 1417, C. D. 1896.

## II. DELAY IN FILING.

15. Delay, especially if the amendment would operate to the prejudice of intermediate inventors, raises a presumption that the original application correctly set forth the scope of the invention then made, and that the additions or variations disclosed by the amendment are of late discovery. *Ex parte Lillie*, 53 O. G. 2041, C. D. 1890.

16. The question whether the process claim was seasonably presented is an executive one, and where that question is intended to be raised the examiner should refuse to incorporate and thus lay a basis for a petition to the commissioner. *Ex parte Perkins*, 55 O. G. 189, C. D. 1891.

17. What is unreasonable delay in filing an application after making oath to it must be decided by the circumstances of each particular case. A delay of six months held unreasonable in the case of a party residing in Massachusetts. *Ex parte Lovejoy*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

### III. OF DRAWINGS.

(See DRAWINGS.)

18. The drawing filed with an application is one of its most important and essential parts. It becomes a permanent record in the office, and no one has authority to change any of its features by erasure or otherwise mutilating the same. Such practice is violative of every principle applicable to public records. *Ex parte Wharton*, 40 O. G. 917, C. D. 1887.

19. When a figure is added to an original drawing on file in the office, without direction or permission of the office, it must be erased or canceled, even though it has been added in good faith. *Ex parte Cordrey*, 48 O. G. 397, C. D. 1889.

20. The unauthorized addition of new figures to the drawings is a violation of the rules. *Ex parte Burt*, 49 O. G. 1986, C. D. 1889.

21. An attorney whose power has been revoked cannot have his name erased from the drawing of the application. *Ex parte McNulty*, 53 MS. D., Nov., 1893 (Fisher, Ass't Com'r).

22. If in the opinion of the examiner the proposed amendment to the drawing involves new matter, the changes in the drawing should not be allowed until the question has been finally determined. *Ex parte Ernest*, 76 O. G. 1417, C. D. 1896.

23. The drawings of two applications by the same applicants having become interchanged, *ordered* that the correction be made and a canceled sheet restored. *Ex parte McPherson & Laing*, 62 MS. D., Sept., 1897 (Greeley, Ass't Com'r).

(Regarding correction of drawing, see *Ex parte Snyder*, 22 O. G. 1985, C. D. 1882.)

### IV. ELECTION AND DIVISION.

(See DIVISION OF APPLICATION; DIVISIONAL APPLICATION.)

24. If claims for a genus and several species are presented, and a claim for one of the species is imperfect, it should be amended preliminary to requiring applicant to elect which of

the species he will retain. *Ex parte Johnson*, 40 O. G. 574, C. D. 1887.

25. To allow an applicant, after prosecuting to final action claims covering a certain species, or genus and species, to present an entirely new species and construction and ask consideration thereof in the same application, would be to reverse the well-settled rules and decisions of the office. (*Ex parte Eagle*, C. D. 1870, 137.) *Ex parte Wharton*, 40 O. G. 917, C. D. 1887.

26. When an applicant has made an election of the species he will prosecute and has presented his claim therefor, he is bound by that election, and can no more change his purpose, when he shall find the selected species anticipated or unpatentable, by selecting for prosecution another species than he can claim two or more species in one and the same application. *Id.*

27. When division of an application has been required and an amendment is presented which does not relieve the application from the objection raised, but simply reduces the number of the inventions, the examiner should refuse to admit it. *Ex parte Maxim*, 43 O. G. 506, C. D. 1888.

28. The only effect of such amendment, when admitted, is to narrow or limit the right of applicant in making election of the invention he desires to prosecute in his pending application. *Id.*

29. The objection that applicant has elected and cannot be permitted to further amend his case raises the question of what constitutes an election under these circumstances. *Held*, that such action does not put the applicant in the status of having made a final election from which he may not be allowed to recede, and applicant cannot be considered to have made a final election until he shall have complied with the requirement as to division and the office approves and accepts his action. *Id.*

30. An applicant who in his application has elected, through mistake or ignorance, to prosecute claims for one invention must exercise diligence in presenting his amendment correcting such error, and this before the application has been examined and rejected. *Ex parte Zabel*, 43 O. G. 627, C. D. 1888.

31. The examiner was right in refusing to admit an amendment covering a distinct and separate invention from that originally retained and prosecuted to rejection. To enter and consider such an amendment would be to permit

the applicant to secure examination of two distinct inventions for one fee. *Id.*

32. When an applicant is required to divide his application and eliminate from his specification so much thereof as relates to the invention which he elects to withdraw, the drawings of such invention should also be canceled, unless they are actually necessary to enable those skilled in the art to construct or operate the invention retained. It is not necessary that those skilled in the art should have made the exact subject of the invention, provided the general state of the art is such as to enable them to make it. *Ex parte Simonds*, 44 O. G. 449, C. D. 1888.

33. In such case it is enough for the applicant to state in a general way the manner and means in which his invention can be constructed. The requirement in this particular is necessary to prevent duplication of printing drawings and specifications, to save expense in the examination and preparation for issue, and in the various forms of publication and reproduction of the same; also to relieve the public of uncertainty as to the scope of the patent and its possible scope as a re-issued patent, and to protect the public in other directions. *Id.*

34. Under rule 42, when an application is divided the applicant will be required, so far as practicable, to cancel all matter in the original specification, descriptive or otherwise, which has been eliminated therefrom by division, and when the drawings in the case admit of canceling such eliminated subject-matter such cancellation of the drawings will be required. *Ex parte Hunter*, 59 O. G. 1922, C. D. 1892.

35. An applicant having originally presented only claims for a method and having prosecuted them to a final rejection and taken an appeal to the examiners-in-chief has made his election, and he cannot be permitted to thereafter substitute claims covering mechanism alleged to be capable of carrying out the method originally claimed, merely because they are believed to be patentable and do not include new matter. *Ex parte Eschner*, 63 O. G. 760, C. D. 1893.

## V. AFTER FINAL REJECTION.

(See REHEARING IN PATENT OFFICE; REOPENING CASES IN PATENT OFFICE; AMENDMENT, DELAY IN FILING.)

36. If an applicant cancels a claim, even though the requirement of the examiner which

led to such action was irregular and improper, he cannot re-assert it by amendment after its final rejection. *Ex parte Johnson*, 40 O. G. 574, C. D. 1887.

37. The decisions are numerous to the effect that an applicant cannot re-assert a claim after a final rejection which he had previously voluntarily erased. In such case he must file a new application. *Id.*

38. An applicant whose claims have been twice rejected and his case is in condition for appeal has no longer the right to amend as a matter of course. If he has elected to prosecute his claims to a final rejection by the tribunals below, before being permitted to have his case reopened for further amendment he must present a satisfactory showing to the office why the proposed claim was not originally or earlier introduced. *Ex parte Donovan*, 44 O. G. 698, C. D. 1888.

39. An applicant whose claim for a combination has been rejected has the right to appeal to the examiner-in-chief. If he should not avail himself of this right, but eliminate his claim for the combination, his drawings and specification should also be amended by canceling all reference thereto. The admission of a subsequent amendment restoring such a claim for the combination was erroneous and irregular. *Ex parte Gillette*, 44 O. G. 819, C. D. 1888.

40. When an amendment touching the merits is presented nearly two years after the case is in condition for appeal to the examiners-in-chief, and no showing or attempt at any showing whatever is made why the amendment was not presented earlier, a petition that the case be reopened and that applicant be heard upon the amendment must be denied. *Ex parte Cordrey*, 48 O. G. 397, C. D. 1889.

41. When, after material amendment, the examiner rejects, without giving new references or reasons, announcing such rejection to be final, and thereafter applicant offers another amendment, which the examiner refuses to consider, *held* that, the first amendment having been of a material character, applicant was entitled to a reconsideration, or was entitled to further amend, and, having elected the latter course, the examiner should have incorporated the amendment and considered the same. *Ex parte Griswold*, 50 O. G. 838, C. D. 1890.

42. Amendments canceling claims or presenting those rejected in better form for consideration on appeal may be admitted either before or after the appeal has been taken, without a showing why they were not earlier presented. *Ex parte Collis*, 50 O. G. 992, C. D. 1890.

43. An amended claim which does not differ materially from that finally rejected may be admitted for the purpose of appeal, but not otherwise, without further showing. The applicant's opinion may properly be consulted as to whether the proposed amended claim is couched in better form than the corresponding claim which has been rejected. *Id.*

44. An amendment upon the merits after final rejection should be accompanied by a verified showing of good and sufficient reasons why it was not earlier presented. *Ex parte Peloubet*, 56 O. G. 928, C. D. 1891.

45. The decision of the commissioner of patents in *McDonough v. Gray, v. Bell, v. Edison* (C. D. 1889, 9) was a final rejection of the McDonough application, and the examiner upheld in refusing to consider an amendment thereon subsequently offered by the applicant. *Ex parte McDonough*, 61 O. G. 1479, C. D. 1892.

46. Where a claim was finally rejected and at the same time the statement of invention was criticised as being too broad, the final rejection was premature and an amendment touching the merits may properly be admitted thereafter. *Ex parte Klaus*, 64 O. G. 299, C. D. 1893.

47. A final rejection, under rule 65 (six-months rule), is a date from which to reckon the two years the statute allows for action by the applicant. *Ex parte Van Norman*, 60 MS. D., Dec., 1896 (Fisher, Ass't Com'r).

48. An amendment presented seventeen months after a final rejection will not be admitted, even for the purpose of appeal, in the absence of a showing of unavoidable delay. *Ex parte Zimmerman*, 61 MS. D., June, 1897 (Greeley, Ass't Com'r).

49. Rule 28, established April 22, 1897, having been abolished, no showing is required why an amendment is not presented sooner. The applicant has two years from the last official action within which to amend. *Ex parte Fuller and McKinney*, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

50. The "six-months rules" having been abolished, the examiner is directed to receive an amendment filed more than six months after the last official action in the case. *Ex parte Adams*, 62 MS. D., Oct., 1897 (Butterworth, Com'r).

51. Where the claims of an application were rejected under old rule 65 and no action was taken until several months after the six months' limit of appeal under rule 134, *held*, that as the rules had been amended to permit applicants

two years within which to prosecute their cases, no showing is required as to why amendment was not earlier presented. *Ex parte MacMaster*, 80 O. G. 1475, C. D. 1897.

52. It is a well-settled principle of law that alterations of procedure or practice are always retrospective unless there be some good reason against it. In this case it seems that justice and equity demand that the applicant should have two years from the last official action in which to prosecute his case. *Id.*

53. Where a case was rejected on August 15, 1895, under rule 68, then in force, not on references, but on the ground that there had been intentional and unreasonable delays in prosecution, and such rejection made final under rule 65, *held*, that as these rules have been revoked and there has been no final rejection on references, the action under said rule 65 is set aside and the case opened for reconsideration. *Ex parte Higgins*, 80 O. G. 2037, C. D. 1897.

54. If an amendment, after rejection, inserting additional claims and requesting suspension of action upon other matters for stated reasons be admitted without question, it cannot be objected to at a subsequent period as insufficient to obviate abandonment. *Ex parte Burson*, 81 O. G. 2246, C. D. 1897.

## VI. NEW MATTER.

(The term "new matter" was first technically used in re-issue cases.)

55. In applications for inventions capable of illustration, rule 69 contemplates the existence of two things: *first*, a model or drawing; *second*, a specification. Amendments cannot be allowed which introduce new matter not found in either at the time of filing the application. Amendments proposing such new matter are a departure from the original invention and should be excluded. *Ex parte Wharton*, 40 O. G. 917, C. D. 1887.

56. Applicant has been required to amend his claim by erasing the words "or equivalents." Acquiescing in such requirement, applicant seeks to amend by inserting a description of a device asserted to be the equivalent of that originally described and shown. The examiner refused to enter the amendment, and applicant appeals to the commissioner. *Held*, that the action of the examiner was correct for the following reasons: The proposed amendment did not cure any defect in the original specification, for the invention therein described was complete and operative. It

added nothing which had been omitted, nor omitted anything which ought not to have been originally inserted. *Ex parte Johnson*, 43 O. G. 507, C. D. 1888.

57. The proposed amendment did not explain any matters set forth originally. It simply described in detail devices not originally disclosed, and broadened the scope of the claims which contained the parts of the newly-described devices which are said to be the equivalents of those originally set forth, but from which they differ in construction. *Id.*

58. The proposed amendment involved *new matter*, and would compel the office to pass upon the merits of each newly-introduced device in order to determine the question of equivalency. *Id.*

59. The proposed amendment would have the effect of permitting applicant to add new and different species — would be analogous to permitting an applicant who originally claimed a genus and one species to amend by adding other species which he did not claim or show, although they might to some extent illustrate the nature and character of the invention. *Id.*

60. The admission of such amendments would permit an applicant to make a picture gallery of his application by introducing all the known forms of what might be equivalents, and thus secure an examination of each device. *Id.*

61. Amendments which propose claims involving a departure from the invention originally presented, or a want of identity with the invention originally disclosed, should be admitted for consideration and *rejected for such reasons*, whereupon appeal would lie to the examiners-in-chief. *Ex parte Regan*, 45 O. G. 589, C. D. 1888.

62. If the new matter presented in an amendment contains claims for another and distinct invention, which, if admitted, would immediately require a division of the application to be made or applicant to elect which invention he will prosecute in the pending application, it should not be admitted. *Id.*

63. The original application of Sawyer and Man, filed January 9, 1880, for a patent for improvements in incandescing electric lamps, was evidently intended to secure only the arched form of the carbon burner; but in 1885, after Edison's inventions had been published to the world, the purpose of the application was changed to secure the use of all carbons made of fibrous material. *Held*, that such a change was not justifiable and the claim based thereon

is void. \**Consolidated Electric Light Co. v. McKeesport Light Co.*, 49 O. G. 1536, C. D. 1889.

64. The courts look with disfavor upon "attempts to enlarge the scope of an application once filed." *Ex parte Lillie*, 53 O. G. 2041, C. D. 1890.

65. A drawing cannot be altered to show a construction neither disclosed in such drawing nor described in the specification as originally presented, upon the filing of an affidavit that the drawing made from and with the proposed amendment would correctly represent a model which was never filed in the patent office. *Ex parte Kissner*, 53 O. G. 919, C. D. 1890.

66. Officials of the patent office should be upon their guard against amendments, made late in the history of proceedings upon an application, which are apparently inspired by the purpose of dominating inventions subsequently made by other inventors and not embraced within the scope of the application as originally filed. *Rogers v. Winssinger*, 56 O. G. 804, C. D. 1891.

67. Petition to amend a drawing, and thereby bring out a feature of construction not shown in the drawing as originally presented nor described in the specification, but shown in an exhibit model not a part of the application, denied. *Ex parte Austin*, 56 O. G. 1059, C. D. 1891.

68. Where a proposed amendment embodied a substitute claim and descriptive matter relating to the subject-matter of such claim, *held*, that the amendment should be entered, and if, in the opinion of the examiner, it included matter not disclosed by the application as originally filed, the claim should be rejected. *Ex parte Harvey*, 58 O. G. 1257, C. D. 1892.

69. The question raised upon an amendment sought to be introduced into a pending application is not whether the applicant's invention of its subject-matter dates back to the filing of his original application, but whether such subject-matter is itself new so far as it relates to said pending application. *Ex parte Burson*, 58 O. G. 1414, C. D. 1892.

70. An amendment to an application must, to satisfy the requirements of rule 70, show only such a change as was within the original disclosure that was made when the application was first presented. *Ex parte Smith*, 58 O. G. 1840, C. D. 1892.

71. An applicant of his own motion filed a substitute sheet of drawings, which was entered as a part of the application. The examiner subsequently held it to be unwarranted by the specification, and required cancellation.

On appeal, *held*, that while the better course would have been to refuse to enter the new drawing until after the final determination of the question as to its admissibility, yet, it being clear that the drawing was uncalled for and superfluous, the requirement of cancellation must be sustained. *Ex parte Shepard*, 60 O. G. 575, C. D. 1892.

72. An amendment comprising a substitute specification and drawings and containing new matter should be refused entry. *Ex parte Nelson, Jr.*, 52 MS. D., Feb., 1893 (Simonds, Com'r).

73. When an amendment is filed which in the judgment of the examiner substantially varies the scope of the application as originally filed and necessitates a change in the drawings, *held*, that the amendment should be entered and rejected on the ground of new matter and for all other reasons which bar its patentability. *Ex parte Zuber*, 67 O. G. 529, C. D. 1894.

74. In such a case the drawings should not be changed unless and until the question of the new matter in the amendment has been determined in favor of the applicant. *Id.*

75. It is competent to amend the specifications while the application is pending, so long as it is done within the scope of the original application; but it is not competent, under color of this privilege, to introduce new matter. (*Railway Co. v. Sayles*, 15 O. G. 243, 97 U. S. 554, and *Eagleton Mfg. Co. v. West, etc. Mfg. Co.*, 27 O. G. 1237, 111 U. S. 490.) \**Michigan Central R. Co. v. Consolidated Car-heating Co.*, 71 O. G. 1028, C. D. 1895.

76. Where the specification as originally filed said nothing about inclining the steam-pipes downward from the center to the ends of the car and from the ends to the center of the car, and the drawings failed to show any such inclination, and thereafter the specification was amended to incorporate this feature, *held*, that the amendment was for new matter. \**Michigan Central R. Co. v. Consolidated Car-heating Co.*, 73 O. G. 615, C. D. 1895.

77. It is competent to amend the specification so long as it is done within the scope of the original application; but it is not competent, under color of this privilege, to introduce new matter. If the amended application embodies any material addition to or variance from the original — anything not comprised in that — such addition or variance cannot be sustained. (*Railway Co. v. Sayles*, 15 O. G. 243, 97 U. S. 554.) So long as the inventor does not change the structure of his device he can change the specification. (*Western Electric*

*Co. v. Sperry Electric Co.*, 65 O. G. 597, 58 Fed. Rep. 186.) \**Id.*

78. Claims based on new matter should be considered and rejected on the ground of departure and for all other reasons that are applicable, so that all questions may be settled at once if appeal is taken to the examiners-in-chief. (*Ex parte Zuber*, C. D. 1894, 47, 67 O. G. 529.) *Ex parte Ernest*, 76 O. G. 1417, C. D. 1896.

## VII. UPON RECOMMENDATION OF EXAMINERS-IN-CHIEF OR COMMISSIONER.

79. The primary examiners possess the whole jurisdiction of determining whether questions presented by offered amendments involve matters which were *res adjudicata*, and have the power to refuse to consider or act upon them, whether the question is referred to them by recommendation from the examiners-in-chief or the commissioner; but from this refusal there is a right of appeal. *Ex parte Pearson*, 40 O. G. 244, C. D. 1887.

80. Where the examiners-in-chief annex to their decisions a statement and a recommendation of an amendment, the applicant in presenting the same to the primary examiner is not required to make any showing, under rule 67, why the amendment was not sooner presented. *Id.*

81. Where the examiners-in-chief do not make such statement and recommendation, a doubtful or uncertain suggestion by them will not relieve the amendment from the requirements of rule 67. *Id.*

82. When an amendment is presented in compliance with a supposed recommendation of the examiners-in-chief which the examiner refuses to accept, the commissioner should be advised by the examiner in his answer to petition whether the proposed claim differs in scope or subject-matter from the claim already adjudicated. *Ex parte Donoran*, 44 O. G. 698, C. D. 1888.

83. An examiner is not bound by a recommendation contained in decision of examiners-in-chief. (*Ex parte Dysart*, 34 O. G. 1390; *Ex parte Pearson*, 40 O. G. 244.) Rule 130 (b) clearly implies that the examiner may reach a judgment adverse to the examiners-in-chief on points embraced in their recommendation, and that a further appeal may be rendered necessary either to the examiners-in-chief or to the commissioner. *Ex parte Heyer*, 44 MS. D. (2 G. W. D.), Nov., 1890 (Mitchell, Com'r).

84. The rules of practice of the patent office



provide that the examiners-in-chief may annex to their decision a statement of apparent grounds for granting letters patent in the form claimed or any other form and may make such recommendation as they deem proper. Such statement and recommendation cannot be ignored or pleaded as of no effect. It is binding upon the examiner and cannot be disregarded. *Ex parte Letellier*, 81 O. G. 1611, C. D. 1897.

85. It is to be presumed that the examiners-in-chief consider fully all matters bearing upon the question of patentability of claims as to which they make favorable recommendations, the question of new matter as well as other questions. Unless a state of the art not before the examiners-in-chief when their recommendation is made is found to exist by the examiner, such as precludes the allowance of claims recommended by them, the examiner should accept the recommendation. *Id.*

86. The examiner's action holding that an applicant cannot appeal from the decision of the examiners-in-chief and at the same time take advantage of so much of their decision as is favorable to him — cannot "split up their decision and accept a part of their suggestion and appeal from the rest of their decision"—overruled, as this is precisely what an applicant is entitled to do. It is the purpose of the patent law to grant to an applicant all that he is entitled to claim as new. *Id.*

87. The examiners-in-chief intimated in their decision on appeal that a certain feature might be allowed if it could be shown an advantage resulted therefrom as alleged by the applicant; and upon appeal to the commissioner, an affidavit that the invention has been made and put into practical operation having been filed, the application was allowed. *Ex parte Wm. A. D. Graham*, 62 MS. D., July, 1897 (*Greeley, Ass't Com'r*).

88. In a case appealed to the commissioner, he having suggested a certain feature might have novelty, and the examiner having subsequently refused entry of a claim therefor, *held*, the entry should be made, since it appears said claim was not substantially the same as one before registered. *Ex parte Arthur M. Wiatt*, 62 MS. D., July, 1897 (*Greeley, Ass't Com'r*).

#### ANALOGOUS USE.

(See PATENTABILITY; DOUBLE USE; NEW USE.)

#### ANNULMENT OF PATENTS.

(See CANCELLATION OF PATENTS.)

#### ANTICIPATION.

(See PATENTS; PATENTABILITY.)

##### I. PATENTS AND PRINTED PUBLICATIONS.

##### II. PRIOR ART.

##### III. PRIOR USE.

##### I. PATENTS AND PRINTED PUBLICATIONS.

1. The date of an application for a patent is conclusive evidence that the invention was made prior to such date, and a patent, though dated a month later than another for the same thing, is not anticipated by it when it appears that the application for such later patent was filed in the patent office two months before the date of the earlier patent. \**Kearney v. Lehigh Valley R. Co.*, 32 Fed. Rep. 320 (1887).

2. Green's patent is not anticipated by earlier patented processes for obtaining water by bored wells, or artesian wells, or by any earlier published description which was not as full, clear and exact as would be required in a specification of a patent, or was a description which would enable a properly qualified person to put the invention in practical operation from the description alone. \**Eames v. Andrews*, 39 O. G. 1319, C. D. 1887.

3. A prior patent anticipates a later patent where the later patent varies from the prior patent in particulars which do not require patentable invention. \**Sax v. Taylor Iron Works*, 40 O. G. 118, C. D. 1887.

4. A prior patent had all the features of the patent in suit, except that it had two corrugated zinc rubbing-plates instead of one, and in this respect the earlier patent described an equivalent of the single zinc plate of the patent in suit, and such patent, being also prior to the other in date of invention, was an anticipation of it. \**Starling v. St. Paul Plow Works*, 41 O. G. 818, C. D. 1887.

5. A prior patent will not deprive a later patent of patentable novelty if by discarding some of its mechanism so as to make it a failure in the way intended it will resemble the later patent. \**The Enterprise Mfg. Co. of Pennsylvania v. Sargent & Co.*, 42 O. G. 1403, C. D. 1888.

6. An English patent does not anticipate back of date of sealing, at which time it was made patent to the public. (Cases cited.) \**Elec-*

trical Accumulator Co. v. Julien Electric Co., 38 Fed. Rep. 117 (1889).

7. The fact that the specification of the foreign applicant was made accessible to the public in an unpublished form prior to the filing date of the American application is immaterial, because it was not then a printed publication, nor was it a patent. *De Ferranti v. Westinghouse*, 52 O. G. 457, C. D. 1890.

8. A domestic applicant is entitled to receive a patent for an invention as against all foreign knowledge or use of said invention, unless it has been patented or described in a printed publication. *Id.*

9. Novelty is not negated by any prior patent or printed publication, unless the information contained is full enough and precise enough to enable any person skilled in the art to which it relates to perform the process or make the thing covered by the patent sought to be anticipated. *Deprez and Carpentier v. Bernstein*, 54 O. G. 1711, C. D. 1891.

10. Prior publications must give "an account of a complete and operative invention, capable of being put into practical operation," in order to anticipate a patented invention. This general rule, however, is subject to the qualification that if the prior publication contains an omission which would ordinarily be supplied by one skilled in the art, the omission will not avail the subsequent patentee. (Cases cited.) *\*Chase v. Fillebrown*, 58 Fed. Rep. 374 (1893).

(A patent for an invention which was experimental and unsuccessful will not invalidate a subsequent patent for the perfected invention. *Whiteley v. Swayne*, 7 Wall. 685.)

11. The so-called publications made in the British Official Journal and the German Imperial Gazette concerning applications for patents and the laying open of such applications to public inspection do not constitute either publications of or patents for the inventions involved. *Parkin and Wright v. Jenness*, 63 O. G. 759, C. D. 1893.

12. A drawing contained in a pamphlet which appears to be a mere trade circular and not accompanied by any printed description, and there being no evidence that the pamphlet was ever actually published or intended for public use, or accessible to the public, is not such a printed publication as would anticipate the patent. *\*Britton v. White Mfg. Co.*, 61 Fed. Rep. 93 (1894).

13. Claims 20 and 21 of patent No. 272,598, dated February 20, 1883, not anticipated by

British patent of Howard and Bousfield of 1881, Steward having made oath during pendency of application that he had completed the invention and made a working model before the date of the British patent. *\*Deering v. Winona Harvester Works*, 69 O. G. 1641, C. D. 1894.

14. It is well settled that mere paper patents may negative otherwise patentable novelty, provided that they sufficiently disclose the principles of the alleged invention, or provided the alleged objections can be obviated by mere mechanical skill. *\*Edward Miller & Co. v. Meriden Bronze Co.*, 79 O. G. 1520, C. D. 1897.

15. A mere trade circular never actually published or intended for general use, or accessible to the public, is not such a printed publication as would anticipate a patent, although it may have been for a number of years in the possession of a witness. *\*Britton v. White Mfg. Co.*, 79 O. G. 2195, C. D. 1897.

16. A mere paper patent may anticipate, provided it sufficiently discloses the principle of the alleged invention. Such prior patent may be relevant also to show that another device is not an infringement of such alleged invention, but is merely an improvement upon the prior patent or an application thereof to a new purpose. (*Pickering v. McCullough*, 104 U. S. 319; *Dashiell v. Grosvenor*, 162 U. S. 432.) *\*Universal Winding Co. v. Willimantic Linen Co.*, 80 O. G. 1273, C. D. 1897.

## II. PRIOR ART.

17. Where the defendant attempts to defeat a patent by showing that the patentee was not the original discoverer of the thing claimed, the patent will, for the purpose of meeting such proof, be considered as relating back to the date of the original discovery. (*Dixon v. Moyer*, 4 Wash. 68, and other cases.) *\*Consolidated Bunging Apparatus Co. v. Woerle*, 38 O. G. 1015, C. D. 1887.

18. It is doubted if a simple construction of a machine more than two years before application for a patent upon it would invalidate the patent. *\*Campbell v. Mayor, etc. of New York*, 45 O. G. 345, C. D. 1888.

19. Although each separate step of a process may have been taken before, the process is not anticipated so long as it is not shown to have been used. *\*Celluloid Mfg. Co. v. Russell*, 37 Fed. Rep. 676, C. D. 1889.

20. Prior to December, 1875, abandoned and rejected applications were cited as references;

but after *Brown v. Guild* (6 O. G. 392) that practice ceased. Although such was the practice, yet a reference of that character was illegal, for the reason that by statute a patent can be barred only by public use, a publication, or prior knowledge or use by others of the completed invention. *Webster v. Sanford*, 44 O. G. 567, C. D. 1888.

21. Knowledge of foreign invention, although of an earlier date than an original invention in this country, is not necessarily a bar to a domestic patent. *Green v. Hall, v. Siemens, v. Field*, 47 O. G. 813, C. D. 1889.

22. The mere taking of a coloring substance already known and applying it to paper does not involve invention, and in view of the state of the art the patent is void. *\*Underwood v. Gerber*, 48 O. G. 116, C. D. 1889.

23. An abandoned application cannot of itself constitute a bar to a subsequently granted patent. *Black v. Fowler*, 48 O. G. 821, C. D. 1889.

24. *Held*, that a sketch made from memory of a machine seen fifteen years before is not sufficient evidence to anticipate a patent. *\*Tatum v. Gregory*, 41 Fed. Rep. 142 (1890).

25. A combination of parts in an automatic ventilating fan is anticipated by a similar combination of the same elements in various prior patents relating to windmill fans. The uses are analogous. *\*Smith v. Partridge*, 42 Fed. Rep. 57 (1890).

26. It is not sufficient to constitute anticipation that the device relied upon might by modification be made to accomplish the function performed by the patent in question, if it were not designed by its maker nor adapted nor actually used for the performance of such functions. *\*Topliff v. Topliff*, 57 O. G. 1257, C. D. 1892.

27. Evidence of the prior existence of the patented invention, to deprive an inventor of the fruit of his genius, must be so definite as to produce strong belief that the machine existed; and where such machine would naturally be known to more than a few observers, the fact that the evidence tends to disclose that it had been known only to a few at a particular time throws doubt upon its existence at that time. *\*Knickerbocker Co. v. Rogers*, 67 O. G. 1448, C. D. 1894.

28. It is well settled that an abandoned application, even though accompanied by experiments which fall short of practical use, cannot defeat a subsequent patent. (*Corn Planter Cases*,

6 O. G. 392, 23 Wall. 181.) *Hien v. Pungs*, 68 O. G. 657, C. D. 1894.

29. When a caveat did not describe the same invention patented by the caveator, its date of filing could not be availed of to defeat a subsequent publication by another of the invention embraced in the patent. *\*Electric Ry. Co. of the United States v. Jamaica & Brooklyn R. Co.*, 68 O. G. 769, C. D. 1894.

30. Prior invention must be established by "full, unequivocal and convincing evidence." *\*American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 70 Fed. Rep. 986 (1895).

31. A feature of construction in a prior invention which was immaterial and was not in the contemplation of the inventor thereof or pointed out by him as an improvement, or in any way suggested as a function of the arrangement of the parts, does not show anticipation of the patent. *\*Edison Electric Light Co. v. Electric Engineering & Supply Co.*, 73 O. G. 1287, C. D. 1895.

(However suggestive the experiments of others may have been, . . . they "will not suffice to defeat a patent." *United States Nickel Co. v. Anthes*, 1 O. G. 581, C. D. 1872—Judge Shipley.)

32. The fact that all the elements of a combination may be found partly in one structure and partly in another is unsafe ground for overturning a patent. *\*American Soda Fountain Co. v. Green*, 76 O. G. 964, C. D. 1896.

33. The fact that in a room ordinarily used to contain complete devices ready for the market there was exhibited a certain device is not conclusive proof that such device was complete and on sale. *\*Wurts v. Harrington*, 79 O. G. 335, C. D. 1897 (decided April 29, 1896).

34. The mere fact that a patented device is limited in operation or application is not alone sufficient to destroy its relevancy in a consideration of the prior art. *\*Edward Miller & Co. v. Meriden Bronze Co.*, 79 O. G. 1520, C. D. 1897.

35. As against the defense of anticipation the patentee may show the fact of invention by drawings, sketches, models or any other competent proof. The defense of anticipation to be successful must be established as of a date anterior to the patented invention, not merely prior to the application for or date of the patent. *\*Von Schmidt v. Bowers*, 80 O. G. 347, C. D. 1897.

36. Letters patent No. 250,416, *held* to be invalid, as the changes over the prior art were of that order of mechanical detail which is far removed from inventive skill. *\*National Fold-*

ing Box and Paper Co. v. Stecher Lithographic Co., 80 O. G. 813, C. D. 1897.

37. Letters patent No. 270,522, granted to the American Bell Telephone Company as assignee of Thomas A. Watson, for an improvement in telephone switches, is void in view of the prior state of the art, as it involves only several expedients in arranging a subscriber's outfit. \*Western Electric Co. v. Western Telephone Construction Co., 80 O. G. 2038, C. D. 1897.

38. A model of an alleged anticipating machine made merely from recollection years after the machine that it purports to represent, and which is introduced without disclosing the fact that it was not an original model until the same was developed on cross-examination, cannot be accepted as sufficient evidence to invalidate a patent. \*Kansas City Hay-press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

### III. PRIOR USE.

39. An old device will not be considered sufficient to defeat a patent when its construction is such that radical changes and additions would be required before it could be made to perform the work of the patented device satisfactorily. \*Consolidated Bunging Apparatus Co. v. Woerle, 38 O. G. 1015, C. D. 1887.

40. To antedate a patent by evidence of an earlier machine, such evidence must be very clear and precise to overcome the presumptions arising from the grant of the patent. \*Osborn v. Glazier, 40 O. G. 1137, C. D. 1887.

41. A fraudulent surreptitious purchase or construction or use of an invention prior to the application for a patent probably would not affect the rights of the patentee under this section of the act of 1839. \*Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

42. Where an element of a claim does not depend for its novelty in the material of which it is made, it will be anticipated by a like element in a like instrument of different material. \*Brinkerhoff v. Aloe, 46 O. G. 338, C. D. 1889.

43. The slide employed in the Brinkerhoff instrument and covered, broadly, by the first claim of the patent is made of metal. The patent makes no mention of any novelty existing in the material of which the slide is composed. *Held*, that the claim is anticipated by a glass slide in a similar instrument. \*Id.

44. A claim for an incandescing conductor for an electric lamp of carbonized, fibrous or textile material is void for want of novelty in view of the fact that wood charcoal had pre-

viously been used for electric lighting in incandescing lamps. \*The Consolidated Electric Light Co. v. McKeesport Light Co., 49 O. G. 1536, C. D. 1889.

45. It is a well-established rule that whatever, if subsequent, would infringe will, if prior, anticipate. \*Olds v. Brown, 41 Fed. Rep. 698 (1890).

46. Evidence that a particular device, forming an element of a combination claim, was used prior to the date of a patent upon which suit was brought is immaterial. The evidence should tend to prove that the device was so combined that the combination operated in the same way for the same purposes as in the claim in question. \*St. Paul Plow Works v. Starling, 55 O. G. 1821, C. D. 1891.

47. Where a patent sued upon describes a method which differs only in degree and not in kind from a previously-employed method, and where the utmost that can be said of the patented process is that it produces a somewhat more perfect article than was previously produced, *held*, that the patented method involves no novelty within the meaning of the patent law. (Citing *Smith v. Nichols*, 21 Wall. 112.) \*Ansonia Brass and Copper Co. v. Electrical Supply Co., 58 O. G. 1692, C. D. 1892.

48. Where evidence adduced by defendant of prior use of the patented article sued upon is such as to leave the court in doubt whether or not the exact device in question was ever hit upon by a prior experimenter, and where it appears that the first general use of the device came from its publication by the patentee, this doubt should be resolved in his favor. \*Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co., 58 O. G. 1555, C. D. 1892.

49. There is no anticipation by any prior device if it was of an accidental character of which the parties using it never derived the least hint. (*Tilghman v. Proctor*, 102 U. S. 707; *Pittsburgh Reduction Co. v. Cowles Electric Smelting and Aluminum Co.*, 55 Fed. Rep. 301; *Topliff v. Topliff*, 145 U. S. 156.) \*Chase v. Fillebrown, 58 Fed. Rep. 374 (1893).

50. He who alleges prior use must establish it by the same high class of testimony which a prosecuting attorney is required to produce in a criminal case. He holds the affirmative of that issue and must prove it beyond a reasonable doubt. If the evidence is susceptible of two interpretations, the one sustaining and the other destroying the patent, the court must accept the former. \*Lalancé & Grosjean Mfg. Co. v. Habermann Mfg. Co., 62 O. G. 452, C. D. 1893.

51. It is well settled that evidence of prior use, when the thing used is not produced, is of little weight, after a long interval, as to its identity with the patent in evidence. \*Pratt v. Sencenbaugh, 64 Fed. Rep. 779 (1893).

52. The indefinite, unsubstantiated evidence of prior use is insufficient to affect the validity of a patent. (Cases cited.) \*Britton v. White Mfg. Co., 61 Fed. Rep. 93 (1894).

53. Where the novelty of an invention resides in the particular form adopted, it is not negated by prior structures in another art which were not capable of doing its work, though afterward, in the light of that invention, they can be modified to perform its function. \*Knickerbocker Co. v. Rogers, 67 O. G. 1448, C. D. 1894.

54. As against an original inventor, anticipation is not shown by prior use of the invention under conditions which failed to disclose its composition or operation. Such knowledge of the invention should be accessible to the public. (Citing Boyd v. Cherry, 50 Fed. Rep. 279.) \*Matheson v. Campbell, 69 Fed. Rep. 597 (1895).

55. Where the devices alleged to anticipate the patented device were not designed to meet nor subjected to conditions analogous to those of the patented thing, *held*, that such prior structures did not anticipate the patented device. \*National Meter Co. v. Thomson Meter Co., 70 O. G. 925, C. D. 1895.

56. Where it is proved that the article set up as anticipating the patent was made a sample and known only to its maker, his daughter, and the person for whom it was made, *held*, that the proof was sufficient to establish prior public use. \*Dalby v. Lynes, 71 O. G. 1317, C. D. 1895.

57. The number of anticipations is not material. If one perfected and used has preceded, it is sufficient to defeat the validity of the patent relied upon. \*The Front Rank Steel Furnace Co. v. Wrought Iron Range Co., 72 O. G. 288, C. D. 1895.

58. The fact that a slight compression of the contacts had existed in a prior lamp does not show anticipation of the Bergmann patent, it appearing that such compression was immaterial to the form of construction employed in the prior lamp and was not in the contemplation of the inventor thereof or pointed out by him as an improvement or in any way suggested as a function of the arrangement of the parts. \*Edison Electric Light Co. v. Electric Engineering and Supply Co., 73 O. G. 1287, C. D. 1895.

59. The prior use of a paper with a fiber too close to allow the ink from an ink-roller to pass through it, such paper being impregnated with wax of a character so hard as to rupture or abrade the fibers of the paper when it is removed by a perforating instrument, is not an anticipation of a paper with a fiber so open as to permit the ready passage of ink and impregnated with wax of a character sufficiently soft to permit its removal from the paper without tearing or breaking the fiber of the paper. \*A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1895.

60. A mere accidental use of some of the features of an invention, without recognition of its benefit, does not anticipate a patent. \*Taylor Burner Co., Limited, v. Diamond, 76 O. G. 477, C. D. 1896.

61. To constitute anticipation of a device it is enough that such a device has been in well-established use, whether it originated in design or by accident. \*National Harrow Co. v. Quick, 76 O. G. 1574, C. D. 1896.

62. A new combination and arrangement of old parts, whereby spinning-spindles, instead of running in rigid bearings, are flexibly mounted on the rails so as to allow of greatly increased speed of revolution, *held* to involve invention and not to be anticipated by the use of similar devices in centrifugal machines for drying sugar or creaming milk. The two devices are so different in size, structure, and uses to which they are adapted that it is not a case of double use. (Potts & Co. v. Creager, 70 O. G. 494.) \*Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

63. Under the decision in Potts v. Creager (70 O. G. 494, 155 U. S. 597), power picks and plows are not anticipations for a mining machine, since they do not belong to related arts. \*Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

64. Decree for complainant in Hanifen v. Godshalk, *supra*, vacated upon rehearing, since it appears that defendants have established, at least *prima facie*, the identity of the fabric sued on with a prior British one. \*Hanifen v. Godshalk, 79 O. G. 513, C. D. 1897.

65. Novelty is not negated nor overcome by showing prior construction of a similar thing for a wholly different and foreign use not suggestive of the particular use to which the patented invention is applied. (Cases cited.) \*Kinnear & Gager Co. v. Capital Sheet-metal Co., 81 Fed. Rep. 491 (1897).

## APPEAL.

(See INTERFERENCE — APPEAL.)

- I. PETITION OR APPEAL (INTERLOCUTORY) TO COMMISSIONER.
- II. APPEAL FROM PRIMARY EXAMINER TO EXAMINERS-IN-CHIEF.
- III. APPEAL FROM EXAMINERS-IN-CHIEF TO COMMISSIONER.
- IV. APPEAL FROM COMMISSIONER TO COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.
- V. APPEAL FROM COMMISSIONER TO SECRETARY OF THE INTERIOR.
- VI. APPEAL TO UNITED STATES CIRCUIT COURT OF APPEALS.
- VII. APPEAL TO UNITED STATES SUPREME COURT.

## I. PETITION OR APPEAL (INTERLOCUTORY) TO COMMISSIONER.

1. There is no rule or requirement that an appeal which, though made because relating to form, involves the absolute merits of a claim shall be taken to the commissioner merely to save applicant the appeal fee. If applicant be put to the trouble and expense of a second appeal after the requirement of division has been complied with and the application has reached the stage for full consideration upon its entire merits, the fault is with applicant who has presented his application under such conditions rather than due to the office or its practice. *Ex parte Carter*, 46 O. G. 1391, C. D. 1889.

2. Where the examiner declined to consider the merits of certain definitely-stated claims for an article of manufacture for the reason that, in his opinion, said claims failed to point out any qualities in the thing claimed which could legitimately be considered in connection with the patentability of an article of manufacture, a petition on behalf of applicant praying that the examiner be directed to make the examination required by the statute, allowing or rejecting said claims, was granted. *Ex parte Rogers*, 49 O. G. 1361, C. D. 1889.

3. Questions involving "the rejection of a claim" are not reviewable by the commissioner upon petition. *Ex parte Tobie*, 50 O. G. 992, C. D. 1890.

4. Upon petition to the commissioner from decision of the assistant commissioner, *held*, that the law makes no provision for such an appeal and the petition was treated as a mo-

tion for rehearing. *Ex parte Clauton*, 42 MS. D. (2 G. W. D.), Mar., 1890 (*Fisher*, Ass't Com'r).

5. Objections to the specification, accompanied by refusal to act further on the merits until they have been removed, are reviewable by a petition to the commissioner and not by an appeal to the examiners-in-chief. *Ex parte Gäbel*, 55 O. G. 863, C. D. 1891.

6. Where the complaint was that the examiner had declined to consider claims 2 and 3, which were alleged to be modifications of the design shown in the drawing and claimed in the first claim, which stood allowed, *held*, that the examiner's action should be sustained. *Ex parte Petzold*, 55 O. G. 1526, C. D. 1891.

7. Objections that a claim is indefinite or that certain claims are substantially identical pertain to form, and a petition lies to the commissioner. *Ex parte Eastman*, 56 O. G. 410, C. D. 1891. 5709

8. Petition to expunge argumentative matter and new reasons of rejection from an examiner's statement refused. *Ex parte Mevey*, 56 O. G. 805, C. D. 1891.

9. An action of an examiner that amounts in effect to a holding that an alleged divisional application covers matter that could not be legitimately divided out of the earlier application of which it purports to be a division, is reviewable by the commissioner on petition, and does not involve a question that can be taken to the examiners-in-chief by way of appeal. *Ex parte Fuller*, 57 O. G. 1883, C. D. 1891.

10. Where the effect of action by the commissioner on an appeal from an examiner would be to review a decision of such examiner favorable to the merits of an application in question, such appeal will not lie. *Hochhausen v. Eickemeyer*, 58 O. G. 521, C. D. 1892.

11. An appeal from the adverse action of an examiner which involves the question whether the application under consideration is a division of a prior application is properly taken to the commissioner rather than to the examiners-in-chief. *Ex parte Freeman*, 58 O. G. 522, C. D. 1892.

12. No appeal lies to the commissioner from a decision of the examiner of interferences affecting the evidence before his own tribunal; but a motion to take additional testimony is not within this rule, and an appeal from the examiner's adverse decision thereon is properly taken to the commissioner. *Guerrant v. Cable*, *v. Coffee*, 59 O. G. 629, C. D. 1892.

13. When the objection to new matter is

that it is merely in the descriptive part of the specification or drawing and does not affect the scope of the claims, an interlocutory appeal lies from the examiner to the commissioner; but when new matter appears in or affects a claim or claims, the appeal lies to the examiners-in-chief. *Ex parte Suter*, 59 O. G. 1431, C. D. 1892.

14. A decision by the examiners-in-chief affirming a rejection by an examiner, subject to certain recommendations made by them, is such an affirmance of the examiner's decision that a petition to the commissioner asking "that a record decision affirming the patentability of the invention in issue may be entered" will not lie. *Ex parte McGowan*, 60 O. G. 735, C. D. 1892.

15. If a patent be granted on one of two concurrent applications by the same applicant and the other application is rejected on such patent for lack of divisibility of invention, a petition to the commissioner asking that the examiner be instructed that the application is a division of the application for which a patent was granted will not be passed upon, since it presents a question relating to the merits of the case. *Ex parte Feister*, 61 O. G. 152, C. D. 1892.

16. Where the examiner of interferences refused to consider a motion to strike out a wife's testimony and reserved the question until final hearing, *held*, on appeal to the commissioner, that this was a proper subject for interlocutory action. *Crawford v. Lichtenstein*, 61 O. G. 1480, C. D. 1892.

17. No petition can be properly taken from the action of the examiner when there has been no repetition of such action. *Ex parte Bishop*, 63 O. G. 153, C. D. 1893.

18. The question whether or not an examiner should cite as a reference an applicant's former patent, the application for which was copending with the present application, is one pertaining to the merits of the invention and therefore not reviewable by the commissioner on petition. *Ex parte McDonald*, 64 O. G. 857, C. D. 1893.

19. *Ex parte Mullen and Mullen* (50 O. G. 837) and *Ex parte Rogers* (49 MS. D. 418) discussed and held not to indicate a different practice. *Id.*

20. "There is no petition from the rejection of a claim by the primary examiner upon anything which he may hold is a substantial disclosure and anticipation of a claim." The rem-

edy is by appeal to the examiners-in-chief. *Ex parte Hulbert*, 66 O. G. 315, C. D. 1894.

21. A petition asking that an examiner be advised that a certain figure and description are sufficiently described and indicated in the original specification and drawing presents an appeal from the sufficiency rather than the propriety of a rejection. This is a question for the examiners-in-chief. *Ex parte Coe*, 81 O. G. 2086, C. D. 1897.

22. A request that an examiner be instructed in his duty as to his general practice toward applicants and in relation to application should be presented in a complaint against the examiner and not in a petition. *Id.*

(The term "petition" was substituted for "interlocutory appeal" by Commissioner Montgomery.)

## II. APPEAL FROM PRIMARY EXAMINER TO EXAMINERS-IN-CHIEF.

24. Since April 27, 1880, all *ex parte* cases appealed to the examiners-in-chief are within the jurisdiction of the primary examiner immediately after a decision by the examiners-in-chief. *Ex parte Pearson*, 40 O. G. 244, C. D. 1887.

25. No appeal lies to examiners-in-chief from adverse decision of primary examiner in public use proceedings. *Ex parte Finch*, 40 O. G. 1027, C. D. 1887.

26. Objections by the examiner that the alleged invention shown in an application for a mechanical patent should be made the subject of a design application, *held* to be a rejection of the application, the appeal from which must go to the examiners-in-chief. *Ex parte Schulze-Berge*, 42 O. G. 293, C. D. 1888.

27. An applicant whose claim for a combination has been rejected on the ground of illegitimacy and that it covers a mere aggregation of devices or elements has the right to appeal to the examiners-in-chief. Although such rejection is a vital formal objection, it also relates to the merits, and applicant has the right by appeal to all the tribunals provided by law to test the validity of such claim. *Ex parte Gillette*, 44 O. G. 819, C. D. 1888.

28. An objection holding that claims are functional is not a rejection, and therefore not appealable to the examiners-in-chief. *Ex parte Barrett*, 45 O. G. 125, C. D. 1888.

(Practice now modified. See *inter alia*, *Ex parte Halfpenny*, 73 O. G. 1135; *Williams*, 61 O. G. 423; *McClellan*, 59 O. G. 1763.)

29. The action of the examiner refusing to answer an appeal on the ground that it is not regular in form, in that it did not set forth the points on which it was taken, but simply stated that the appeal was from the rejection of the claims on references of record, overruled, and *held* that the present rules do not require that the reasons of appeal shall constitute a brief of the argument upon which applicant will rely before the board, but merely that the point or points of decision from which appeal is taken shall be specified. *Ex parte Callahan*, 50 O. G. 990, C. D. 1890.

30. The rules (133 and 135) require that the appellant should identify the part or portion of the decision from which appeal is taken, so that the examiner may confine his statement to the particular points involved in the appeal and not be compelled to anticipate every possible aspect which the presentation of the case on appeal may assume. *Id.*

31. From an examiner's rejection on account of "new matter," appeal lies to the examiners-in-chief. *Ex parte Regan*, 45 O. G. 589, C. D. 1888.

(See, also, *Ex parte Burt*, 49 O. G., C. D. 1889; and *Niolin Ochsenreiter*, 56 O. G., C. D. 1891.)

32. The refusal of the examiner to answer an appeal to the examiners-in-chief on the ground that it was premature was irregular, the examiner having twice objected to a certain claim because it did *not* cover a *combination*. *Ex parte Bullard*, 45 O. G. 1569, C. D. 1888.

33. The objection of the examiner that under such circumstances a petition to the commissioner is premature because he has not twice declined to answer the appeal to the board is not well taken. If the application is in condition for appeal, the statement required by rule 135 is required as a matter of course, and if the examiner refuses to furnish such statement the commissioner can at once direct that he shall do so. *Id.*

34. Where a petition prayed that examiner be instructed to accept an affidavit as sufficient to remove the effect of a reference cited, *held*, that under *Ex parte Payne*, 41 MS. D., and *Ex parte Boyer*, *id.*, it was a matter appealable to the examiners-in-chief, and the petition dismissed. *Ex parte Rosenstock*, 41 MS. D. (1 G. W. D.), Dec., 1899 (Fisher, Ass't Com'r).

35. One of the claims in an application had been rejected because it covered an illegitimate combination or an aggregation of elements. Applicant appealed from such rejection to the

examiners-in-chief. The board refused to take jurisdiction of the appeal and remanded the case to the primary examiner for reconsideration and such action as would dispose of the merits of all the claims. The examiner referred the case to the commissioner for instructions. Whenever a claim for an illegitimate combination is presented in an application which also contains claims for different elements constituting distinct and separate inventions which ought not to be claimed in the same application, a vital objection as to form is presented, and the claim may be rejected for the purpose of enabling the office to require division. Such a rejection, though relating to form, involves merits, and an appeal therefrom should lie to the examiners-in-chief. *Ex parte Carter*, 46 O. G. 1391, C. D. 1889.

36. When applicant claims the combination of a "stitch-forming and cloth-feeding mechanism" in a sewing-machine and "an automatic expansible or yielding hemmer and feller," and the examiner objects to the claim for the reason that the "means for securing an automatic action of the hemmer and feller" and "the means for securing an expansible or yielding action thereof" are not stated, and the applicant insists that his invention resides in a combination of which the peculiar hemmer and feller is an element, irrespective of the mere means by which its automatic action or its expansible or yielding action is secured, *held*, that the objection of the examiner presents a question of fact which relates to the merits, upon which applicant has a right of appeal to the examiners-in-chief. *Ex parte Laskey*, 48 O. G. 539, C. D. 1889.

37. An appeal from an action of the examiner objecting to a claim for an article of manufacture because of supposed aggregation goes to the examiners-in-chief. *Ex parte Baker*, 49 O. G. 1363, C. D. 1889.

38. The appeal from a rejection by the examiner because of insufficiency of the oath required by rule 75 lies to the examiners-in-chief. *Ex parte Boyer*, 49 O. G. 1985, C. D. 1889.

39. No appeal should be taken from an examiner's action until a final rejection has been had on all his grounds for refusing a patent. *Ex parte Donovan*, 52 O. G. 309, C. D. 1890.

40. Whether a process is a proper or legitimate one is a question relating to the merits and the subject for an appeal to the examiners-in-chief, and not a petition to the commissioner. *Ex parte Read*, 47 MS. D. (3 G. W. D.), June, 1891 (Frothingham, Ass't Com'r).



41. Questions involving "the merits of an invention" are questions concerning the meritorious or unmeritorious attitude of an alleged invention to the antecedent rights of the public; or, in other words, questions other than questions of "form" arising between the applicant and the office. The presence in rule 124 of the words quoted means no more than that the questions which go to the examiners-in-chief, when they arise *directly* under rule 133, go to the same tribunal when they arise *collaterally* under rule 124. *Zeidler v. Leech*, 54 O. G. 503, C. D. 1891.

42. All appeals in which, under the rule, the party only "whose claim is affected" has a right to be heard lie to the examiners-in-chief, and if decided adversely by them, to the commissioner, and if by him decided adversely, to the supreme court of the District of Columbia. All appeals from the examiners' decision upon motions to dissolve upon which both parties have the right to be heard go directly to the commissioner, and from his decision there is no further appeal. *Id.*

43. Amendments involving departure of invention raise no question for the examiners-in-chief unless they consist of new claims, either in whole or in part, or unless they alter or enlarge the meaning of the old claims already in the case. *Ex parte Gäbel*, 55 O. G. 863, C. D. 1891.

44. Objections that a claim is drawn to a bad combination, or that it is for an aggregation, or that it does not involve invention, pertain to the merits, and an appeal lies to the examiners-in-chief. *Ex parte Eastman*, 56 O. G. 410, C. D. 1891.

45. The recommendations of the examiners-in-chief are not binding upon the primary examiner, but there is no good reason why an applicant should be put to the delay involved in going through a second appeal simply to have the examiners-in-chief formally affirm what they have already decided in substance. *Ex parte Williamson*, 56 O. G. 1060, C. D. 1891.

46. An applicant will be required to pay only one fee on a single application on appeal to the examiners-in-chief, even if such appeal be repeated. *Ex parte Thomson*, 56 O. G. 1203, C. D. 1891.

47. Only those parties are entitled to be heard by the examiners-in-chief who have specifically entered an appeal and paid the fee thereon. *Shinn v. Baker, v. Gold*, 56 O. G. 1204, C. D. 1891.

48. The question of inoperativeness is one

which goes to the merits of the invention, and from a rejection on this ground an appeal lies to the examiners-in-chief. *Ex parte Ferguson*, 56 O. G. 1334, C. D. 1891.

49. The question whether the facts set forth in the statement filed with a re-issue application constitute inadvertence, accident or mistake is one pertaining to the merits and is appealable, in the first instance, to the examiners-in-chief. *Ex parte Murphy and Atkinson*, 56 O. G. 1449, C. D. 1891.

50. A petition does not lie directly to the commissioner under rule 145 simply on the point whether or not a proposed amendment involves a departure from the invention disclosed in the application as originally presented. This question is one which involves the merits, and appeal lies to the examiners-in-chief under rule 133. *Ex parte Turner, Van Beek and Brown*, 56 O. G. 1708, C. D. 1891.

51. The refusal of the examiner to forward to the examiners-in-chief an appeal taken from his action holding that an application was not a legitimate divisional application, *held* to have been properly made. *Ex parte Fuller*, 57 O. G. 1883, C. D. 1891.

52. The question of "incomplete combination of elements" and an objection that a claim covers only the function of a machine involve the merits, and are appealable to the examiners-in-chief in the first instance. *Ex parte McClellan*, 59 O. G. 1763, C. D. 1892.

53. Where an applicant who has been in interference seeks, after a decision of priority in his favor, to amend his claims, and the examiner rejects his amendment as covering matter which applicant has claimed too late, *held*, that the question thus raised is one which should be decided by the examiners-in-chief on appeal before it comes to the commissioner. *Ex parte Woodward*, 60 O. G. 1052, C. D. 1892.

54. The question whether a claim for a so-called "process" is a claim for the function of a particular machine is one relating to its merits. Appeal lies to the examiners-in-chief. *Ex parte Williams*, 61 O. G. 423, C. D. 1892.

55. The question whether an applicant may claim operative parts of a device which as a whole is inoperative is one on which applicant has a right of appeal to the examiners-in-chief. *Ex parte Smith*, 52 MS. D., Jan., 1893 (*Frothingham, Ass't Com'r*).

56. Where an application was rejected on a previously allowed application taken cumulatively with a patent and the applicant petitioned the commissioner for relief from such

action, *held*, that the question involved was appealable to the board of examiners-in-chief. *Ex parte Seymour*, 65 O. G. 751, C. D. 1893.

57. The use in claims of the terms "means" and "mechanism," limited only by the function which such means or mechanism performs, has heretofore been held to render the claims objectionable in form only when the novelty resides in the specific kind of means or mechanism; but whether the novelty resides in the specific means or mechanism can only be determined by reference to the state of the art. *Held*, therefore, that the question raised when this objection is made against such claims is one going to the merits of the invention and properly appealable to the board of examiners-in-chief. *Ex parte Halfpenny*, 73 O. G. 1135, C. D. 1895.

58. Rule 133 does not enumerate mutually exclusive points of appeal in such sense that one must be wholly different from another. *Ex parte Briggs*, 75 O. G. 1854, C. D. 1896.

59. The subject-matter of each appeal under rule 133 is the rejection of a claim and not the reasons upon which such rejection was based. *Id.*

60. Appeal is not merely from the examiner rejecting the claim, but from his decision holding it to be not allowable. *Id.*

61. The question as to whether a claim for a device different from that originally claimed may be introduced into a case more than two years after the device covered by the later claim has been in public use is a question of new matter which goes to the merits, and is appealable in the first instance to the examiners-in-chief. *Casler v. Edison*, 80 O. G. 966, C. D. 1897.

62. The rule (134) requiring an appeal to be taken in six months after final rejection has been abolished, and under present rules (June 18, 1897) an appeal may be filed at any time before the case becomes abandoned under the statute. *Ex parte Hodgins*, 62 MS. D., Aug., 1897 (Greeley, Acting Com'r).

(This time is limited to one year under the law which went in force January 1, 1898. Appeal to the court of appeals is differently regulated.)

### III. APPEAL FROM EXAMINERS-IN-CHIEF TO COMMISSIONER.

63. Acquiescence in the decision of the examiners-in-chief and abandonment of the right of appeal are not obviated, nor is applicant restored to his right of appeal, by again amend-

ing and restoring the canceled claim. The applicant cannot thus experiment with the office, go back to the primary examiner to ascertain what he may secure, and, failing there, retrace his steps and appeal from the examiners-in-chief and try his chance with the commissioner. If by such proceeding the applicant has deprived himself of the right of appeal to the commissioner, it is because he has elected to abide by the decision of the examiners-in-chief, and if he has thus deprived himself of any substantial right he must resort to some new procedure to extricate himself or file a new application. *Ex parte Williams and Raidabaugh*, 40 O. G. 1337, C. D. 1887.

64. It is not hereby held that a mere amendment before the primary examiner, by authority of the commissioner, and which does not change the subject-matter or scope of the claim, but only renders it more intelligible or less ambiguous, would thus operate as an abandonment of the appeal. *Id.*

65. Where an applicant has appealed from a rejection by the primary examiner to the examiners-in-chief and the latter have affirmed the rejection, the applicant has two courses which he may pursue. He may appeal to the commissioner, or he may return to the primary examiner and take such action before him as the rules and practice of the office permit. If he pursues the latter course and obtains such action by the examiner as to eliminate the claim involved in the appeal or amend it substantially in scope or subject-matter, this is an election to abide by the decision of the examiners-in-chief and constitutes an abandonment of the right of appeal. This proposition is not affected by the fact that the cancellation or amendment of the claim was irregularly allowed by the examiner without authority of the commissioner. *Id.*

66. Motion to dismiss an appeal taken to the commissioner from the decision of the examiners-in-chief, upon the ground that it was not accompanied by the brief statement of reasons required by rule 147, denied, and *held* that the statute does not require that the reasons shall be stated in order to render such appeal valid. The rule is directory in its nature and not a condition precedent to the validity of the appeal. *Holmes and Holmes v. Coler*, 51 O. G. 1622, C. D. 1890.

67. No appeal lies to the commissioner from a refusal of the examiners-in-chief to direct the attention of the commissioner in a decision in an interference case to certain patents al-

leged by one of the contestants to constitute a statutory bar. *Schmiedl v. Walden*, 56 O. G. 1563, C. D. 1891.

#### IV. APPEAL FROM COMMISSIONER TO COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

68. The action of the commissioner of patents in rejecting a claim for the striker plate in another application by the same inventor, but which rejection was acquiesced in by the applicant, *held* not to be reviewable on appeal from a decision of the commissioner rejecting a claim in this application for the combination of the striker plate and door or casing. \**In re Forg*, 66 O. G. 515, C. D. 1894.

69. There is no appeal to the court of appeals from any order or ruling of the commissioner of patents in any preliminary or interlocutory matter in an interference. \**Westinghouse, Jr., v. Duncan*, 66 O. G. 1009, C. D. 1894.

70. There is no appeal to the court of appeals from the *opinion* of the commissioner of patents holding that there is or is not an interference, nor from his refusal to investigate an alleged interference, such matters being left by law to his sound discretion. \**Id.*

71. A decision of the commissioner of patents that may be appealed from to the court can only be made after the primary examiner, the board of examiners-in-chief and the commissioner have all considered the case and made a finding therein. \**Id.*

72. The record of the proceedings in a case in the patent office, upon being filed with the clerk of the court of appeals, becomes a public judicial record of the court and must be so treated. There is no warrant found either in the patent law or the common law of the land to keep such papers secret and not to allow copies to be made except upon the special order of the court or consent of the appellant. \**Ex parte Drawbaugh*, 66 O. G. 1451, C. D. 1894.

73. In appeals from the commissioner of patents the court of appeals has no power or jurisdiction to award cost or to execute any judgment therefor that it might enter therein. \**Wells, Jr., v. Reynolds*, 69 O. G. 1507, C. D. 1894.

74. On an appeal from the decision of the commissioner awarding priority of invention, *held*, that the court will confine its decision to the matter passed upon in his decision and not consider the questions of abandonment, prior public use and anticipation of the invention,

which have not been acted on in the patent office. \**Colhoun v. Hodgson*, 70 O. G. 276, C. D. 1895.

75. Upon an appeal to the court of appeals of the District of Columbia from the decision of the commissioner of patents as to priority of invention, in an interference between parties, *held*, that the question as to the patentability of the issue is not properly presented; the appeal presents a question of priority simply. \**Hisey v. Peters*, 71 O. G. 892, C. D. 1895.

76. *Held* further, that the right of appeal in case of refusal of a patent upon the ground of non-patentability of the claim, and refusal of a patent because of interference with a prior right of invention, are distinct rights, and the latter does not involve the former. (Sec. 4911, R. S., and sec. 9 of act establishing Court of Appeals, D. C.) \**Id.*

77. Where the question of fact as to priority of invention had been fully considered by the officials of the patent office, *held*, that the decision of the patent office must stand, unless the evidence shows beyond any reasonable doubt that the appellant was the first inventor. (*Coffin v. Ogden*, 5 O. G. 270, 18 Wall. 120; *Morgan v. Daniels*, 67 O. G. 811, 153 U. S. 120; *Crawford v. Neal*, 144 U. S. 585, and *Furrier v. Ferris*, 145 U. S. 132.) \**Id.*

78. There is no justification for the theory that, since Revised Statutes, section 4894, give an applicant a possible two years in which to prosecute his application, he has two years in which to take an appeal to the court of appeals of the District of Columbia. \**Hien v. Pungs*, 73 O. G. 1600, C. D. 1897.

79. The right of appeal is not a vested right, but may be altered by statute or by rule of court made in pursuance of statutory authority to enact such rule. \**Id.*

80. Even if there were no rule at the time the right of appeal accrued, after the promulgation of a rule regulating the time for taking appeals the appellant became bound by it. \**Id.*

81. The parties failing to print the transcript of record, the appeal was dismissed. \**Pelton v. Evered*, 77 O. G. 1600, C. D. 1896.

(See, also, \**Munson v. Casper*, 79 O. G. 160, C. D. 1897.)

82. Appeal from the decision of the commissioner of patents, nearly a year after such decision, is brought in violation of rule 20 of the rules of this court, and should not be entertained, especially when no excuse for the delay is urged. \**Bryant v. Seymour, Com'r of Patents*, 77 O. G. 1599, C. D. 1896.

83. While some rules of court may be modified in special cases, they are in general as binding upon the court as upon parties and counsel, and rigid adherence is required to time-rules which are intended to have the effect of statutes. \*Id.

84. The rule that all appeals taken from the commissioner of patents shall be taken within forty days from the date of the ruling appealed from, and not afterward, is a positive law to the court and to the suitors therein. \*Ross v. Loewer, 77 O. G. 2141, C. D. 1896.

85. The contention that a motion for rehearing in the patent office should operate as a stay of the running of the time for the prosecution of appeal to this court till after the motion for rehearing has been determined, cannot be admitted. \*Id.

86. When it appears that an appellant has failed to have his cause filed and docketed, his appeal may, on motion, be docketed and dismissed, with costs. \*Rosebrugh v. Holman, 78 O. G. 1258, C. D. 1897.

(See, also, \*McCreery v. Seymour, Com'r, 79 O. G. 1684.)

87. The fact that the court of appeals of the District of Columbia has refused to consider questions of patentability of issues in priority cases does not establish the conclusion that the decision of the commissioner upon questions of patentability in such cases is final and conclusive. Such questions should come before the court by regular course of appeal. Breul v. Smith, 79 O. G. 153, C. D. 1897.

88. In a case of interference appealed to a court, the decision of the patent office must stand unless the evidence shows beyond any reasonable doubt that the appellant was the original inventor. \*Arnold v. Tyler, 79 O. G. 156, C. D. 1897.

89. The appellant having failed to have his cause filed and docketed, on motion of the appellee the cause was docketed and the appeal dismissed. \*Cleaveland v. Wright, 79 O. G. 866, C. D. 1897.

(See, also, \*Morrissey v. Seymour, Com'r of Patents, and \*Southall v. Seymour, Com'r of Patents, 79 O. G. 1634, C. D. 1897.)

90. Where all the tribunals of the patent office have decided adversely to an appellant, the concurrent decision will not be reversed except in a very clear case. \*Barratt v. Seymour, Com'r of Patents, 79 O. G. 2020, C. D. 1897.

91. Apart from the general rule that courts

have power to make reasonable rules not conflicting with express statutes, the court of appeals was duly authorized by statute to make rules limiting the time of appeals from the decisions of the commissioner of patents. \*In re Hien, 79 O. G. 507, C. D. 1897.

92. The fact that a rule of the court of appeals relating to the time in which an appeal must be taken was promulgated after the decision appealed from, is not controlling as to the appeal, since the right of appeal is not a vested right, but one which may be altered by statute or by rule of court. \*Id.

93. The court of appeals for the District of Columbia has authority to limit the time for taking appeals, and there is no restriction by reason of section 4894, Revised Statutes, which has reference solely to the abandonment of an application by failure to prosecute. \*Id.

94. The decision of the supreme court in Gandy v. Marble, in which it was held that a bill in equity under section 4915, Revised Statutes, was *sub modo* a branch of the application and governed as to laches by section 4894, Revised Statutes, had nothing to do with the time in which an appeal from the decision of the commissioner of patents must be taken. \*Id.

95. The supreme court in Butterworth v. Hoe, in considering the difference between an appeal under section 4911, Revised Statutes, and a bill in equity under section 4915, Revised Statutes, held that the latter is a proceeding according to the ordinary course of equity. This being so, section 4894, Revised Statutes, is inapplicable to the case of an appeal from the decision of the commissioner of patents. \*Id.

96. The act of congress approved February 9, 1893, by which the determination of appeals from the commissioner of patents was vested in the court of appeals of the District of Columbia, does not overstep the boundaries erected by the constitution between the three great departments of the government, but it is within the power of congress to enact such law. \*Bernardin v. Seymour, Com'r of Patents, 79 O. G. 1190, C. D. 1897.

97. As congress had the power to create a distinct special tribunal, proceeding after the manner of a court of law or equity, for the adjudication of claims to patents for inventions, there seems to be no convincing reason why it could not, without violating the constitution, make it a branch or bureau of an executive department, subject to supervision in matters administrative only by the head of that depart-

ment, and subject to review in matters judicial in their nature by a court of competent jurisdiction. \*Id.

98. Where on appeal from the decision of the commissioner of patents a record was allowed to be filed in the case by appellee upon assurance that it would have some material bearing upon the question of the issue presented by the appellee, but on consideration it was found that the record had no such bearing, *held*, that the record so introduced must be at the cost of the appellee. \*Stevens v. Seher, 81 O. G. 1932, C. D. 1897.

#### V. APPEAL FROM COMMISSIONER TO SECRETARY OF THE INTERIOR.

99. The secretary of the interior has no appellate jurisdiction over the commissioner of patents in cases involving the performance of judicial or *quasi*-judicial duties imposed by law upon the commissioner of patents. †Houston v. Barker, v. Bannister, v. Eastman, 44 O. G. 697, C. D. 1888.

100. The secretary of the interior has authority to direct the commissioner of patents to perform the duties, either judicial or ministerial, which the law enjoins upon him; but when these legally-enjoined duties are judicial or *quasi*-judicial he cannot control the commissioner's discretion in the manner of their performance. †Id.

101. The appellate jurisdiction of the secretary of the interior over the actions of the commissioner of patents is limited to cases not involving duties directly imposed by congress, but such only as are imposed by the rules and regulations prescribed by the secretary for the government of the commissioner and his subordinates. †Id.

102. No appeal lies to the secretary of the interior in interference cases. †Petithomme v. Bedbury, 52 O. G. 605, C. D. 1890.

(See, also, *Ex parte* †Noakes, 66 O. G. 575, C. D. 1892; also †Jenkins v. Jenkins & Armat, 78 O. G. 1902, C. D. 1897.)

103. The secretary of the interior will not advise the commissioner of patents how to decide a case pending before him on appeal when he conceives that the parties appealing have the right to expect the individual judgment of the commissioner. †*Ex parte* H. Manske & Co., 63 O. G. 1687, C. D. 1893.

104. Upon an appeal to the secretary from the decision of the commissioner refusing to

make an order of default against K. and declining to entertain and dismiss from consideration motions on behalf of M. for an order upon B. and upon C. to show cause why judgment should not be entered against them as junior parties for failing to take testimony within the time assigned them for that purpose, *held*, that the question involved is one which has been already judicially determined by the commissioner, and, as in such cases the secretary has no appellate jurisdiction, the appeal is dismissed. †Knight v. Bagnall, v. Curtis, v. Morgan, 76 O. G. 1115, C. D. 1896.

105. To construe and apply a rule of the patent office is at least a *quasi*-judicial act, and hence an appeal from the decision of the commissioner based upon an alleged disregard of a certain rule must be dismissed. †Warner v. Stimson, 78 O. G. 1901, C. D. 1897.

106. Another ground for dismissing the appeal is founded upon the grounds of policy, since to allow appeals to the department from interlocutory orders of the commissioner would unnecessarily delay the progress of the case. †Id.

(No appeal lies to the secretary from the commissioner as to judicial or *quasi*-judicial actions of the latter. Butterworth, Com'r, v. United States ex rel. Hoe, 29 O. G. 615, C. D. 1884.)

#### VI. APPEAL TO UNITED STATES CIRCUIT COURT OF APPEALS.

107. On a suit for infringement the court passed a decree for a perpetual injunction and accounting, and after an interval of more than two months defendants asked for a rehearing and a dissolution of the injunction. Pending this petition, and before its denial by the court, the circuit court of appeals was created. *Held*, that the order denying the petition for a dissolution of the injunction was not an interlocutory order or decree of continuance from which an appeal lies to this court within the meaning of section 7 of the act of March 3, 1891, establishing the circuit court of appeals. \*Boston & Albany R. Co. v. Pullman's Palace Car Co., 61 O. G. 428, C. D. 1892.

108. In the prosecution of an appeal to the circuit court of appeals under section 7 of the act of March 3, 1891, from an order granting an injunction, there is no discretion in the court or judge allowing the same to deny or refuse the appellant a *supersedeas*, and the appellant is entitled to it as a matter of right. \*Société Anonyme du Filtre Chamberland Systeme Pasteur and The Pasteur Chamberland Filter Co. v. Blount, 61 O. G. 1484, C. D. 1892.

109. A decree which is rendered after full hearing on the merits and which sustains the validity of a patent, declares infringement, and awards a perpetual injunction and an accounting, is an "interlocutory decree" granting an injunction, from which an appeal will lie to the circuit court of appeals under section 7 of the act of March 3, 1891. (*Jones Co. v. Munger, etc. Co.*, 50 Fed. Rep. 785, 1 C. C. A. 688, approved.) \**Richmond v. Atwood*, 61 O. G. 1655, C. D. 1892.

110. The term "interlocutory order or decree" was used in its broadest sense in this section and should be given full scope, to the end that any party aggrieved by any order or decree granting an injunction at any stage of the proceedings may have a speedy remedy by appeal. \**Id.*

111. On such an appeal, where the whole record is before the circuit court of appeals, and, in order to determine the rightfulness of the injunction, the court necessarily examines the whole case on the merits and reaches the conclusion that there is no infringement, it may not only reverse the decree and dissolve the injunction, but may also vacate the order for an accounting and order the bill dismissed, thus rendering such a decree as the lower court should have rendered on the whole case. (*Jones Co. v. Munger, etc. Co.*, 50 Fed. Rep. 785, 1 C. C. A. 668, disapproved.) \**Id.*

112. A decree sustaining the validity of a patent, declaring infringement, directing an injunction perpetual in form and referring the cause to a master to take an account of damages and profits is not appealable in its entirety, so as to give the circuit court of appeals jurisdiction to finally determine the questions of validity and infringement, for the decree is not final in its nature and appealable as such under prior laws, but is interlocutory, and on an appeal therefrom under section 7 of the act creating the circuit court of appeals, the court is limited to the question whether the injunction was providently granted in the exercise of a legal discretion, and it can have no jurisdiction to render a decision on the other questions, even at the request of both parties. (*Jones Co. v. Munger Mfg. Co.*, 50 Fed. Rep. 785, 1 C. C. A. 158, disapproved.) \**Columbus Watch Co. v. Robbins*, 62 O. G. 1963, C. D. 1893.

113. In an action at law for damages for an infringement, the question whether a certain patent set up as a defense is an anticipation of the patent sued on is a question of fact to

be submitted to and decided by a jury, and where there was no request for an instruction to the jury to return a verdict for the defendant the appeal court cannot, under such circumstances, consider the question. \**Harper & Reynolds Co. v. Wilgus*, 64 O. G. 302, C. D. 1893.

114. On a writ of error to the circuit court of appeals its review is confined to the consideration of questions of law, the rulings of trial courts upon questions of evidence, and the instructions given and refused to the jury. \**Id.*

115. Where there is nothing in the bill of exceptions to show that the jury disregarded the instructions of the court, the presumption is that they strictly followed them, and, in the light of the evidence, obeyed the charge of the court. \**Id.*

116. Where the appeal has been taken under the seventh section of the court of appeals act from an interlocutory order granting an injunction, the appellate court will not ordinarily hear and finally determine the merits of the controversy as to the validity of the patent sued on and its infringement; yet, in looking into the record to determine whether the order was properly granted, the court may be obliged to consider the validity and infringement of the patent and reach a conclusion on both of those points. \**Columbus Watch Co. v. Robbins*, 70 O. G. 132, C. D. 1895.

117. As the decree of the circuit court was not final, *held*, that the only appeal which could be considered is from so much of such decree as grants an injunction. \**Kilmer Mfg. Co. v. Griswold*, 72 O. G. 1786, C. D. 1895.

118. A suit by the United States to annul a patent is not within the limitations of the act creating the circuit court of appeals. \**United States of America v. American Bell Telephone Co. and Berliner*, 73 O. G. 1285, C. D. 1895.

119. The "interlocutory order or decree" made appealable by section 7 of act of March 3, 1891, for the organization of the courts of appeal, as amended February 18, 1895, must be one which leaves the cause pending on the issues in the court of original jurisdiction. The state of the record or progress of the cause must be such when said appealable "interlocutory order or decree" is entered that a "final decree" upon the matter with which said "interlocutory order or decree" has to do may yet be made. \**Standard Elevator Co. v. Crane Elevator Co.*, 77 O. G. 811, C. D. 1896.

120. By providing an appeal from a prelim-

inary or *pendente lite* injunction and in an adjoining section of the same act giving an appeal from any "final decision," the law-makers indicated that a perpetual injunction decreed as the outcome of a final hearing on the merits in a patent case was appealable as a "final decision." \*Id.

121. The words "the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court during the pendency of such appeal," in section 7, seem to imply that the mere perfecting the appeal shall not in legal effect stay the suit. \*Id.

122. Where the lower court held that defendant had infringed and referred the cause to a master in chancery to take, state and report to the court an account with respect to the infringement and the gains, profits and advantages which the defendant had received or which had arisen or accrued by reason of such infringement, and while the matter was so pending before the master and before any report by him the appellant (here) perfected an appeal from that decree to the court of appeals, *held*, that the appeal should be dismissed, as the decree appealed from was interlocutory, and that the appeal was taken after the expiration of thirty days from the entry of the interlocutory decree. \*Raymond v. Royal Baking Powder Co., 77 O. G. 1124, C. D. 1896.

## VII. APPEAL TO UNITED STATES SUPREME COURT.

123. An appeal from the final decree of a circuit court must be taken within two years from the entry of such decree or it will not be entertained. \*Fowler v. Hamill, 55 O. G. 715, C. D. 1891.

124. Where it appeared that the decree in the circuit court was against only one of several defendants, *held*, that the suit was still pending and undetermined against the other defendants, that the decree was not final, and that the supreme court had, therefore, no jurisdiction of the appeal. \*Hohorst v. Hamburg-American Packet Co., 63 O. G. 155, C. D. 1893.

125. In order to bring a case by appeal or writ of error from the court of appeals of the District of Columbia within the jurisdiction of the supreme court of the United States under this alternative, the matter in dispute must be money or some right the value of which can be estimated and ascertained in money and which appears by the record to be of the req-

uisite pecuniary value. \*United States ex rel. State of South Carolina v. Commissioner of Patents, 67 O. G. 1191, C. D. 1894.

126. In order that a case may come within this clause the validity and not the construction only of an authority exercised under the United States must be directly drawn in question. \*Id.

127. The United States supreme court alone has appellate jurisdiction of a suit to annul a patent. \*United States of America v. American Bell Telephone Co. and Berliner, 73 O. G. 1285, C. D. 1895.

128. The supreme court of the United States will not take jurisdiction on appeal of applications for patents in view of the provisions in relation to appeals from the circuit courts of appeals under the act of March 3, 1891, as the right to apply for a patent and the invention cannot be regarded for jurisdictional purposes as in itself property or a right of property having an actual value susceptible of estimation in money. \*Durham v. Seymour, Com'r of Patents, 74 O. G. 1731, C. D. 1896.

## APPLICATION FOR PATENT.

- I. DATE OF.
- II. DELAY IN FILING.
- III. JOINT AND SOLE.
- IV. BY EMPLOYEES OF PATENT OFFICE.
- V. IN A FOREIGN LANGUAGE.
- VI. IMPROPER ALTERATION AND SUBSTITUTION OF PAPERS.
- VII. NAME OF APPLICANT.
- VIII. RETURN OF PAPERS TO APPLICANT.
- IX. INKS REQUIRED FOR PAPERS.
- X. TITLE OF INVENTION.

### I. DATE OF.

1. The date of completed application is the date the fee is paid, and not the date that the application is filed. *Ex parte* Columbia Sewing Machine Co., 41 MS. D. (1 G. W. D.), Nov., 1889 (Mitchell, Com'r).

2. An application dates from the day when the papers were filed complete and formal. The omission of applicant's residence from the oath is an informality, and the application takes date from the day when the omission is supplied. *Ex parte* Brand, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

## II. DELAY IN FILING AND PROSECUTING.

3. An applicant having deceased shortly after official action on his application, and his widow having been appointed administratrix of decedent's estate more than two years after, and having then promptly applied for reinstatement of the application, *held*, the delay was sufficiently accounted for. *Ex parte Guerrant*, 34 MS. D., April, 1887 (Montgomery, Com'r).

4. Applicants present broad and generic claims and claims for specific constructions. The former have been rejected for lack of novelty, and the latter found to conflict with claims in other pending applications. They insist that they have two years in which to appeal from the rejection, and by refusing to act successfully tie up other applications and prevent the issue of patents, or place the office in the position of issuing patents which may hereafter be adjudged to interfere with an application pending at the time the patents were granted. *Held*, that if applicants refuse to avail themselves for an unreasonable time of their right of appeal, or are unreasonably dilatory in seeking the protection which the rules offer them, for the purpose of delaying the issue of patents to other parties for their inventions which have been found patentable, the commissioner would not be justified in permitting such dilatory and unjust action of applicants to work hardship to other applicants who are entitled to the specific constructions, but will issue the patents. *Ex parte Lombard*, 43 O. G. 1847, C. D. 1888.

5. In such cases the applicants should be notified that in order to secure an interference they must act with reasonable promptness; but the office and not the applicants must be the judge of what constitutes reasonable promptness. *Id.*

6. Applicant has failed in this case to make a sufficient showing to enable the commissioner to arrive at the conclusion that his delay in completing the application was unavoidable during the entire period of non-prosecution on account of his financial condition. *Ex parte Fenno*, 52 O. G. 1665, C. D. 1890.

7. An inventor is not responsible for delay in patent office occasioned by interminable interference proceedings between him and other inventors. \**Brush Electric Co. v. Julien Electric Co.*, 41 Fed. Rep. 679 (1890).

8. The delaying of applications which are in condition to go to patent in order that an applicant whose claims have been rejected may

appeal to the examiners-in-chief is wholly in the interest of the public. *Abel and Dewar v. Maxim, v. Nobel*, 56 O. G. 139, C. D. 1891.

9. To what extent the suspension of issue of an allowable application should be carried to await an appeal upon a rejected application, which, if allowed, would interfere therewith, is a question depending upon the exercise of a wise discretion; but it would be an abuse of that discretion to permit an applicant whose claims are rejected to tie up and delay the issue of other applications by negligently or wilfully refraining from taking an appeal. Even though an applicant may have a strict legal right as between himself and the public to avail himself of the two years allowed by statute within which to take his appeal, he has no such right as against other applicants who are seeking in good faith to obtain patents for their inventions. *Id.*

10. An application will not be reinstated under section 4894 of the Revised Statutes, although the applicant had been sick fourteen months, when it appeared he had experienced attorneys who might have proceeded with the prosecution of the case. *Ex parte Tuoti*, 45 MS. D. (3 G. W. D.), Jan., 1891 (Fisher, Acting Com'r).

11. The application was filed June 4, 1877; the patent granted November 17, 1891. "The device covered by the patent in suit had been in public use by the respondent corporation since the year 1878. The respondent corporation was of ample means to prosecute the application. The result of any delay which might take place in the issue of the Berliner patent would evidently be to continue so much longer the practical monopoly of the art of electrical transmission of articulate speech." Under these circumstances the duty of the respondent corporation was to use the greatest degree of diligence in prosecuting the application to an early issue. "There should have been at least as great diligence as their own interests would have called for had their business been unprotected by patent-rights." The delays subsequent to June 9, 1882, were unwarrantable, were acquiesced in, and therefore intended by the respondent corporation, and were such as to invalidate the patent. \**United States of America v. American Bell Telephone Co.*, 69 O. G. 1778, C. D. 1894.

12. There can be but one law touching alleged delays in the progress of an application through the patent office and touching the duty



of applicants with reference thereto, whether the invention was from the outset seen to be valuable, or only afterward proves to be so, or always remains of little account. To deny this is to deny that the laws are equal, and would furnish a standard for the determination of the rights of patentees too fickle and imaginative to form a proper basis for the use of a court of law. \*American Bell Telephone Co. v. United States of America, 71 O. G. 1903, C. D. 1895.

13. Where an inventor delays four or five years in applying for a patent, "he assumes the chances of the field being occupied by other and more diligent designers more prompt to supplement their creative efforts by a reduction to practice." \*Front Rank Steel Furnace Co. v. Wrought Iron Range Co., 72 O. G. 288, C. D. 1895.

14. It is insufficient excuse for seven months' delay in filing an application that the attorney was too busy with other engagements to write the claims, there being no proof of sickness or poverty, etc. The rule of *stare decisis* must prevail. (Cases cited.) McCormick v. Cleal, 61 MS. D. 461, June, 1897 (Butterworth, Com'r).

15. Under the statute, former rule 68, relating to an inquiry as to delay in prosecuting a case if pending more than five years, held of doubtful validity, in view of decision of supreme court in American Bell Co. v. United States, 71 O. G. 1903; and the rule having been abrogated, the rejection is set aside. *Ex parte Jenne*, 62 MS. D., July, 1897 (Butterworth, Com'r).

### III. JOINT AND SOLE.

16. One of two joint caveators filed an application, and both caveators stated they had abandoned their interest in the caveat; *held*, the applicant need not furnish evidence he was sole inventor. *Ex parte Drury*, 46 MS. D. (8 G. W. D.), March, 1891 (Frothingham, Ass't Com'r).

17. Rule 32 (Rules of February 9, 1897) has been abolished. A joint application cannot be changed and continued as sole under present rules. The applications are separate and distinct, and the papers and fee filed in the joint application cannot be transferred to the other. *Ex parte Prescott*, 62 MS. D., Aug., 1897 (Greeley, Ass't Com'r).

18. When through ignorance a party who is not an inventor joins with the inventor in making application, the ignorant cannot legally

succeed as sole applicant the joint applicants. The fact that for a time the rules permitted the substitution now asked for does not make it possible or equitable to grant relief not in accordance with the law. *Ex parte Erne and Bridges*, 81 O. G. 2247, C. D. 1897.

### IV. BY EMPLOYEES OF PATENT OFFICE.

19. The obvious purpose and intent of congress, as expressed by section 480, Revised Statutes, was and is to prevent persons employed in the patent office from improperly utilizing their knowledge of the inventions of others, acquired as a result of their official connection with the patent office, and from utilizing the opportunities they have, as a result of their employment, to become rivals or competitors of inventors whose applications they have before them for examination, or in any wise to take undue advantage of the knowledge they have acquired of pending applications in their capacity of examiners or officials. *Ex parte McElroy*, 80 O. G. 1123, C. D. 1897.

(Order No. 1,144.)

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

Washington, D. C., August 6, 1897.

All applications for patents now pending before the office filed by employees of the patent office during the period of their service, either complete or incomplete, or completed after they had separated themselves from the service, are ordered to be stricken from the files and the fees returned.

The views of the commissioner upon section 480 of the Revised Statutes are expressed in his decision of even date herewith in the case of *Ex parte John H. McElroy* (80 O. G. 1123).

BENJ. BUTTERWORTH,

Commissioner.

See decision of Commissioner Butterworth, 26 O. G. 637, C. D. 1884, 12.

20. The reason of the statute which prohibits an officer or an employee of the patent office from acquiring either directly or indirectly *any interest* in a patent issued would seem by fair intendment to prohibit him from filing an application for the interest he is not permitted to acquire. The application is the evidence of an inchoate right to a patent, and the ownership becomes complete when the patent is issued. *Id.*

21. To construe the statute to allow an employee of the patent office to file an application would obviously permit, if in fact it did not encourage, the very mischief the statute was clearly intended to prevent, as examiners might

make some slight improvement or modification in inventions covered by applications pending before them for examination and file an application, change or modify it from time to time, negotiate the sale of the whole or a part interest in the invention or application or the patent to be predicated thereon, and resign and prosecute the case and take a patent whenever such course seemed to offer greater pecuniary advantages than to remain in the office, and thus the office might become freighted with applications filed by examiners or other employees in contravention of the spirit if not the strict letter of the statute, and thus become a prolific source of scandal. *Id.*

22. An application filed by an employee of the patent office ordered to be stricken from the files and the fee returned, as under section 480, Revised Statutes, it is not competent for an inventor to file an application for a patent while he is such an employee. He may file his application, however, after he has severed his connection with the office. *Id.*

(An employee of the patent office may have a patent after his employment ceases, for an invention made before such employment began (\*Page v. Holmes Burglar Alarm Telegraph Co., 17 O. G. 737, C. D. 1880), or for an invention made during his term of employment. *Foot v. Frost*, 14 O. G. 860, C. D. 1878. See, also, *Com'rs Dec.*, 26 O. G. 637, C. D. 1884.)

## V. IN A FOREIGN LANGUAGE.

24. An application in the German language, accompanied by a translation, *ordered* stricken from the files and a new file prepared as of date of receipt of the duly-executed specification in the English language. *Ex parte Gentsch*, 62 MS. D., Oct., 1897 (Greeley, Acting Com'r).

## VI. IMPROPER ALTERATION AND SUBSTITUTION OF PAPERS.

25. In *Ex parte Schuetz & Schuetz*, 41 MS. D., it was held that interlineations and erasures are unauthorized if made subsequently to the execution of the application. In cases where it is established to the satisfaction of the examiner that the application has been "altered or partly filled up after being signed or sworn to," such application should be stricken from the files. *Ex parte Kirkpatrick*, 41 MS. D. (1 G. W. D.), Dec., 1889 (Mitchell, Com'r).

26. An application signed and sworn to in blank will be stricken from the files. *Ex parte*

*Ayres*, 42 MS. D. (2 G. W. D.), Jan., 1890 (Fisher, Ass't Com'r).

27. A surreptitious alteration having been made in the drawings after filing, *ordered* the application be stricken from the files. *Ex parte Merrill*, 53 MS. D., Nov., 1893 (Seymour, Com'r).

28. An omitted page of a specification cannot be substituted by an attorney before filing an application. The application in this case *ordered* stricken from the files. (*Ex parte Altmann*, 80 O. G. 1475.) *Ex parte Raetzell*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

29. Where it appeared that the sheets of the specification were removed from the cords or ribbons connecting the same to the other papers of the application, and over the ends of which the seal of an officer before whom the oath was taken was affixed, and another specification was substituted, *held*, that there was a violation of rule 31 and an offense against the notice published in the Official Gazette, volume 70, page 1369, and the application was *ordered* stricken from the files of the office. *Ex parte Altmann*, 80 O. G. 1475, C. D. 1897.

## VII. NAME OF APPLICANT.

30. The law knows but one christian name. The middle names are mere matters of ornament or of social distinction; hence the omission of the middle name, or of the initial of the middle name, is wholly immaterial. But an omission to write the christian name in full is fatal. *Ex parte Gentry*, 44 O. G. 822, C. D. 1888.

## VIII. RETURN OF PAPERS TO APPLICANTS.

31. It is the settled practice of the patent office to refuse to return any of the papers of a complete application — that is, an application which comprises all necessary papers properly executed and on which the filing fee has been paid. Applications which do not comprise all papers necessary to a complete application properly executed may be returned where their return is necessary in order to enable the applicant to complete the papers, and this may be done whether the filing fee has been paid or not. *Ex parte Van Etten*, 80 O. G. 1760, C. D. 1897.

32. There are good reasons why papers should not be returned. It must be presumed that in filing the papers the applicant contemplated and intended the completion of the application and its preparation for examination

within the period fixed by statute. They must be taken to have been filed in good faith for the purpose of obtaining a patent on the invention set forth in them, as this is the only purpose for which applications can be filed or received by the patent office. *Id.*

33. It is a matter of grave doubt whether any paper or drawing relating to an application for patent, whether such application be complete or not, which has been filed in the patent office and has been stamped or otherwise marked by the office with the date of its receipt, should be returned. Certainly a paper or drawing so marked should not be returned except on satisfactory showing therefor being made, and in no case should it be returned without erasure or cancellation of the marking put upon it by the office. *Id.*

34. The receipt of the papers and drawing is acknowledged by the office. To permit the papers so dated to pass out of the custody of the office would offer opportunity for material changes in the drawing and specification and would give rise to endless controversy as to the date at which the invention set forth was actually shown by the records of the patent office. *Id.*

#### IX. INKS REQUIRED FOR PAPERS.

35. The preservation of the files of this office requires the use of permanent ink in the preparation of papers by applicants, and to this end an examiner may require an applicant to furnish copies of papers filed by him when the ink used in the originals is not of a lasting character. *Ex parte Ritter*, 55 O. G. 1883, C. D. 1891.

#### X. TITLE OF INVENTION.

36. While an applicant will be allowed within reasonable limits to say what the title of his patent shall be, he has not an absolute right in this or any similar matter of detail, and it is the province of this office to determine whether any title given to an invention is one which satisfies section 4884 of the Revised Statutes. *Ex parte Nickola*, 57 O. G. 1425, C. D. 1891.

37. If the title of an application is short and correctly indicates the nature and design of the invention, the applicant should be allowed, within reasonable limits, to say what it shall be. *Ex parte Becker*, 64 O. G. 559, C. D. 1893.

38. If the title given by the applicant is not satisfactory to the examiner, objection should be made; but the examiner himself should not arbitrarily select such title. *Id.*

#### ART.

(See PATENTABILITY — PROCESS OR METHOD.)

1. It is of the very essence of a patentable process that it shall exist and be capable of conception and operation independently of the apparatus by which it may be carried out. *Crane v. Meriam*, 43 MS. D. (2 G. W. D.), May, 1890 (Mitchell, Com'r).

2. An art, within the meaning of the patent laws, must accomplish some change in the character or condition of material objects. *Ex parte Turner*, 66 O. G. 1593, C. D. 1894.

3. When the practice of the alleged art will not produce any physical effect, but will merely carry out a plan or theory of action without the production of any physical results proceeding directly from the operation of the theory or plan itself, it is not an art in the sense of the patent law. *Id.*

4. Where the separate steps in the process are found separately in different patents, but taken with a different effect and in necessary relations with another set of operations, and in none of them as a complete process, these steps, when brought together, bear the same relation to one another and to the prior art that the few and simple elements of an improved machine bear to the many and complicated elements of its precursor. *Ex parte Rudd*, 68 O. G. 535, C. D. 1894.

5. The terms "art" and "process" in a patent have substantially the same meaning, and the expression "In the art of," as an introduction to a claim to an application, is misleading and confusing. *Ex parte Davis & Mustard*, 63 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

(Art embraces all those inventions which cannot be embraced under one or more of the four groups of instruments enumerated in the statute. *Rob. on Pats.*, vol. 1, 164.)

#### ASSIGNEES — RIGHTS OF, IN APPLICATIONS.

(See ATTORNEYS.)

1. The rights of assignees under the joint patent are protected; for if the sole applicant has assigned and transferred all the right and title which he had in the invention, then such assignees become the owners of the sole invention, and the office, if satisfied on this point, would permit them to take charge of and control all proceedings had in and under the sole application. *Kohler v. Kohler and Chambers*, 43 O. G. 247, C. D. 1888.

2. It would not be policy to allow any one but an assignee who is the owner of an undivided part of the entire invention to prosecute an application, owing to great confusion that would necessarily result. *Ex parte Funston*, 49 O. G. 1044, C. D. 1889.

3. An assignee of the entire invention may assert his right to hold correspondence with the patent office to the exclusion of the inventor. *Ex parte Baker*, 49 O. G. 1363, C. D. 1889.

4. In cases in which there is a dispute or a conflict of interest between the inventor applicant and his assignees, neither party will be permitted to take any action in the prosecution of the application without the concurrence of the other. *Petition of John S. Campbell*, 44 MS. D. (2 G. W. D.), Aug., 1890 (Fisher, Acting Com'r).

5. It is common practice to allow an assignee of an undivided part of an invention to be represented, if he so desires, by an attorney of his own selection, but an instrument which does not come within the definition of an assignment laid down by the supreme court in *Waterman v. Mackenzie* does not entitle the holder to such representation. *Ex parte Hunter*, 46 MS. D. (3 G. W. D.), April, 1891 (Frothingham, Acting Com'r).

6. When an applicant makes a full assignment of one of two applications, together with the invention disclosed therein and the right to a patent therefor, and such applications contain the same subject-matter, together with claims not drawn upon proper lines of division, he thereby conclusively elects to give the preference to the assigned application and to assert in the unassigned application only such portion, if any, of the invention as is special thereto. It follows that the assignee is entitled to prosecute the assigned application precisely as if the other application had never been filed. *Ex parte MacLaughlin*, 55 O. G. 863, C. D. 1891.

7. *Quære*, whether public policy will permit the office to allow an assignee to prosecute an application wholly from the sight of the inventor if the latter wishes to keep himself informed as to the proceedings. *Ex parte MacLaughlin*, 55 O. G. 864, C. D. 1891.

8. The assignee of an inventor who died before making his application has no standing as an applicant before the patent office, and this is true where the application sought to be made by the assignee is a division of one properly filed by the inventor. *Ex parte Stevens*, 59 O. G. 299, C. D. 1892.

9. The assignee of the entire interest may control the appointment and dismissal of an attorney to the exclusion of the applicant. *Ex parte Anderson*, 62 O. G. 449, C. D. 1893.

10. The assignee of a part interest has the right to have access to the files at any time. *Protest of the New Era Iron Works Co.*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

## ASSIGNMENT.

- I. IN GENERAL.
- II. DEFINED.
- III. CONSTRUED.
- IV. OF FUTURE IMPROVEMENT.
- V. BY ATTORNEY.
- VI. BY CORPORATION.
- VII. BY ORDER OF COURT.
- VIII. IN BANKRUPTCY.
- IX. DISPUTED TITLE.
- X. RECORDING AND IDENTIFICATION.

### I. IN GENERAL.

1. An assignment before application for letters patent "of the full and exclusive right to the invention as fully set forth in the specifications" carries with it whatever patents may issue upon divisions of the application required by the rules of the patent office. *\*Puetz v. Bransford*, 39 O. G. 1083, C. D. 1887.

2. A new application based upon features withdrawn from the original application, and differing in construction and arrangement, but not to a patentable degree, from the corresponding features in the original application does not relieve such new application from the assignments before stated of the original application. *\*Id.*

3. Letters patent No. 330,850, issued to Tillman Puetz, Jr., November 17, 1885, shows features of novelty not embraced in the drawings and description of the application for patent No. 330,849, and an assignment conveying an interest in the latter does not confer any right to the former. *\*Puetz v. Bransford*, 39 O. G. 1427, C. D. 1887.

4. A clause appointing the assignees attorneys of the patentee, with authority to use his name whenever they deem proper in the management of the business connected with the ownership of the patent, does not restrict in any way the interest or power of the assignees. Such a clause is simply unnecessary. *\*Rude v. Westcote*, 48 O. G. 399, C. D. 1889.

5. An assignment by a patentee of a certain patent does not, in the absence of misrepresentation as to the scope of the patent assigned, estop the assignor from taking out patents for other and different improvements in the same class of articles as that with which the earlier patent was concerned. \*Essex Button Co. v. Paul, 58 O. G. 1095, C. D. 1892.

6. A complete agreement of sale in an instrument purporting to be an assignment of a patent is all that is necessary to pass the legal title of personal property as between the parties. \*Jonathan Mills Mfg. Co. v. Whitehurst, 56 Fed. Rep. 589 (1893).

7. An exclusive right to make and sell is not assignable. \*Waterman v. Shipman, 64 O. G. 713, C. D. 1892.

8. An assignment executed before the consul-general of the United States at Frankfort-on-the-Main, Germany, is sufficiently proved by the signature of the said consul-general and the United States general seal. (Cases cited.) \*Matheson v. Campbell, 69 Fed. Rep. 597 (1895).

9. He who takes an equitable title by assignment takes subject to all existing equities whether he has notice or not. †Harrison v. Morton, 76 O. G. 1275, C. D. 1896.

10. When in a written instrument intended to effect the transfer of patents one such patent is inadvertently, as shown by competent evidence, omitted, the assignee has equitable title. Newton v. Buck, 79 O. G. 2200, C. D. 1897.

(Assignments of patents are not required to be under seal. \*Gottfried v. Miller, 21 O. G. 711, C. D. 1882.)

An assignment of all an assignor's property except such as is exempt by law does not carry a patent-right. \*Campbell v. James, 18 O. G. 1111, C. D. 1880, 18 Blatch. 92.)

## II. DEFINED.

11. An assignee of an undivided part of an invention within and throughout a specified part of the United States is not such an assignee of an "undivided part of an invention" as rule 6 requires to enable him to join in the prosecution of an application which the inventor had, without consent of said assignee, abandoned in a written declaration. Ex parte Funston, 49 O. G. 1044, C. D. 1889.

12. Such assignee does not come within the definition of an assignee as laid down in rule 211, paragraph 1. Id.

13. A grant of the exclusive right to make, use and sell a patented article throughout the United States for the full term of the patent is

to be treated as an assignment, enabling the assignee to bring suit in his own name against the patentee for an infringement. \*Rapp v. Kelling, 52 O. G. 1666, C. D. 1890.

14. An assignment is an instrument in writing, conveying either (1) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or (2) an undivided part or share of that exclusive right; or (3) the exclusive right under the patent within and throughout a specified part of the United States. \*Waterman v. Mackenzie, 54 O. G. 1562, C. D. 1891.

15. Such an instrument vests in the assignee a title in so much of the patent itself, with a right to sue infringers, alone in the first and third cases and jointly with the assignor in the second. \*Id.

16. Any other transfer is a mere license, giving the licensee no title in the patent and no right to sue at law in his own name for an infringement. \*Id.

17. A transfer of the exclusive right to a patent within and throughout a specified part of the United States is, properly speaking, an assignment. Ex parte Buchanan, 56 O. G. 140, C. D. 1891.

18. An instrument granting all right, title and interest in the invention, except as to a certain combination, is not an assignment. (\*Waterman v. Mackenzie, 54 O. G. 1562.) Ex parte Hunter, 56 O. G. 929, C. D. 1891.

19. An alleged assignment purporting to convey an invention yet to be made is a mere executory contract and not an assignment proper. \*Regan Vapor-Engine Co. v. Pacific Gas-Engine Co., 58 O. G. 1695, C. D. 1892.

20. An instrument recorded in the patent office before application for patent was made and not specifically identifying the invention is not an assignment but a mere executory agreement. Ex parte Lorentz, 59 O. G. 158, C. D. 1892.

(When an exclusive right is given for manufacture and sale of an invention throughout the United States, excluding the patentee as well as others, there remains nothing in the patentee. Nellis v. Pennock Mfg. Co., 13 Fed. Rep. 451.)

## III. CONSTRUED.

21. A provision in an assignment of a patent, that the net profits arising from sales, royalties, settlements or other sources are to be divided between the parties to the assignment, so as to give the patentee one-fourth thereof,

does not in any respect modify or limit the absolute transfer of title. \*Rude v. Westcott, 48 O. G. 399, C. D. 1889.

22. Schwintzer, by an absolute assignment, transferred, for a certain consideration, title to a patent, and on the following day he and the assignee entered into a contract reciting that, instead of the consideration mentioned in the assignment, the assignee should pay certain sums on future dates, and if he should fail to do so the title to the patent should return to Schwintzer. *Held* that, by this transaction, the legal title to the patent vested in the assignee, but was liable to be defeated *in futuro* on failure of the condition subsequent. \*Boesch v. Graff, 51 O. G. 477, C. D. 1890.

23. Complainant's president, being the owner of letters patent under which it manufactured split pulleys, assigned an interest therein, with the right in the assignee to manufacture, and any improvements were to be joint property. An employee of complainant instructed the assignee in the manufacture, and, it appeared, used substantially the forms claimed in a patent for which he applied, but assigned to the president, who assigned immediately after its issue to complainant. *Held*, that complainant could not dispute the right of the assignee to manufacture under the last patent. \*Dodge Mfg. Co. v. Puster, 52 O. G. 159, C. D. 1890.

24. When a written agreement is uncertain and shows a patent ambiguity, it is proper to admit parol testimony to explain it, and to construe it according to such testimony adduced. Ligowsky v. Peters, v. Hisey, 56 O. G. 1595, C. D. 1891.

25. When an assignment of patent-rights conveys rights for certain specified territory, a subsequent assignment of "all his right, title and interest" must be construed to convey only the interest for territory not included in the first assignment. \*Regan Vapor-Engine Co. v. Pacific Gas Co., 56 O. G. 1886, C. D. 1891.

26. The mere fact that an agreement which recites certain previous assignments of patents as the consideration for its execution was not executed until the day after such assignments were made does not of itself establish the fact that it was a separate and independent transaction. If it is apparent that the parties at the time had the entire transaction under consideration, the documents should be construed together. \*Id.

27. An agreement purporting to convey all discoveries and inventions of a certain character owned by C. and B., and applications for

patents pending therefor, may be construed to include inventions of the same character owned by and applications for patents pending in the name of B. alone, where C. and B. jointly own but one of such inventions, but C. is B.'s solicitor for procuring patents for the others. \*Lowry v. Cowles Electric Smelting and Aluminum Co., 65 O. G. 295, C. D. 1893.

28. B. and K., being owners of a patent for dress-stays, entered into an agreement that any inventions in dress-stays made by either of them should be owned jointly. Thereafter B. secured a patent for an improvement in dress-stays. After this the two entered into partnership with an existing firm for the purpose of making and dealing in dress-stays, the contract reciting that the right under the original patent owned by B. and K. should be in the partnership exclusively, and that any improvements made by either B. or K. should belong to the partnership. Several months later this partnership was dissolved by a written agreement reciting that "K. for a money consideration assigned all his right, title and interest in and to all and singular the property, assets and business of said copartnership" to the other partners. *Held*, that this assignment divested all of K.'s right and title to the patent secured by B. after the making of the original agreement between them. \*Bray v. Denning, 65 O. G. 754, C. D. 1893.

29. A clause in an assignment of a patent that, if the assignee fail to make certain statements and payments within a certain time after the same become due, the assignors shall have the right by giving notice to cancel the exclusive privilege and grant conferred does not authorize a cancellation by notice given at a time when no money is due. \*E. C. Atkins & Co. v. Parke, 68 O. G. 1519, C. D. 1894.

30. Where a written instrument transferred the exclusive right to make, use and sell machines in accordance with certain designated patents of the defendant, and it appeared that the object of the transfer unquestionably was to vest in the transferee the exclusive right to manufacture under all the patents of the defendant during their entire existence, *held*, that the omission to designate one of the patents from the transfer was a mistake. \*Newton v. Buck, 75 O. G. 673, C. D. 1896.

#### IV. OF FUTURE IMPROVEMENT.

31. Where the same inventor had assigned an earlier patent on potato-planters, together

with all improvements which he might thereafter make, certain interests in which patent became the property of defendants, they thereby acquired equitable interests in subsequent patented improvements of the same inventor in potato-planters and a right to a legal title to the same. \*Aspinwall Mfg. Co. v. Gill, 40 O. G. 1133, C. D. 1887.

32. An assignment of a patent, with future improvements of the same by the same inventor, is valid as to the improvements, as collateral or incidental stipulations connected with the conveyance of the principal subject. \*Id.

33. An instrument purporting to assign an invention yet to be made does not operate as an assignment of such invention when made, but is a mere executory contract. \*Regan Vapor-Engine Co. v. Pacific Gas-Engine Co., 58 O. G. 1695, C. D. 1892.

34. An indorsement of such an instrument assigning and transferring "all right, title and interest in and to the above agreement" passes only the written instrument itself, with such right of action thereon as had not at the time of the indorsement become vested in the indorser. (Reversing Regan Vapor-Engine Co. v. Pacific Gas-Engine Co., 57 O. G. 1886.) \*Id.

35. An assignment of part of right, title and interest in a patented invention and in and to any further improvements that the inventor might make or acquire does not give assignee title to an invention which is radically different in several respects, though belonging to the same art. To do so would be in effect to hold that the assignment in question constitutes a mortgage on the inventor's brain. Only improvements on the particular machine patented would pass by the assignment referred to. \*Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

## V. BY ATTORNEY.

36. The assignment of a patent for an invention when executed by one acting as attorney by an instrument under seal must be executed in the name of the principal and purport to be sealed with his seal in order to bind the principal. \*Machesney v. Brown, 38 O. G. 1130, C. D. 1887.

37. A conveyance executed by an attorney under a power of attorney to sell for the patentees, for them and in their names, all their right, title and interest in a patent, is in law their conveyance and not his. \*H. Tibbe &

Son Mfg. Co. v. Heineken, 47 O. G. 1221, C. D. 1889.

38. An instrument granting all right, title and interest in the invention, except as to a certain combination set forth in the application, is not an assignment, and an attorney appointed by a person holding under such an instrument will not be recognized in the prosecution of the application. Ex parte Hunter, 56 O. G. 929, C. D. 1891.

39. A patentee appointed an attorney with full authority to grant licenses and also with authority to assign the patent, but on terms and conditions to be "agreed on and approved by the grantor, or every bargain closed will be void." The attorney thereafter, without referring the matter to his principal, transferred in his own name, as grantor, to the plaintiff, his executors, etc., "the exclusive liberty, license, power and authority to make, use and sell" the machines in all the states and territories of the Union for the remainder of the term of the patent. Held, that this was an assignment of the patent, and was void as such both because made in excess of the attorney's authority and because it was his own act and deed and not that of his principal. \*Chauche v. Pare, 77 O. G. 1123, C. D. 1896.

40. After this transfer the principal wrote several letters to the plaintiff recognizing his interest in the invention, but all of which indicated that the patentee understood the plaintiff to have merely a license. Held, that they did not amount to a ratification of the assignment which the attorney had attempted to make. \*Id.

## VI. BY CORPORATION.

41. Officers of a corporation are special, not general, agents, and have no power to bind the corporation, except within the limits prescribed by the charter and the by-laws. The president of a corporation has no authority to assign a patent owned by the corporation without authority of the directors or managers. \*Kansas City Hay-Press Co. v. Devol, 72 Fed. Rep. 717 (1896).

42. While an assignment of a patent by a corporation executed by its president and secretary without previous authorization by the trustees is not within the scope of the ordinary powers of such officers, the act was clearly subject to ratification by the corporation, and inasmuch as four years have elapsed without any question being raised by the corporation,

no third party can challenge the validity of the assignment in a collateral proceeding. \*Id.

## VII. BY ORDER OF THE COURT.

43. As a void patent confers no title or right upon the patentee, a court of equity will not order him to assign it. \*Kennedy v. Hazelton, 46 O. G. 973, C. D. 1889.

44. Under the Public Statutes of Massachusetts, chapter 151, section 2, clause 11, authorizing "bills by creditors to reach and apply . . . any property, right, title or interest, legal or equitable, of a debtor within this state, which cannot be come at, to be attached or taken on execution in a suit at law;" and act of 1884, chapter 285, authorizing a bill to reach and apply in payment of a debt any property of the debtor, as provided by the above act, notwithstanding certain facts specified, "or that it is of uncertain value, provided the value can be ascertained by a sale or appraisal, or by any means within the ordinary procedure of the court," the court may decree that the master make and deliver an assignment of letters patent if the defendant refuse to assign them. †Wilson v. Martin-Wilson Automatic Fire Alarm Co., 52 O. G. 901, C. D. 1890.

45. Letters patent containing, under the Revised Statutes of the United States, section 4884, "a grant to the patentee, his heirs or assigns," and being by section 4898 "assignable in law by an instrument in writing," an assignment by a master under decree of court, without the patentee joining therein, is sufficient in form. †Id.

46. The *situs* of a patent-right is not such that it cannot be sold under a decree of a state court having jurisdiction over its owner. †Id.

47. The rule seems to be well settled that an assignment can only be made by the actual owner of a patent; that rights under the patent cannot be sold by a sheriff on execution and do not, like other incorporeal rights, vest in a receiver. \*Newton v. Buck, 75 O. G. 673, C. D. 1896.

48. It might be proper under some circumstances to have the patent issue to an inventor of an improvement, and then by process in equity compel an immediate assignment to an original inventor; but the jurisdiction of this court is equitable as well as legal in character, and that circuitous course is unnecessary. \*Milton v. Kingsley, 75 O. G. 2193, C. D. 1896.

49. A receiver under the laws of New York becomes, in proceedings supplementary to execution, invested with the title to all the debtor's property, equitable as well as legal, and a court may compel such debtor to appropriate his property and transfer it to a receiver. \*Newton v. Buck, 79 O. G. 2200, C. D. 1897.

(If an insolvent refuses to convey when ordered by the court, the latter may appoint a trustee to make the assignment. Murray v. Ager, 20 O. G. 1311.

The patent-right may be subjected by bill in equity to the payment of a judgment debt of the patentee. \*Id.

NOTE.—The decision of the supreme court of the District of Columbia in this case quotes decisions of the same and other courts and practically establishes the law upon the subject.

The patent privilege does not rest in a receiver merely by virtue of his appointment. See \*Dick v. Struthers, 34 O. G. 131.

A receiver, as such, has no power to convey the legal title to a patent. See \*Adams v. Howard (1884), 23 Blatch. 27; \*Gordon v. Anthony (1879), 16 O. G. 1135, 16 Blatch. 234.

A receiver, as such, may convey the equitable title. \*Adams v. Howard, *supra*.)

## VIII. IN BANKRUPTCY.

50. Where an assignee in bankruptcy elects to abandon property to the bankrupt before the expiration of the period of limitation within which he may bring suit under section 5057, the effect is as if the property abandoned had never been included in the assignment, and the statute of limitations is not pleadable in bar of a subsequent action for infringement by the owner of the patent. \*Sessions v. Romadka, 59 O. G. 939, C. D. 1892.

51. Where a bankrupt purposely leaves out of his schedule of assets certain property which he regards as unproductive and valueless, and his assignee in bankruptcy is a whole year winding up the estate and gives no sign of his wish to assume the property, *held*, in view of all the facts, a plain election within the discretion of the assignee not to accept the property, and that a transfer by the party himself some time subsequent to the winding up of his affairs vests a good and valid title in the purchaser. \*Id.

(*Held*, under section 5046, Revised Statutes, a right to the patents of the bankrupt vested in the trustee by virtue of his appointment. \*Carver v. Peck (1881), 131 Mass. 291; \*Prime v. Brandon Mfg. Co. (1879), 16 Blatch. 453, 4 Bann. & Ar. 379.

*Held*, the trustee's right was superior to that of an assignee of record whose assignment was made by the bankrupt after the bankruptcy. \*Id.)



## IX. DISPUTED TITLE.

(See PATENTS — ISSUE TO ASSIGNEES.)

52. While the commissioner is authorized to recognize formal legal assignments, and when they have been filed in the patent office before patent issues may give the assignee control of the management and prosecution of an application and direct the patent to issue in the name of the assignee, yet he cannot recognize equitable rights under executory or other equitable contracts; but where the relief asked, as in a petition for rehearing, is founded upon an alleged state of the title to the invention, the commissioner possesses the power to determine the allegation as to title in order to exercise his discretion in granting or refusing the relief. *McDonough v. Gray*, 46 O. G. 1295, C. D. 1889.

53. When an instrument is presented for record, the only thing to pass upon is whether it, upon its face, does in fact affect the title. If it does, and is accompanied by a proper fee, the commissioner's plain duty is to record it, and the parties affected unfavorably are to seek their remedies in the courts. *Ex parte Thompson*, 40 MS. D. (1 G. W. D.), Aug., 1889 (Fisher, Acting Com'r).

54. The commissioner of patents has no judicial authority to take action in disputed questions of title under an assignment. *Ex parte Gallatin*, 59 O. G. 1104, C. D. 1892.

55. The patent office cannot determine private rights under assignments. An assignment, regular on its face and regularly recorded, must be considered an absolute assignment until canceled by the written consent of both parties, or by the decree of a competent court. *Ex parte McFarlane*, 76 O. G. 1418, C. D. 1896, and *Ex parte Nichols*, 80 O. G. 1891, C. D. 1897.

## X. RECORDING AND IDENTIFICATION.

56. An assignment should be identified by date of execution. *Ex parte S. J. Murray*, 47 MS. D., May, 1891 (Mitchell, Com'r).

57. The recording of a mortgage of a patent-right in the patent office is equivalent to a delivery of possession and makes the title of the mortgagee complete toward all other persons, as well as against the mortgagor. *\*Waterman v. Mackenzie*, 54 O. G. 1562, C. D. 1891.

58. The statutes give no authority for recording or otherwise noting on the records of this office a protest against the validity of a previously-recorded assignment. *Ex parte Backus*

*Portable Steam Heater Co.*, 58 O. G. 385, C. D. 1892.

59. The office acts in a ministerial capacity in recording assignments and has no authority to enter upon a judicial inquiry as to their validity. *Id.*

60. Assignments of patents ought always to distinctly describe the patent, and, if the language of the assignment leaves in doubt the question whether the patent was intended to be included, the doubt ought to be resolved against the assignee in suits between him and third parties. *\*Levy v. Dattlebaum*, 63 Fed. Rep. 902 (1894).

61. The court refused to agree that an assignment which does not identify the patent by name, number and date cannot convey a title to the patent. *\*Id.*

62. The statute makes it the duty of the commissioner of patents to record assignments, meaning assignments that are genuine. He has no authority to record a spurious instrument. A spurious assignment recorded in the patent office would not be in law a record of that office. The record of an assignment is in law tantamount to a finding or certificate by the commissioner that the original is genuine. It matters not that the commissioner may act on the mere assumption that whatever paper of this kind is presented for record is genuine. He is a public officer charged by law with the duty of recording only such as are genuine. The law attaches to his act in making the record the *prima facie* presumption that the instrument copied upon his record book is entitled to record — that is to say, is genuine. (The view announced in *Mayor of New York v. American Cable R. Co.*, not acceded to.) *\*Standard Elevator Co. v. Crane Elevator Co.*, 77 O. G. 811, C. D. 1896.

63. Section 4898 does not require that any instrument in the chain of title to a patent shall be recorded, but all such assignments may be recorded. The sense, the essential significance and intent, of this section is that the record or official copy of any assignment shall give to any person interested the *prima facie* assurance that an original assignment was made in terms as shown in the record; that such instrument was subscribed as shown; that it was delivered; that the signature thereto is the genuine signature of the assignor, and that such assignor had an assignable interest according to the purport of the instrument. *\*Id.*

64. The record of assignments in the patent

office is a record "belonging to the patent office" within the literal terms of section 892; but in the absence of that section and on the general principles of evidence, a paper purporting to be a copy of a record in the patent office could be proven to be such copy by the sworn testimony of the person who made it or of a person who had compared it with the original record in the patent office. \*Id.

(Recording is only necessary as notice to strangers. Case v. Redfield, 4 McLean, 526. As to requirement for identification, see Wright v. Randel, 19 Blatch. 945.)

Two classes of record books are used in the patent office for assignments, namely: "Transfers of patents" and "Irregular transfers of patents." "The former contain all writings affecting the title of an invention or patent, whether an assignment, grant, license, injunction, power of attorney to sell, etc., where the inventor's name is given. The latter contain similar writings, but where the inventor's name is not known." Assignments which do not unmistakably identify the applications they are intended for are held unrecorded, and the parties filing the same so notified. (See Off. Gaz. of May 1, 1883.) Identification can be made by date of execution or date of filing of the application or its serial number.

No deed can be recorded *nunc pro tunc*.)

## ASSISTANT COMMISSIONER OF PATENTS.

(See JURISDICTION OF.)

### ATTORNEYS.

#### I. ATTORNEYS AND POWERS.

#### II. DISBARMENT.

#### I. ATTORNEYS AND POWERS.

1. An applicant has an undoubted right to revoke a power of attorney and nominate another attorney. (Ex parte Morley, 37 O. G. 337.) Ex parte Brewster, 33 MS. D., Feb., 1887 (Montgomery, Com'r).

2. The protest of an attorney against revocation of his power by the applicant, based on an oral agreement by which he was to receive an interest in the patent, held unavailing, there being no written assignment and no legal interest. Ex parte Nicholson, 34 MS. D., April, 1887 (Hall, Com'r).

3. An "associate attorney" cannot be nominated by an applicant without the consent of the *regular* attorney. Ex parte Ranks, 38 O. G. 329, C. D. 1887.

4. The regular course would be for such principal attorney to nominate his associate upon the written authorization of his client. Id.

5. The nomination of an "associate attorney" made by applicant without the consent of the principal attorney cannot be recognized or acted upon. Id.

6. When two or more attorneys are empowered to act in a case, the applicant should designate with which correspondence should be held. Ex parte Jewett, 38 O. G. 781, C. D. 1887.

7. Failing to do this, the office will, if either reside in this city, recognize the resident attorney. Id.

8. Practitioners before the patent office are not required to be learned and experienced lawyers, or to possess any special qualifications. Consequently greater indulgence should be shown applicants in matters touching the management and presentation of their cases. While the rules and practice of courts of equity govern here as far as applicable, cases may arise in which they should not be rigidly enforced. Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

9. The attorney appointed by an inventor who has assigned his interest is recognized in conduct of the case until the assignee asserts his right to appoint another. Ex parte Baker, 49 O. G. 1363, C. D. 1889.

10. Until an assignee of the entire invention asserts his right to hold correspondence with the office to the exclusion of the inventor, it is the practice of the office, to be deviated from only in exceptional cases, to recognize a correspondingly exclusive right on the part of the attorney of the inventor. Id.

11. Where it appeared that an appeal, taken under rule 147 by counsel who had repeatedly appeared in the case, was taken in season and with authority of appellant, and the appeal fee had been paid and accepted by the office, such appeal was not dismissed simply because the power of attorney of said counsel had not been filed, as called for by rule 18, and the attorney of record was permitted to sign the appeal *nunc pro tunc*. Pitney v. Smith & Egge, 49 O. G. 129, C. D. 1889.

12. An attorney appointed by a person holding under an assignment granting all right, title and interest save as to a certain combination set forth in the instrument, will not be recognized in the prosecution of the application. Ex parte Hunter, 56 O. G. 929, C. D. 1891.

13. Where one of two joint applicants subsequently files a sole application for the same improvement, a power of attorney, executed by the other of the joint applicants and their assignee, will be accepted by this office as sufficient in the joint case. *Ex parte Benjamin and Bailey*, 59 O. G. 298, C. D. 1892.

(NOTE.—This decision has not affected the practice of the office in refusing to recognize in a joint application a power of attorney given by one of the joint applicants.)

14. It is not ordinarily within the discretion of the commissioner of patents to prevent revocation of a power of attorney by an applicant. *Ex parte Gallatin*, 59 O. G. 1104, C. D. 1892.

15. Where objection was made to the validity of a patent because of an amendment made by the attorneys after the applicant's death, no new power of attorney having been filed at the patent office and no administrator having intervened and filed a new oath, *held*, (1) the amendment was within the scope of the original specification and required no new oath; (2) it appearing that the attorneys had power in fact to act, and that their acts were subsequently ratified by both administratrix and assignee, the amendment did not invalidate the patent. (*Distinguishing Eagleton Mfg. Co. v. West*, 27 O. G. 1237, 111 U. S. 490.) \**De La Vergne Refrigerating Machine Co. v. Featherstone*, 62 O. G. 741, C. D. 1893.

(NOTE.—In an opinion delivered by the assistant secretary of the interior department, John M. Reynolds, under date of September 4, 1894, addressed to William Lochren, Commissioner of Pensions, it was held that "where a firm of attorneys has been prosecuting a claim for pension, and before the completion of the claim one of said attorneys dies, the surviving partner will not be required to obtain a new power of attorney in his own behalf to entitle him to recognition in such claim, but he will be allowed to complete the same in the name of the firm." (Vol. 8, Pension Decisions, p. 280.) The above doctrine had been practically applied (by Ass't Com'r S. J. Fisher) in at least one case in the patent office.)

In a previous case it was held that where an attorney dies, leaving pension claims pending which he was entitled to, his personal representative will not be recognized to complete such claims. *In re J. Ambler Smith, Attorney, deceased*—Sam. H. Lewis, Administrator, vol. 7, p. 69.)

16. The assignee of an entire interest may control the appointment and dismissal of an attorney to the exclusion of the applicant; but when an applicant joins with an assignee of less than the whole interest, or with the grantee or a licensee, in making a power, it will require the co-operation of both to revoke it. *Ex parte Anderson*, 62 O. G. 449, C. D. 1893.

17. When an applicant alone makes a power of attorney he may revoke and appoint anew, to the exclusion of every one except the assignee of the whole interest. *Id.*

18. It is the uniform practice of the office in a case of dispute between an attorney and an assignee,—unless he is an assignee of entire interest, unless the power is coupled with an interest, or unless the assignee has joined in appointing the attorney,—to recognize the attorney of the applicant only. *Protest of the New Era Iron Works Co.*, 62 MS. D., Oct., 1897 (*Greeley, Ass't Com'r*).

19. A power of attorney given by an alleged assignee will not be entered in a case where the assignment fails to properly identify the application. *Ex parte Rudolph Chillingsworth*, 62 MS. D. 1, July, 1897 (*Greeley, Ass't Com'r*).

20. A power of attorney, coupled with a promise to pay to the attorney ten per cent. of all money received for the invention, does not give him such an interest in the invention as to render the said power of attorney irrevocable, since, although such power was given for valuable consideration, the interest which the attorney has in the invention exists *in futuro*, and is an equitable, not a legal, interest. *Ex parte Firsching*, 80 O. G. 1272, C. D. 1897.

## II. DISBARMENT OF.

21. The relation which a patent solicitor sustains to the commissioner of patents is not the same as that which a member of a bar sustains to a court. The commissioner is not a member of the judiciary, practitioners are not members of a court of which the commissioner is judge, nor does the commissioner have the authority or jurisdiction of a judge in a similar proceeding. *In re John Wedderburn and John Wedderburn & Co.*, 81 O. G. 159, C. D. 1897.

22. The respondent corporation having by advertisements, by their pamphlets and letterheads, and by the whole tenor of their correspondence with clients, put themselves before the public as patent attorneys, cannot be heard to deny that they are in fact subject to the jurisdiction of the commissioner simply because they are in fact a corporation not legally competent to practice law. *Id.*

23. In proceedings under a rule to show cause why an attorney should not be disbarred, it is not necessary that the rules of evidence applicable in criminal proceedings be strictly observed, such proceeding being in its nature civil. (*Ex parte Wall*, 107 U. S. 265.) Nor is it

necessary in proceedings of this nature that offenses be proved beyond a reasonable doubt. It is sufficient if the investigation be conducted with fairness and the respondents be afforded ample opportunity to explain the transactions on which the charges were based and to vindicate their conduct in reference thereto. (*Randall v. Bingham*, 7 Wall. 523.) *Id.*

24. Since disbarment proceedings in this office are not *quasi-criminal* in character, the failure of a respondent in such proceedings to appear and testify in his own behalf, as well as his failure to exhibit to the inspection of the office the organization and details of his business, may properly be made subjects for consideration in arriving at a conclusion. *Id.*

25. When an attorney is charged with dishonest practices before this office, since the character of such practices is peculiarly within his own knowledge, it is not only competent for him to testify concerning them, but it is his duty to himself, to the patent office and to the public to show, if he can, that such practices are legitimate and proper. *Id.*

26. It appearing that while applications for patent were filed in the name of J. W. as attorney all correspondence with clients was carried on in the name of the corporation, J. W. & Co., J. W. being the president thereof, J. W. is to be considered as merely the agent of the corporation, and the corporation must and should be held responsible for his acts. *Id.*

27. The name of J. W. having appeared continuously since 1893 on papers filed in this office, he cannot be presumed to be ignorant of the requirements of attorneys or agents practicing before this office. As president of the corporation he must be held to have been cognizant of and responsible for whatever has been done by the corporation or its employees. *Id.*

28. If it were true that a solicitor might falsely and deceitfully obtain business from clients, might utilize the offer of the government to grant patents to defraud citizens, might advise the public falsely that advice would be given free, and might fraudulently induce clients to intrust the prosecution of claims to him without notice of such things being taken by the head of the proper department, the result would be the organization of combines of confidence men to plunder the public. It is the duty of the head of each department to protect the public in its relations to such department. *Id.*

29. A prize competition open only to those

who have paid money to the respondents clearly has nothing philanthropic or generous about it, is not intended for broadly stimulating invention, but is intended solely to boom respondents' business. It is necessary to a fair competition that the jury or board of awards should be impartial, disinterested men, competent to decide on the merits, and it is also necessary that such jury or board should see and examine the invention submitted. To permit the merit of inventions to be finally passed upon by inexperienced and incompetent searchers is to make the competition a mere farce and a fraud. *Id.*

31. An offer to advise free as to patentability and salability of any device a supposed inventor who had failed to respond to J. W. & Co.'s first letter with its accompanying papers, in view of the fact that the advice given was a mere statement that the device was of a patentable nature, but to determine its patentability a search at a cost of five dollars would have to be made, and a statement that a successful device of this nature, if patented immediately and properly handled, would net its owner not less than so many thousand dollars, is deceptive and a mere trick to reopen correspondence with the inventor to lead him on to send fees to J. W. & Co. *Id.*

32. It is the duty of an attorney to report the result of a search fully and correctly to the inventor. A false and misleading report upon a search is as grossly deceptive as such a report would be if no search had been made. When references exist which approach the invention so closely as to throw doubt on the advisability of taking out a patent, they should be called to the inventor's attention, even though they do not completely anticipate. *Id.*

33. The failure to revise the favorable reports of unskilled searchers indicates reckless disregard of the rights of clients, indifference to the agreement as to the character of the search, and intended fraud. It was the duty of respondents to have had reports made under such circumstances revised. *Id.*

34. The respondents were bound by their agreement with their clients to have searches made properly. Their failure to do so is gross and inexcusable negligence. They must be held responsible for the acts of their employees in making these searches, particularly as the system under which the searchers worked was of respondents' creation. *Id.*

35. The sending of favorable reports by personal direction of J. W. in cases in which ref-

ferences had been found by searchers, without waiting to obtain copies of these references, was nothing less than a deliberate fraud upon the clients and amounts to gross misconduct. *Id.*

36. A report of search which, while citing an anticipating reference, included a request to send on money for fees, and a promise, on receipt of fees, to prepare the necessary application papers and an offer to find a purchaser, is not an unfavorable report and was not intended to be understood by the client as an unfavorable report. It is upon its face a deceptive and fraudulent report. It was intended to deceive and mislead the client. Its use, followed up by the acceptance of fees for the preparation of application papers, is clearly gross misconduct. *Id.*

37. The propriety of an attorney or solicitor of patents combining the business of soliciting with that of selling patents is questionable. Doubtless it may be done honestly; but propositions for undertaking the sale of inventions which require the payment of a fee in cash in advance are justly condemned. *Id.*

38. Advice to take out foreign patents should be given to clients only in those cases in which it is clear that such patents will be of advantage to the clients. In cases in which the invention is not patentable, the advice to take out foreign patents presents a plain case of attempt to defraud the client for the benefit of the attorney. That this is gross misconduct is not open to question. *Id.*

39. Studious concealment from the client of the true condition of his case, or positive misrepresentation of the condition of the case, in each case representing the condition of the case more favorably than the facts justified, while at the same time the attorney is urging the taking out of foreign patents or the payment of fees to the attorney for advertising the invention for sale, is gross misconduct. *Id.*

40. An attorney is bound to inform his client of such steps in the progress of the case as he should know, and he should at least tell the truth and treat his client with candor when he does inform or advise him in regard to his case. If he does not do so, and is at the same time urging further expenditure of money for purposes which he knows cannot result in advantage to the client, his misrepresentation of the condition of the case is conclusive evidence of fraud. *Id.*

41. A letter merely stating to a client that

his application is finally rejected and the only course open is to appeal, without explanation of the references, information as to the grounds of the rejection, or advice as to the wisdom of appealing, such as a capable and honest attorney is bound to give his client, is not such a letter as in fairness and justice to clients should be written. *Id.*

42. An attorney is employed because he is of greater skill and experience in prosecuting applications than his client. He is bound to give his client the advantage of his skill and experience. When he not only fails to do so, but omits that duty for an unworthy purpose, he is guilty of gross misconduct. At so critical a period in the case as that at which the question of appeal has to be considered, the client is entitled to the best information and the best judgment of the attorney. *Id.*

43. For persons who represent themselves to be attorneys of experience in practice and skilled in patent matters to accept appeal fees in cases in which they know there was nothing patentable and appeal would be useless, without hesitation or explanation, purposely keeping the client in ignorance of the true significance of the examiner's rejection and thus misleading them as to the possibility of favorable action on appeal, is gross misconduct. *Id.*

44. An attorney who, after repeated assurances to his client that he would do his best on the appeal, fails to appear to argue the case orally and fails to even file a written brief, is guilty of gross negligence. *Id.*

45. To award an inventor a silver medal and to state to him that his invention is of special merit and promises to be exceedingly profitable, when the invention is known to be unpatentable and therefore worthless, and to subsequently accept fees for the preparation of an application therefor, shows that the medal was sent intentionally and for a definite purpose, and such award is deceptive and fraudulent and amounts to gross misconduct. *Id.*

46. Even if the silver medals had been sent only in those cases on which favorable reports had been made by the searchers, the fact that such medals, together with the accompanying award-letter, were sent in eleven thousand cases shows that many inventors whose inventions were in no sense remarkable, in no sense valuable, and in no sense such as would be selected by any competent or honest board of awards, received these medals, and that the

respondents in sending medals in these cases were guilty of grossly deceiving a large number of their clients. *Id.*

47. It appearing that in each of twenty cases \$5 more than the fees agreed on was asked for and paid to the respondents and not returned by them, *held*, that this excess could not have been called for by mistake, and it is not seen that the retention of this excess is anything less than petty cheating. *Id.*

48. An attorney who files several successive applications for the same unpatentable invention, in behalf of different clients to whom he has successively reported such invention patentable, is either grossly negligent or has committed a grave offense against law and morals. *Id.*

49. Persons in the employ of an attorney who has been engaged in fraudulent practices, when, being in responsible positions, they have co-operated and assisted in carrying forward such practices, and when, in view of prior experience, such persons must be presumed to have been aware of the nefarious nature of such practices, must be held to be sharers in his guilt and with him be held unfit to practice before this office. *Id.*

50. Section 4 of the act of July 4, 1884, applies to agents or attorneys before the patent office as well as before the other bureaus of the interior department. \**United States ex rel. Wedderburn v. Bliss, Secretary of the Interior, 81 O. G. 1783, C. D. 1897.*

51. The proper construction of section 487 of the Revised Statutes is that a person to be disbarred is entitled to notice of the charges against him and an opportunity in some form to be heard in relation thereto prior to any decision of the commissioner or approval by the secretary. Any other construction would render the section void, as being in conflict with that part of the fifth amendment to the constitution which provides that no person shall "be deprived of life, liberty or property without due process of law," and this is the construction very properly given that section by the commissioner of patents and the secretary, as shown by the practice under it. \**Id.*

52. The only difference between section 487 of the Revised Statutes and section 5 of the act of July 4, 1884, is that the act of July 4, 1884, directs that the order disbaring an agent or attorney from practicing before the patent office shall be made by the secretary of the interior, while section 487 provides that it shall be made by the commissioner of patents with the approval of the secretary. The only sub-

stantial difference between the two sections is that section 5 applies to all the bureaus of the interior department, while the section of the Revised Statutes applies only to the patent office. \**Id.*

53. Where an agent was furnished with a copy of charges made against him before the commissioner of patents as to why he should not be disbarred from practicing as a patent agent, and he had a hearing before the commissioner of patents on these charges and the commissioner recommended that he be disbarred from further practicing as an agent or attorney, and the secretary approved the reasons given by the commissioner of patents without affording the agent a hearing before him in person, *held*, that the refusal of the secretary to hear oral argument was not arbitrary, oppressive or unjust and the proceeding before him was conducted under "due process of law." \**Id.*

54. The proceeding before executive and ministerial officers and special tribunals exercising quasi-judicial powers in order to constitute due process of law need not be as formal as in courts of justice or conducted after the manner of proceedings in such courts. What would be due process of law before such officers and tribunals might not be considered such in a court of justice. What is due process of law in a particular case depends largely upon the nature and object of the proceeding, the duties and the jurisdiction of the officer or tribunal, and the nature of the right or immunity to be affected by the proceeding. If the mode of procedure be such that the party to be affected has an opportunity of presenting to the officer or tribunal in any reasonable way his contention as to the facts and merits of the question to be determined, the proceeding is due process of law; but if the determination be made in an arbitrary, oppressive or unjust manner so that the party to be affected has no reasonable opportunity for hearing, then the proceeding and determination are void because not due process of law. \**Id.*

55. Upon a demurrer to the petition for writ of *mandamus* to compel the secretary to grant a hearing in person to a patent agent whom the commissioner had recommended to the secretary for disbarment, the reasons for which recommendation the secretary had approved without a hearing before him in person, *held*, that the demurrer should be sustained, the rule to show cause discharged, and the petition for writ of *mandamus* dismissed. \**Id.*

## CANCELLATION OF PATENT.

1. The court, adopting the conclusions of Judge Shepley, of the same circuit (*Attorney-General v. Rumford Chemical Works*, 2 Bann. & Ard. 298, 9 O. G. 1062, C. D. 1876, 391), are of the opinion that the government, in the absence of any express enactment, has no power to bring a bill to cancel a patent. \**United States v. American Bell Telephone Co.*, 41 O. G. 123, C. D. 1887.

(Decision of U. S. Cir. Ct.—Dist. of Mass.)

2. The constitution and acts of congress cover all the rights and remedies of patentees, and under the constitution congress could have provided for suits to cancel patents; but congress has not made such provision. \**Id.*

3. The history of patent legislation under the constitution tends to show that congress never intended to include suits to annul patents under the present patent laws. \**Id.*

4. The power to bring *scire facias* under the acts of 1790, 1793, to cancel patents was limited to patents obtained surreptitiously or upon false suggestion, and by the act of 1836 and the terms of the patent law as it now stands and has been construed by the supreme court the same defenses may now be made in a suit for infringement as were grounds for the cancellation of a patent under the acts of 1790, 1793. \**Id.*

5. The power of the government to bring suit for the cancellation of a patent does not exist by implication springing from the general principles of equity jurisprudence arising out of the procedure in England, because the foundation of the patent system in England differs from that in the United States, the one being a matter of royal favor, the other of constitutional statutory provisions. \**Id.*

6. The decisions of the courts upon cancelling patents for lands do not apply to patents for inventions, because the government is the owner of the public lands, while patents for inventions are based on statutes, and the inventions described in them never belonged to the United States. \**Id.*

7. In the various suits for the cancellation of patents for lands in the circuit courts such patents have been repealed for fraud, error or mistake, and the same is not limited to cases in which the United States has a direct pecuniary interest. \**United States v. American Bell Telephone Co.*, 45 O. G. 1311, C. D. 1888.

(Decision of U. S. Sup. Ct.)

8. In both instances the essence of the right

of the government to interfere is the obligation to protect the public from a grant procured by fraud. \**Id.*

9. In this case, although the court was called upon only to decide that an individual could not bring a suit to repeal a patent, the reason given for so doing must be held to establish the principle that the individual could not bring such suit, because the government alone could do so. \**Id.*

10. The United States in granting patents to Bell, if the same were granted improperly, took away enormously valuable rights from the people and conferred them upon the patentee. The government that did this wrong to the people certainly had the right to correct the error of its own officers, and the way for doing so seems clearly to be by suit in equity. \**Id.*

11. The broad and conclusive effect of a decree to repeal a patent is so widely different, so much more beneficial, and so much more likely to secure complete justice than any defense made by an individual infringer that it is impossible that congress in granting certain rights to the individual intended to supersede or take away the more enlarged remedy of the government. \**Id.*

12. Letters patent No. 463,569, granted November 17, 1891, to Emile Berliner, for a combined telegraph and telephone, cannot be declared invalid on the ground that the delay of the application in the patent office for thirteen years was unlawful and fraudulent. *United States v. American Bell Telephone Co. and Emile Berliner*, 79 O. G. 1362, C. D. 1897.

13. Congress has established a department with officials selected by the government to whom all applications for patents must be made, has prescribed the terms and conditions of such applications, and intrusted the entire management of affairs of the department to those officials. When an applicant for a patent complies with the terms and conditions prescribed and files his application with the officers of the department, he must abide their action, and cannot be held to suffer or lose rights by reason of any delay on the part of those officials, whether reasonable or unreasonable, unless such delay has been brought about through his corruption of the officials, or through his inducement, or at his instance. Proof that they were in fault, that they acted unwisely, unreasonably, and even that they were culpably dilatory, casts no blame on him and abridges none of his rights. \**Id.*

14. Before the government is entitled to a

decree canceling a patent for an invention on the ground that it had been fraudulently and wrongfully obtained it must establish the fraud and the wrong by testimony which is clear, convincing and satisfactory. \*Id.

15. When the evidence does not tend to show any corruption by the applicant of any of the officials of the department or any undue influence exerted by it upon them, and, on the other hand, does affirmatively show that it urged promptness on the part of such officials and that the delay was the result of the actions of those officials, no presumption of fraud arises. \*Id.

16. If circumstances show that there were reasons for official delay in the prosecution of an application, even though they do not make it clear that such delay was wholly justified, such reasons deserve consideration. \*Id.

17. Suits may be maintained by the government in its own courts to set aside one of its patents, not only when it has a proprietary and pecuniary interest in the result, but also when it is necessary in order to enable it to discharge its obligations to the public, and sometimes when the purpose and effect are simply to enforce the rights of an individual. In the former cases it has all the privileges and rights of a sovereign. The statutes of limitation do not run against it. The laches of its own officials does not debar its right. But when it has no proprietary or pecuniary result in the setting aside of the patent, is not seeking to discharge its obligation to the public, when it has brought the suit simply to help an individual, making itself, as it were, the instrument by which the right of that individual against the patentee can be established, then it becomes subject to the rules governing like suits between private litigants. \*Id.

18. The objection to the validity of a patent on the ground that it was already covered by another patent is a defense which, under the statutes (sec. 4920, R. S.), is open to every individual charged by the patentee with infringement, whether the proceeding against him be an action at law or a suit in equity. The government, therefore, if seeking simply to protect the right of an individual, ought not to be permitted to maintain a suit to cancel that against which the individual has a perfect legal defense available in any action brought by or against him. \*Id.

19. It is unnecessary to determine whether there are two separate inventions in the transmitter and the receiver, or whether the patent

of 1891 is for an invention which was covered by the patent of 1880. The judgment of the patent office, the tribunal established by congress to determine such questions, was adverse to the contention of the government, and such judgment cannot be reviewed in this suit. \*Id.

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### CAVEAT.

1. The examiner refused to receive a caveat for a design, knowing that there was no law authorizing the filing of caveats for designs. Applicant petitions the commissioner to direct that the filing-fee be returned to him. Section 4902 of the Revised Statutes, providing for the filing of caveats for any new invention or discovery, does not apply to the subject of designs, nor is there any statute authorizing the filing of caveats for this class of inventions. *Ex parte Carty*, 44 O. G. 570, C. D. 1888.

2. A design invention covers the form, contour or ornamentation, and such design cannot exist in an incomplete condition. A patent when issued covers all the dominant and controlling features, all the distinct and segregable parts. Petition granted and fee ordered to be returned to applicant. *Id.*

3. Decision in *Ex parte Kenney* (C. D. 1869, 97) considered and modified and the following practice directed: Whenever an application is filed showing subject-matter interfering with any pending caveat, the notice which the statute provides shall be sent to the caveator should be sent at once and not delayed until the invention shall have been favorably passed upon and the application found to be ready for allowance. *Ex parte Ward*, 46 O. G. 1513, C. D. 1889.

4. The statute confers no rights upon the caveator, nor does it give him any status in the office as an applicant. It extends, as matter of grace, to him the right to be notified of the pendency of an application relating to the subject-matter of his caveat. It is not intended that he shall have the benefit of an examination of his caveat before he has filed an application, which substantially results when the notice is withheld until the patentability of the invention of another applicant is determined. *Id.*

5. A caveator should not be allowed to delay issuance of a patent to an applicant who has diligently prosecuted his application. *Id.*

6. The statute authorizing the filing of a caveat does not intend to confer upon the caveator any right as an inventor, nor to save him



from the effect of negligence or give him any advantage over any other inventor who has conceived the invention and prosecuted his application with diligence. The statute authorizing a caveat does not compel a caveator to file any application. It is not intended as a stimulus to prod and drive him to perfect his invention, nor is it intended to extend the time in any manner within which he may complete the invention; but it simply provides as matter of grace that the caveator shall be notified of the filing of any application which comes into the office within a year, covering the subject-matter of his caveat. *Elges v. Miller*, 46 O. G. 1514, C. D. 1889.

7. *Held*, that the law does not require that a caveat shall give a complete and accurate description of the construction and details of an invention. *Green v. Hall, v. Siemens, v. Field*, 47 O. G. 813, C. D. 1889.

8. After a caveat has been filed by joint caveators and afterward an application for the same invention is filed by one of the caveators, and a written abandonment of the caveat has been filed, it is improper to require him to furnish evidence showing that he is the sole inventor. *Ex parte Drury*, 56 O. G. 1447, C. D. 1891.

9. Section 4902 of the Revised Statutes provides for the filing of caveats and limits their operative term to one year; but it does not limit the condition of secrecy on the part of the office to that term. *Ex parte Pollok*, 59 O. G. 939, C. D. 1892.

10. Under the provisions of section 4902 of the Revised Statutes the commissioner has no power to extend the time within which a caveator may avail himself of his caveat, by filing an application for patent, beyond three months from the time of placing the notice in the post-office at Washington, with the usual time required for transmitting it to the caveator added thereto. *Ex parte Moore*, 63 O. G. 463, C. D. 1893.

11. A caveator is not entitled to notice of the renewal of an application originally filed before the caveat, although such renewal was made during the life of the caveat. *Ex parte Graves*, 65 O. G. 2059, C. D. 1893.

12. Change of the filing date of a caveat refused, where, in payment of the fee, petitioner's attorney had returned unindorsed a draft received from the office and which had stood to his credit. *Ex parte Sullivan*, 58 MS. D., Feb., 1896 (*Fisher, Ass't Com'r*).

(A caveator is entitled to notice after expiration of the caveat in the case of an application filed during the term

of the caveat but whose patentability was decided subsequently. *In re Kenney*, C. D. 1869, p. 97.

A caveator should be notified in the case of an application filed the same day as his caveat. *In re Essex*, 9 O. G. 497, C. D. 1878.

It is sufficient if a caveat is signed by but one of two or more joint inventors. *In re Gray*, 12 O. G. 396, C. D. 1877.)

## CLAIMS.

(See PATENTABILITY; PATENTS.)

- I. ALTERNATIVE.
- II. ARTICLE DEFINED BY PROCESS.
- III. DUPLICATE OR REDUNDANT.
- IV. FOR EQUIVALENTS.
- V. FUNCTIONAL AND INDEFINITE.
- VI. GENUS AND SPECIES.
- VII. "MEANS," "MECHANISM," ETC.
- VIII. REINSTATEMENT OF.
- IX. "SUBSTANTIALLY AS DESCRIBED;" "AS SHOWN AND DESCRIBED."

### I. ALTERNATIVE.

1. A claim having the phrase "one or more" is alternative in form, if the elements covered by such phrase are not duplicates. *Ex parte Hulbert*, 63 O. G. 1687, C. D. 1893.

2. When the alternative devices specified in the claim are duplicates, an objection of alternativeness to the form of the claim is apparent rather than real, and therefore should not be made. *Ex parte Thorsen*, 63 O. G. 1688, C. D. 1893.

3. *Ex parte Hulbert* (63 O. G. 1687) referred to and the distinction between it and the present case pointed out and defined. *Id.*

4. A claim in which several elements are recited, and containing the clause "whereby a dynamo or telegraph sounder may be made as desired," is not alternative. The result only is alternative. *Ex parte Crowell*, 62 MS. D., Oct., 1897 (*Greeley, Ass't Com'r*).

### II. ARTICLE DEFINED BY PROCESS.

5. A claim for an article of manufacture should not, as a rule, be defined by the process of producing it; but when an article of manufacture is a new and useful thing and embodies invention and cannot be properly defined except by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule. *Ex parte Painter*, 67 O. G. 999, C. D. 1891.

### III. DUPLICATE OR REDUNDANT.

6. Where a simple invention is made the subject of numerous claims, differing in mere methods of expressions, with no corresponding difference in the concrete subject-matter, the office should insist that one claim only be allowed for a given subject-matter of invention, and that mere differences in phraseology shall not be regarded when urged in defense of a needless multiplication of claims. *Ex parte Johnson*, 54 O. G. 505, C. D. 1891.

7. The question of redundancy or multiplicity of claims is one of form and not one involving the merits; hence the proper remedy is by petition to the commissioner. *Ex parte Sawb*, 54 O. G. 1561, C. D. 1891.

8. The matter to be determined is not whether the several claims standing alone would be patentable as against the public. It is conceivable that each one of the claims standing alone would be an entirely valid claim, and yet that sound principle would require that not all of them should be allowed. *Id.*

9. The danger and impropriety of covering the same structure by a number of claims, which can be differentiated only by abstruse and metaphysical distinctions, are apparent. *\*Brush Electric Co. v. Electrical Accumulator Co.*, 56 O. G. 1334, C. D. 1891.

10. While the five claims in suit are all to the same devices, arranged in a single combination, being only different expressions of that combination, and it may be that there is no essential difference between them, the court does not deem it necessary to consider how far they may be distinguished from each other, but holds them all valid. *\*Illinois Watch Co. v. Robbins & Avery*, 61 O. G. 721, C. D. 1892.

11. Two claims are not, as a matter of form, substantially alike when corresponding elements are set forth broadly in one and specifically in the other and when one includes an element neither actually nor impliedly included in the other. *Ex parte Baackes*, 63 O. G. 909, C. D. 1893.

(It is admissible to put claims in different forms when one set or form of words would be inadequate to clearly cover the invention and prevent misconception. *Ex parte Woodruff*, 17 O. G. 433, C. D. 1880.)

### IV. FOR EQUIVALENTS.

(See EQUIVALENTS.)

12. The words "or equivalent devices" should not be employed in a claim unless such equivalent devices are clearly described in the speci-

fication. *Ex parte Dolph*, 39 O. G. 239, C. D. 1887.

13. When so clearly described, and when the employment of one in the combination and a grant of patent thereon would be a complete bar to the granting of patent for the same combination with the employment of the other, such words are permissible. *Id.*

(NOTE.—It is settled practice to allow the term "or equivalent" in a claim only when an alleged equivalent is described, and it must be also illustrated in the drawing save in the exceptional case when it is so common and well known as to be unmistakable.)

### V. FUNCTIONAL AND INDEFINITE.

(See CLAIMS — "MEANS," "MECHANISM.")

14. A claim in the following form — The combination of the following elements: mechanism, substantially as described, for . . . ; mechanism, substantially as described, for . . . , etc.—covering four groups of mechanism, condemned as indefinite. Claims covering *all* mechanism which will perform the same functions or accomplish the same result are not sufficiently limited or restricted by the words "substantially as described." Such claims would suppress all further improvements in mechanism that could accomplish the same results. The same principles relative to vague and broad claims prevail in original as in re-issue applications. *Ex parte Paige*, 40 O. G. 807, C. D. 1887.

15. Comprehensive terms and phrases to denote mechanical equivalents are regarded as proper, provided when so used they clearly and distinctly express the invention. The words "means" and "mechanism" may be proper where they refer to mere adjunctive devices readily understood; but in claims for combinations of mechanism composed of several elements the words "means" and "mechanism" alone used as defining the element of invention are vague and definite. *Id.*

16. Applicant claims, broadly, "automatically-operating mechanism to impart alternate fast and slow movements to the driving-shaft" in his needle-grooving machine, but concedes that the principle involved is old, and that this varying movement or motion has been accomplished by an infinite variety of means to an infinite variety of kinds and classes of machinery; but he insists that he is the first in this particular kind of machinery to apply *means* for varying the movement. *Held*, that applicant has only invented improvements upon

mechanism already used to accomplish the same result, and that he must limit his claims to the specific construction by which he obtains this variableness of movement. The courts would undoubtedly construe his patent to cover his specific construction, and to permit such vague and indefinite language in claims would result in misleading the public or in deterring others from entering this particular field of invention, and thus by a species of intimidation applicant would secure a protection to which he is not entitled. *Ex parte Miller*, 43 O. G. 1346, C. D. 1888.

17. When several old elements are brought into close propinquity, and joint operation is effected by means but for which there would be only aggregation and not a combination, such means are the essential invention, and on a claim for a combination with the old elements and such means the terms "power-actuated transfer mechanism" and "power-actuating mechanism" are indefinite and vague. Such means are not mere adjunctive devices, but become new elements in the alleged combination, and must be properly and clearly described. *Ex parte Treat*, 44 O. G. 342, C. D. 1888.

18. A functional claim is vague, uncertain and indefinite, and may be incapable of being understood. When the office objects to such a claim it simply says to the applicant, put your claim in intelligible form and it will receive examination on its merits. *Ex parte Barrett*, 45 O. G. 125, C. D. 1888.

19. The objection that a claim is functional is one of indefiniteness. No one can tell with any certainty what invention is actually covered by a claim which is functional in form until it has received a judicial interpretation. It may be so absolutely functional, and therefore incapable of construction, as to be void, and the court would adjudge it so. In their desire, however, to save a patent the courts might construe and hold it to be a claim for the members or elements set out, if set out with sufficient certainty, which does not seem to be the case in the present claim. Hence, the office in insisting upon its rights to require claims to be framed with sufficient certainty and definiteness acts not only in protection of the public, but as a friend and adviser of the applicant. *Id.*

20. No general rule can be laid down for governing the employment in the claims of patents of such words as "means," "mechanism" and "appliances." It is the object of the

law, as it is the solicitude of this office, to protect inventors and guard their inventions. This object is best secured in the case of patents which represent the maturity of an art by taking care that claims shall be drawn with all reasonable restrictions, so that they shall be valid in spite of everything that is contained in existing patents and of everything previously known or used. *Ex parte Pacholder*, 51 O. G. 295, C. D. 1890.

21. While the statute as interpreted by the courts is not inconsistent with the allowance of the controverted claims, yet the tendency to employ in claims such words as have been under consideration should not be encouraged. *Id.*

22. Where in a claim the language qualifying the word "means" was employed to set forth function and contained no limitation whatever in respect to the construction or mode of operation as distinguished from the result, and the word "means" designated that portion of the claim in which the novelty resided, *held*, that such claim was vague and indefinite and should not be allowed. *Id.*

23. Where in a claim the language following the words "means" and "mechanism" was employed to set forth function, but contained limiting or qualifying words other than those which set forth the result accomplished, *held*, that such claim was not vague and indefinite. *Id.*

24. Words and phrases in combination claims which ascribe functions to enumerated elements do not ordinarily make the claims functional. *Houchens and Marr*, 41 MS. D. (1 G. W. D.), Sept., 1889 (*Mitchell, Com'r*).

25. The specification of function in claims frequently promotes definiteness, but when the claim is so drawn as to ignore construction and cover any and every device which will accomplish the same result, it is functional. *Ex parte Raymond*, 41 MS. D. (1 G. W. D.), Oct., 1889 (*Mitchell, Com'r*).

26. Functional claims are, first, those covering a function, result or effect not a product or composition of matter; second, those covering the function of a machine or apparatus; third, those reciting the functions of elements and not their structure; and fourth, those defining sets of mechanism by statements of the results produced. *Ex parte Knudsen*, 72 O. G. 589, C. D. 1895.

27. Claims of the first class are usually participial in form. *Held* not to be patentable and

should be rejected. (Ex parte Simonds, C. D. 1870, 23; Ex parte Hahn, C. D. 1875, 107; Rob. on Pat., vol. 2, sec. 518, notes.) Id.

28. Claims of the second class are in the form of methods or processes or equivalent expressions. *Held*, should be rejected. (Corning v. Burden, 15 How. 252; Rob. on Pat., vol. 2, sec. 529, notes.) Id.

29. Claims of the third class define the construction as "means," "mechanism" or "devices" for effecting certain results, or define certain named elements or the device by statements of function instead of structure. *Held*, should be objected to if vague or indefinite, or rejected on references disclosing the combination and the functional qualifications, or both. (Ex parte Pacholder, 51 O. G. 295; Morley Sewing Machine Co. v. Lancaster, 47 O. G. 267; Ex parte Halfpenny, 53 MS. D. 489.) Id.

30. Claims of the fourth class define sets of mechanism by the results produced. *Held*, should be objected to and receive action on their merits. (Smith & Egge Mfg. Co. v. Bridgeport Chain Co., 56 O. G. 1449.) Id.

(A functional claim is properly one that has for its subject the performance of an act merely, and not the means by which that act is executed. In re Hahn, 8 O. G. 597, C. D. 1875.)

## VI. GENUS AND SPECIES.

(See EXAMINATION OF APPLICATION—REJECTION; AMENDMENT OF APPLICATION—ELECTION AND DIVISION; DIVISION OF APPLICATION.)

31. Generic and specific claims distinguished from claims for mere improvements upon or additions to an invention which may be generically claimed. Ex parte Smith, 44 O. G. 1183, C. D. 1888.

32. An applicant can show and describe as many different forms of his invention as can be covered by a generic claim, and may also claim specifically the preferred form of the invention. But more than this he is not entitled to do. If applicant can comprehend in some one form of expression the patentable novelty which is common to all of the forms shown and described, he is entitled to employ that expression to cover the generic invention. Ex parte Cook, 51 O. G. 1620, C. D. 1890.

33. An invention embodied in a given structure and restrictedly claimed does not become a different invention when claimed more broadly or generically. Ex parte Edison, 54 O. G. 263, C. D. 1891.

34. Claims which are specific are not severable from so-called fundamental or generic claims, since they are distinguishable only in respect to scope, and are not for different parts of the machine. \*Fassett v. Ewart Mfg. Co., 58 Fed. Rep. 360 (1893).

35. A claim covering a combination of elements is not objectionable in form because the terms employed to designate one of such elements are broad enough to cover either of two devices that differ in structure and mode of operation, but are shown and described as capable of performing the same function. Ex parte Baackes, 63 O. G. 909, C. D. 1893.

36. Where there are combination claims for the structures, one of the structures being specifically set out, such claims should be regarded as combinations of all the enumerated elements, and not as claims for a part only of the elements contained in them. Ex parte Korff, 64 O. G. 1397, C. D. 1893.

37. An inventor may not regard his invention, at the time it is produced, as any broader than his one specific form, but he has, notwithstanding, a right to a broad claim. Hill v. Hodge, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

38. A pioneer inventor is entitled in his patent to a generic claim, under which will be included every species of the genus, and in addition thereto he is entitled in the same patent to make specific claims for one or more species of the genus. \*Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

## VII. "MEANS," "MECHANISM," ETC.

(See CLAIMS, FUNCTIONAL.)

39. The terms "means" and "mechanism" are not outlawed, but they may be too vague and indefinite to be permissible. Ex parte Paige, 40 O. G. 807, C. D. 1887.

40. When the terms "means" or "mechanism" indicate the essential novel element in a combination, they are too vague and indefinite to be allowed. Such means are not mere adjunctive devices, and must be clearly described. Ex parte Treat, 44 O. G. 342, C. D. 1888.

41. In a claim, "mechanism" to effect a certain result is an element of means. \*Brush Electric Co. v. Western Electric Co., 77 O. G. 1273, C. D. 1896.

42. An applicant should be allowed to claim his invention as broadly as possible in view of the state of the art. The use of the term

"means," with the proper qualifying words, is not prohibited by any decision of the office or courts. *Ex parte Weaver*, 81 O. G. 967, C. D. 1897.

43. Where the idea is clearly stated and the combination or relation of parts to produce a desired end is plainly expressed, the breadth of the statement of the claim is no reason for objecting to it. (*Ex parte Knudsen*, 72 O. G. 589.) *Id.*

(Claims are too broad when distinguished from a reference only by the terms "means for" and "mechanism by which." *Ex parte Demming*, 26 O. G. 1307, C. D. 1884.)

### VIII. REINSTATEMENT OF.

(See WITHDRAWAL FROM ISSUE; AMENDMENT AFTER FINAL REJECTION.)

44. A claim canceled upon a requirement for division cannot be reinstated save by due showing of inadvertence, accident or mistake. (*Maxim*, 43 O. G. 506; *Gillette*, 44 O. G. 700.) *Ex parte Carlton*, 62 MS. D., Oct., 1897 (*Greeley, Ass't Com'r*).

### IX. "SUBSTANTIALLY AS DESCRIBED," "AS SHOWN AND DESCRIBED."

45. Claims covering *all* mechanism which will perform the same functions or accomplish the same result are not sufficiently limited or restricted by the words "substantially as described." *Ex parte Paige*, 40 O. G. 807, C. D. 1887.

46. Where the specification described joining the end caps to the outer shell without flanges or projections by tin joints made by soldering with pure tin, and the patentee testified that he adopted a solder of pure tin and dispensed with rivets, the claim to the fountain as a new article of manufacture "in the manner substantially as described" limited the patent to a fountain in which the caps were connected with the outer cylinder by pure tin solder without rivets or flanges. *\*Matthews v. Iron Clad Mfg. Co.*, 42 O. G. 827, C. D. 1888.

47. It is well understood that, while the courts, when construing the validity, scope and extent of the claims in patents, will regard the words "as shown and described" as ever present, and when absent will not construe patents to embrace more than is shown and described, it is the policy of the office while it has control over applications to insist that the form and phraseology adopted and employed by applicants should not be misleading nor unintelligi-

ble to the common people who seek to deal with patent property. *Ex parte Gerard*, 42 O. G. 1235, C. D. 1888.

48. A claim for "The construction of a conically shaped crushing-mill with an eccentric motion as herein described for the purposes and in the manner substantially set forth" is limited to a mill constructed in the manner substantially as set forth, and is not broadly for a conically shaped crushing-mill with an eccentric motion. *\*Gates Iron Works v. Frazer*, 42 Fed. Rep. 49 (1890).

49. Under the closing words of a claim, in this case "substantially as and for the purposes set forth," an element necessary to operation, and on which stress is laid in the description, may be read into the claim or treated as an element thereof by implication. *\*Alaska Refrigerator Co. v. Wisconsin Refrigerator Co.*, 57 O. G. 125, C. D. 1891.

50. The words "substantially as specified" in the claim of a patent are to be given effect, and where the claim read literally would be inoperative their effect is to include in the claim elements or devices contained in the specification that are wanting in the claim. *\*Lee v. Pillsbury*, 60 O. G. 1752, C. D. 1892.

51. The words "substantially as described" concern only the specific elements or things stated in the claim, or the combination which is the subject of the claim. (Cases cited.) *\*McKay & Copeland Lasting Machine Co. v. Claffin*, 58 Fed. Rep. 353 (1893).

52. Where the claim is unambiguous and exact, matter in the description cannot be read into it to change its scope, nor do the words "substantially as described" in the claim open the way to the admission therein of matter only incidentally described or mentioned in the description. *\*Westinghouse v. Edison Electric Light Co.*, 69 O. G. 1774, C. D. 1894.

53. Where a claim is so broad as to appear to seek to appropriate results or functions rather than the means or devices whereby the results are accomplished, but contains the words "substantially as described," etc., *held*, that the claim ought to be sustained, if possible, by regarding it as restricted to the devices disclosed, and the words "substantially as described," etc., therein as necessarily limiting it to the structure disclosed in the specification. *\*Columbus Watch Co. v. Robbins*, 70 O. G. 132, C. D. 1895.

54. When a patented invention shows but a slight advance upon a previous art, the words in the claims "as herein described" and "as described" must be construed closely. (Cases

cted.) \*Davis v. Parkman, 71 Fed. Rep. 961 (1895).

55. When a communication between two parts is desired in a specification, and claimed "substantially as described," it is an essential element of the claim. \*Scarborough v. Neff, 76 O. G. 475, C. D. 1896.

56. The phrase "substantially as described" may indicate a particular construction. \*Id.

57. The words "substantially as described" may be part of a claim and control its construction. They may not be omitted from the claim in order to give it a broader construction. \*Campbell v. Richardson, 78 O. G. 1103, C. D. 1897.

(NOTE.—The phrase "substantially as set forth" is ignored when the admissibility of a claim is made to depend upon it. In re Moule, C. D. 1871, 87; In re Rubens & C., C. D. 1869, 107; In re Collins Co., Assignees, 2 O. G. 617, C. D. 1872; In re Rice, 5 O. G. 522, C. D. 1874.)

### COMITY.

(See PRIOR ADJUDICATION; INJUNCTION; PRIOR JUDGMENT.)

1. The courts of one circuit follow the decisions of another covering the same questions upon the same pleadings and evidence. \*Worswick Mfg. Co. v. City of Philadelphia, 30 Fed. Rep. 625 (1887).

2. It would be very unseemly for one judge of a circuit court to overrule another judge of the same circuit in the same cause, particularly when the first decision had been adopted in other circuits and had not been reversed by the appellate court. \*Bate Refrigerating Co. v. Gillett, 40 O. G. 1029, C. D. 1887.

3. Hammerschlag's patent having been sustained by the courts in a number of contested cases, a proper regard for uniformity of decisions should incline other courts to hold the patent valid against the same, or substantially the same, decisions until all controversy over its validity is put at rest by a decree of the supreme court of the United States. \*Hammerschlag Mfg. Co. v. Bancroft, 40 O. G. 1339, C. D. 1887.

4. Where a court, having general jurisdiction of the estates of decedents, has confirmed a sale by an administrator of a right of action for infringement of a patent owned by the decedent, the order thus made is conclusive upon another court, in which an action is brought by such assignee upon such right of action of the assignee's right to sue, and the latter court

will not inquire whether the former court could, under the statutes of the state, legally sell such assets, or whether the original order of sale was broad enough to include the chose in action. \*May v. Mercer County, 41 O. G. 815, C. D. 1887.

5. Where a patent has been found to be valid by a circuit court at an earlier date upon the same evidence as now exhibited, and since that date the supreme court has defined more strictly the line between mere mechanical skill and the exercise of invention, it is no longer the duty of the last circuit court to follow and adopt the adjudication of the former court. \*Rubber and Celluloid Harness Trimming Co. v. India Rubber Comb Co., 44 O. G. 343, C. D. 1888.

6. The circuit court of the United States for the northern district of Illinois will, under the rule of comity, be governed, as to the infringement of a patent, by prior decisions of other circuits as to the same patent where the proof is the same. \*Thompson v. E. P. Donnell Mfg. Co., 50 O. G. 1208, C. D. 1890.

7. The court not able to arrive at the conclusion reached in the case of Consolidated Roller Mill Co. v. Coombs (48 O. G. 255), from the eastern district of Michigan, sustaining the patent to Gray, No. 222,895, notwithstanding the rule of comity which should prevail between the federal courts in cases involving the same patents. \*Consolidated Roller Mill Co. v. Barnard & Leas Mfg. Co., 53 O. G. 431, C. D. 1890.

8. Where there was a prior decision in the same circuit as that in which the present case was pending against the complainant, pressing with equal binding force as the decision relied upon from another circuit, *held*, that the rule of comity ought not to be invoked to the same extent as in most cases where it has been applied. \*Id.

9. The doctrine of comity does not require a circuit court to enjoin an infringement of a patent on the strength of a decision rendered by another circuit court inconsistent with one of its own decisions in which the same patents were considered. \*Pullman Palace Car Co. v. Wagner Palace Car Co., 55 O. G. 715, C. D. 1891.

10. Where a patent has already been construed by the court in an action, that construction must be accepted in another action by the patentee against a third party where no new defenses are interposed. \*National Folding Box and Paper Co. v. American Paper Pail and Box Co., 58 O. G. 1844, C. D. 1892.

11. The circuit court for the southern district of New York having adjudicated the validity of the second claim of letters patent No. 171,866, for an improvement in paper boxes (41 Fed. Rep. 139), thereafter granted a preliminary injunction, based upon such prior adjudication, against a third party (48 Fed. Rep. 913), no new defenses having been interposed. *Held*, on appeal to the circuit court of appeals for the second circuit, that the prior adjudication would have the same weight with the circuit court of appeals which it had with the circuit court. \*American Paper Pail & Box Co. v. National Folding Box and Paper Co., 61 O. G. 287, C. D. 1892.

12. The rule of comity as between the circuit courts approved; but it does not apply as between the circuit courts and the circuit courts of appeals. The latter courts, while regarding the decisions of the circuit courts with sincere respect, are not bound to follow them, but must base their decisions upon their own independent judgment. \*National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

13. A circuit court should follow the decision of another circuit court upholding a patent, except when new evidence of invalidity is introduced, and in the latter event should confine its investigation to the additional evidence. (National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, 53 Fed. Rep. 367, followed.) \*Wanamaker v. Enterprise Mfg. Co., 63 O. G. 156, C. D. 1893.

14. The rule of comity between circuit courts in respect to decisions in patent cases does not apply to the circuit court of appeals, and the latter court will examine independently all the questions presented by the record. \*Id.

15. The rule of comity is limited to a case involving the same state of facts. (Starling v. Plow Co., 53 Fed. Rep. 119.) \*Pratt v. Sencenbaugh, 64 Fed. Rep. 779 (1893).

16. A decision of the circuit court of appeals sustaining the validity of a patent is not conclusive in a second suit in a circuit court of another circuit involving the same patent, where a different defense is made. \*Edison Electric Light Co. v. Columbia Incandescent Lamp Co., 65 O. G. 133, C. D. 1893.

17. In a suit for infringement of a patent, where it appears that the courts of other circuits have already sustained the validity of the patent as against all the defenses now made, save that of anticipation by reason of certain patents not before in evidence, and have also

found that defendants infringed, the court will accept those decisions and examine only the anticipation alleged. \*National Folding Box and Paper Co. v. Phoenix Paper Co., Limited, 65 O. G. 752, C. D. 1893.

18. Upon general questions of law the views of courts of co-ordinate jurisdiction are always regarded with respectful consideration, but never as controlling. In patent causes, however, conclusive effect is accorded by each of the circuit courts of the United States to a prior judgment of any other of them wherever the patent, the question and the evidence are the same in both suits, not on the ground of comity alone, but with the practical and salutary object of avoiding repeated litigation and conflicting decrees in the courts of the several districts upon matters which, having been once passed upon by a court of first instance, ought to be referred to a court of appeal for authoritative determination. (National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, 53 Fed. Rep. 370.) \*Office Specialty Mfg. Co. v. Winternight & Cornyn Mfg. Co., 71 O. G. 1918, C. D. 1895.

19. "*Prima facie* a decision founded upon one patent not in suit here and another decision founded upon three patents collectively, one only of which is in suit here, the two decisions declaring that an invention used by a defendant who is not the defendant here against the machine of that defendant differing widely in its structure from the one complained of here, cannot be treated as binding in the decision which this court may feel bound to render in the suit at bar." \*Boyden Power Brake Co. v. Westinghouse Air Brake Co., 73 O. G. 1857, C. D. 1895.

20. A federal court follows the rulings of another, especially in patent cases. \*National Harrow Co. v. Quick, 76 O. G. 1574, C. D. 1896.

21. The question whether or not a claim is invalid for want of novelty or utility depends on the evidence in the particular case, and the fact that in a suit in one circuit, upon probably different evidence, a patent was not sustained is no ground for holding it invalid in a suit in another circuit. \*Gates Iron Works v. Fraser and Chalmers, 79 O. G. 2015, C. D. 1897.

22. On an appeal from an order granting a preliminary injunction the case is ordinarily to be treated in the appellate court from the standpoint from which it was viewed by the circuit court, and the decision on the merits by a circuit court of another circuit sustaining the patent is therefore usually of controlling weight

in the appellate court, as it should be in the court below. \*Thompson-Houston Electric Co. v. Ohio Brass Co., 80 O. G. 654, C. D. 1897.

**COMMISSIONER OF PATENTS.**

(See JURISDICTION OF.)

**CONTEMPT OF COURT.**

1. When the defendant below had been fined for contempt in the violation of a preliminary injunction and had given bond, and the proceeding was based on a right which depended on the validity of a patent, the proceeding is reviewable on appeal and in the particular case is not upheld. \*Worden v. Searls, 39 O. G. 359, C. D. 1887.

2. This case remanded to the court below, with directions to dismiss the bill, without prejudice to the power and right of the circuit court to punish the contempt by a proper proceeding. \*Id.

3. An attachment for contempt is a summary proceeding, and the writ is granted only in cases which are free from any reasonable doubt on the law or the facts. \*Bate Refrigerating Co. v. Gillett, 39 O. G. 833, C. D. 1887.

4. Where a preliminary injunction to restrain the infringement of patent-rights is granted on condition that a bond be filed by the plaintiff, and the defendant was present in court at the time the order was read and approved, and the complainant then exhibited the form of bond which he was required to give, and stated that the bond would be filed as soon as the surety's signature could be obtained, and it was, in fact, filed on the same day, the defendant cannot, in proceedings to punish him for contempt in committing a breach of the injunction, plead in justification that he was ignorant of the filing of the bond, it being his duty, without notification, to ascertain whether the bond had been filed or not. \*Burr v. Kimbark, 40 O. G. 246, C. D. 1887.

5. Where the principle involved in a patent is the point in issue in a suit to restrain its infringement, the defendant will commit a breach of preliminary injunction and be punishable for contempt where, for the purpose of evading the injunction, he continues to manufacture articles involving the same principle with but slight modifications of structure. \*Id.

6. While upon an examination of the contract under which defendants claimed to be

licensees it is found insufficient to support such claim, still, as it is apparent that defendants acted in good faith, under the belief that they were authorized by said contract, and ceased manufacture upon the commencement of these proceedings, they should not be punished as guilty of wilful contempt. \*Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co., 40 O. G. 578, C. D. 1887.

(See Pennsylvania Diamond Drill Co. v. Simpson, 48 O. G. 676, C. D. 1889.)

**CONTINUING APPLICATIONS.**

(See DIVISIONAL APPLICATION; SUBSEQUENT APPLICATION; INTERFERING PATENTS.)

1. Where patentee filed an application for a patent January 6, 1879, amended the same frequently, and upon the suggestion of the examiner filed an application December 30, 1879, containing the essential features of the original application, *held*, to be a continuous proceeding dating from January 6, 1879. \*International Tooth-Crown Co. v. Richmond, 39 O. G. 1550, C. D. 1887.

2. Should the executor elect to pay a new fee and file a new application for the invention of the decedent instead of continuing the prosecution of the original application, the application so filed by the executor should be entitled to the same status and precedence in order of examination as the application of the decedent. Such application is merely a revival and continuation of the original application, and should receive the same action and consideration which belonged to the original application had death not intervened and arrested the progress of decedent's case. *Ex parte Smith*, 43 O. G. 505, C. D. 1888.

3. A second application cannot legally be considered a continuation of a first or earlier application by the same inventor unless it contains *the same invention*. *Green v. Hall*, 46 O. G. 1515, C. D. 1889.

4. Where an applicant files a second application as a division of his original application, then incorporates the claims of the original application into the divisional application and formally abandons the original application, *held*, that the whole proceeding is a continuous one, and that public use to bar the patent granted on the second or divisional application must be a public use two years prior to the filing of the original application. \*Dederick v. Fox, 63 O. G. 1963, C. D. 1893.



5. Where an applicant abandoned his rejected application he cannot, in an interference based upon his subsequent application, treat the two applications as continuous. *Hien v. Pungs*, 68 O. G. 657, C. D. 1894.

6. Carty filed an application April 20, 1885. October 21, 1887, the application became abandoned. The present application cannot be held a continuation of the first nor as evidencing constructive reduction to practice of the invention in issue. *Carty v. Kellogg*, 73 O. G. 285, C. D. 1895.

## CONTRACTS.

### I. CONTRACTS.

### II. CONTRACTS ILLEGAL.

#### I. CONTRACTS.

1. Where there is any doubt or ambiguity arising out of the language of an executory contract, the construction given by all the parties to the same is entitled to great, if not controlling, influence. \**Topliff v. Topliff*, 40 O. G. 115, C. D. 1887.

2. The manufacture by complainants under Patent No. 114,885, and the payment of royalties up to 1879, constituted an acceptance of such patent as a substitute for the patent named in the agreement, and the subsequent discovery by the complainants of the insufficiency of Patent No. 110,513 gave them no right to rescind the agreement. \**Id.*

3. The language in the agreement as to "any improvement made in these articles" is not restricted to articles like those described in the patent referred to in the agreement, but embraces articles such as are described in Patent No. 114,885. \**Id.*

4. Complainant was bound by a contract, although he did not sign the written memorandum, and was not mentioned as a party to it, by which suits then pending between himself and defendants over the infringement of patents were to be dismissed, and defendants were to be licensed to use the patented inventions, it appearing that, though complainant did not himself sign the instrument, he participated in the negotiation which led to its being signed, was present at the signing, knew its terms, and intended to allow the parties who did sign to adjust the whole matter, as they were principally interested in effecting a settlement. \**Bean v. Clark*, 40 O. G. 1454, C. D. 1887.

5. A written contract, although inartificially

drawn, obscure, and capable of different interpretations in several particulars, yet its provisions embracing, although in very inadequate terms, every matter which the parties had definitely agreed to, and the circumstances surrounding its execution being consistent with no other conclusion, must be regarded as a completed agreement or contract, and not merely an agreement to agree. \**Id.*

6. An agreement or contract to create an estoppel must be of certain intent and effect, and leave nothing open to conjecture. *Ligovsky v. Peters, v. Hisey*, 57 O. G. 1595, C. D. 1891.

7. The supreme court of the United States has often enforced the rule that, in the absence of fraud, accident or mistake, it must be conclusively presumed that the written contract contains the whole engagement of the parties. (Cases cited.) (In Pennsylvania there has been some relaxation of this rule.) \**Consumers' Gas Co. of Danville v. American Electric Construction Co., Limited*, 50 Fed. Rep. 778 (1892).

8. A contract provided that a corporation should employ a certain patentee as its general manager for ten years, subject to termination by either party on one year's notice, or by the patentee's death or inability to act, and that, in the event of a termination of the agreement, the corporation should have a license to use his patents on payment of a certain royalty. *Held*, that a wrongful discharge of the patentee by the corporation was a mere breach of contract, and did not terminate the agreement so as to render the corporation liable to pay the royalty. (*Johnson v. Signal Co. (N. Y. App.)*, 29 N. E. Rep. 964, followed.) †*Miller v. Union Switch and Signal Co.*, 59 O. G. 633, C. D. 1892.

9. In an action to recover a balance alleged to be due on written contract whereby plaintiff agreed to furnish and set up certain machinery for defendant, the latter set up, among other defenses, that he had been served with notice by a certain patentee of a claim for damages for infringing letters patent by the use of the machinery furnished by the plaintiff. *Held*, that a purchaser of machinery who has had the full use and enjoyment and undisturbed possession of it cannot, in the absence of fraud, withhold the purchase price because of an alleged liability on his part to a patentee for infringement in the use of the property. \**Consumers' Gas Co. of Danville v. American Electric Construction Co., Limited*, 60 O. G. 737, C. D. 1892.

10. It is only a latent ambiguity which may be explained by evidence *aliunde*. \**Id.*

parent upon the face of an instrument must be resolved by the court, resorting, if necessary, to the rule that a grant expressed in doubtful words shall be construed most strongly against the grantor. \*Adriance, Platt & Co. v. McCormick Harvesting Machine Co., 63 O. G. 1688, C. D. 1893.

11. A contract of complainant to furnish defendants "such a number of machines as they desire for their own use at present or hereafter" is of doubtful legal validity for want of mutuality. No duty or obligation is upon defendants to take any number of machines, or do anything except to pay for such as they might desire. \*Columbia Wire Co. v. Freeman Wire Co., 71 Fed. Rep. 302 (1895).

12. The release and settlement of July 27, 1881, examined and held not to be void either for gross inadequacy of consideration or by reason of any false statement or fraudulent concealment on the part of the defendant. The long period during which the settlement was allowed to stand is almost enough to estop the complainant. \*Thorn Wire Hedge Co. v. Washburn & Moen Mfg. Co., 73 O. G. 1411, C. D. 1895.

13. The contracts between the parties held not to import that the defendant should guaranty the payment by the licensees of the royalties, but should exercise reasonable diligence in their collection. \*Id.

14. It appeared that, in an action by L. for royalties, B. & Sons had set up fraud as a defense, and, upon such defense being overruled, had obtained a re-assignment of the contract and tendered the same back to L., L. without offering to return any of the profits made under the contract. Held, that by continuing to treat the contract as existing, after discovering the supposed fraud, and by retaining its fruits, B. & Sons ratified such contract. \*E. Bement & Sons v. La Dow, 74 O. G. 271, C. D. 1896.

15. A contract to pay for articles of manufacture containing a patented improvement is an agreement to pay for articles which by reason of the omission of such unnecessary details of construction as the patented article dispensed with are of a simple and less expensive construction, such as the patent sought to secure, even though such manufactured articles are in other respects unlike the patented article. \*Andrews v. Landers, Frary & Clark, 75 O. G. 510, C. D. 1896.

16. Evidence to show the prior state of the art is admissible to explain the latent ambiguity in the language "containing the patented

improvement," occurring in a contract between manufacturers and a patentee, and as bearing upon the situation of the parties and their object in making said contract. \*Id.

17. Where the parties entered into a contract that a royalty of forty per cent. should be paid on all sales of the machines, and the contract also contained the provision "If the parties of the second part shall sell or lease, or [shall] cause to be sold or leased, for use, or shall cause to be used, in any foreign country [the machines in question], . . . then the royalty to be paid shall be forty-five per cent. in lieu of forty per cent. as hereinbefore provided," held, that this provision is not retroactive and that therefore a royalty of forty-five per cent. should be paid only on sales made after the commencement of foreign sales. \*National Sewing Machine Co. v. Willcox & Gibbs Sewing Machine Co., 76 O. G. 961, C. D. 1896.

18. A court is always bound in construing a contract to look at the entire instrument, even though a conclusion derived therefrom may seem to antagonize the meaning of a particular paragraph of the instrument. \*Fox Solid Pressed Steel Co. v. Schoen, 78 O. G., C. D. 1897.

19. A clause in an agreement regulating the manufacture of center plates in general which prohibits the manufacture of sheet-metal frames during the life of the agreement is secondary and incidental to the main agreement. \*Id.

20. The fact that complainants are engaged in making frames of one species and defendants in making frames of another, and that those of the species made by the defendants are those sought to be restrained, as well as the fact that complainants knew of such manufacture long before they objected, should be taken into consideration in interpreting the contract. \*Id.

21. A clause which finally interdicts the manufacture of a portion of a patented article which may be needed in the repair of such article is in undue restraint of trade and will not be enforced. \*Id.

## II. ILLEGAL.

22. A contract wherein one party, in consideration of receiving a license from the other party to use certain patents during the life of said patents, agrees never to dispute or contest the validity of certain other patents or the licensor's title thereto, is a contract against public policy. \*Pope Mfg. Co. v. Gormully, 59 O. G. 464, C. D. 1892.

23. A corporation or combination organized to regulate and control the price at which a device manufactured under patents may be sold by the members of the combination and to prosecute and defend all suits involving alleged infringement of such patents, *held* to be an illegal combination, and its purposes are violative of sound public policy. \*National Harrow Co. v. Quick, 71 O. G. 608, C. D. 1895.

24. Doubtful whether the present bill for infringement, etc., can be sustained without giving aid to the unlawful combination or trust represented by the complainant; but doubt resolved in such way as will not lend the countenance of the court to the creation of combinations, trusts or monopolies. \*Id.

25. The entire theory and purpose of our patent law: is to create a limited monopoly. The rights so acquired by the patentee are entirely inconsistent with the patentee's being made subject to the provisions of the anti-trust laws of the several states. He has been given, and is entitled to maintain, a monopoly of the patented article or device. (Cases cited.) \*Columbia Wire Co. v. Freeman Wire Co., 71 Fed. Rep. 302 (1895).

26. An exclusive license for a consideration by a corporation to a person assigning to it his patent to manufacture and sell, as agent, upon his own account, subject to uniform terms and conditions, the corporation itself agreeing not to manufacture, is part of an illegal combination and in unwarrantable restraint of trade. \*National Harrow Co. v. Hench & Dromgold, 76 O. G. 2011, C. D. 1896.

27. Combinations between a number of persons engaged in the same general business to prevent competition and maintain prices, being against public policy and illegal, the same principle, notwithstanding the patentee's exclusive control of his invention, is applicable in questions concerning patents. \*Id.

28. While it is true that all contracts in restraint of trade are not prohibited, and it is sometimes difficult to determine whether a particular one is, there is no room for doubt that a contract between patentees and manufacturers of patented articles to prevent competition in business and enhance prices is unlawful. \*National Harrow Co. v. Hench, 81 O. G. 1612, C. D. 1897.

29. The fact that property involved is covered by letters patent cannot be urged as a justification of a contract which enhances prices and restrains trade. Patents confer a monopoly as respects property covered by them, but they

confer no right upon the owners of several distinct patents to combine for the purpose of restraining competition and trade. Patent property does not differ in this respect from any other. \*Id.

30. The fact that one patentee may possess himself of several patents and thus increase his monopoly affords no support for an argument in favor of a combination by several distinct owners of such property to restrain manufacture, control sales, and enhance prices. Such combinations are conspiracies against the public interest and abuses of patent privileges. The object of these privileges is to promote the public benefit as well as to reward inventors. \*Id.

31. A contract based on patent-rights which restrains trade is not justified by the situation of the parties. Their exposure to litigation is entitled to no greater weight. Patentees may compose their differences, as the owners of other property may, but they cannot make the occasion an excuse or cloak for the creation of monopolies to the public disadvantage. \*Id.

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#### COPIES AND INSPECTION OF PATENT OFFICE RECORDS.

1. Whenever a reasonable suggestion of its necessity for the purposes of evidence is made by the person requesting it, the commissioner of patents cannot lawfully refuse to furnish a certified copy of an abandoned or rejected application for a patent. The right to be furnished such a copy is given to the public by statute, and the refusal thereof entitles the applicant to the writ of *mandamus* against the commissioner to compel a compliance with such request. \*United States ex rel. Pollok v. Hall, Com'r of Patents, 48 O. G. 1263, C. D. 1889.

2. An attorney at law who has requested such a copy in behalf of his client and been refused has such an interest in the subject-matter as entitles him to commence proceedings in his own name as relator for the writ of *mandamus*. \*Id.

3. Where petitioners requested that an order be issued permitting them to inspect the abandoned cases in the patent office in order to protect their client from unnecessary expense and suit for alleged infringement of certain letters patent, etc., *held*, that the petition must be denied, although, if the petitioners shall make request for certified copies of one or more abandoned applications, accompanied by a reasonable suggestion of their necessity for pur-

poses of evidence, the request will be granted under authority conferred upon the commissioner by rule 170. *Ex parte Fowler and Fowler*, 49 O. G. 562, C. D. 1889.

4. The case of *United States ex rel. Anthony Pollok v. Hall, Commissioner of Patents* (48 O. G. 1263), distinguished from the case at bar. The question before the court in the case cited was whether a copy of a certain specified abandoned application which had been asked for should be furnished by the commissioner, and it is believed that the court did not intend to decide or to lay down a doctrine which would involve the logical necessity of deciding that a petition like the present should be granted. *Id.*

5. It is not to be conceded that the inventions represented in the abandoned applications of the patent office are the property of the public. *Id.*

6. Where the complaint averred that, on the surrender of the original patent, a new patent was issued to the patentee for the same invention, for the residue of the term then unexpired for which the original patent was granted, and the defendant in his answer denied each and every, all and singular, the allegations contained in the complaint. *held*, that a duly-certified copy of the original patent was relevant evidence upon the question whether the re-issue was for the same invention as the original, and that the issue was sufficiently raised by such averment and denial. \**Oregon Improvement Co. v. Excelsior Coal Co.*, 49 O. G. 1694, C. D. 1889.

7. It is the practice of the office to refuse copies of caveats unless the party filing the caveat shall first consent. (Cases cited.) *Ex parte Spear*, 44 MS. D. (2 G. W. D.), Nov., 1890 (Fisher, Acting Com'r).

8. Section 892, Revised Statutes of the United States, providing for the obtaining of certified copies of any records, books, papers or drawings belonging to the patent office, does not require or authorize the commissioner of patents to furnish copies of pending applications for patents, or of papers connected with such applications. \**United States ex rel. United States Electric Lighting Co. v. Commissioner of Patents*, 54 O. G. 267, C. D. 1891.

9. When an inventor has two applications pending, both covering the same generic invention, and has made a full assignment of one of them, thereby conclusively electing to give the preference to the assigned case and to claim nothing in the unassigned application that is not special thereto, *held*, that he should be al-

lowed to inspect the assigned application in order that he may properly restrict the unassigned application. *Ex parte MacLaughlin*, 55 O. G. 864, C. D. 1891.

10. Because an applicant has been forced to use an application in an interference proceeding to establish a record date, it does not follow that the office should allow any and every one to obtain certified copies of said application. *Ex parte Dyer*, 56 O. G. 1564, C. D. 1891.

11. A party who bases his rights as an assignee upon an instrument recorded in the patent office before application was made and not specifically identifying the invention will not be permitted to examine the files because such an instrument is not an assignment, but a mere executory agreement. *Ex parte Lorentz*, 59 O. G. 158, C. D. 1892.

12. A single uncertified copy of a decision or action by any tribunal of this office will be furnished to an interested party without charge. *Ex parte Failor*, 59 O. G. 630, C. D. 1892.

13. In a petition for *mandamus* against the commissioner of patents where the prayer was for permission "to inspect the abandoned cases in the United States patent office," and was not confined to a specific case, *held*, that no such broad right exists to the public, and writ refused. (Citing *United States ex rel. United States Electric Lighting Co. v. Commissioner of Patents*, C. D. 1891, 271, 54 O. G. 267.) \**United States ex rel. Fowler v. Commissioner of Patents*, 62 O. G. 1968, C. D. 1893.

14. The office is not warranted in furnishing copies of the papers in a pending application except to parties in interest, unless advised by a court of competent jurisdiction, having a case before it, that evidence of this sort within the possession of the office is essential to the proper decision of the case. *Ex parte American Bell Telephone Co.*, 63 O. G. 152, C. D. 1893.

15. The refusal of the commissioner of patents to furnish copies of records, books, papers, etc., to any person making application therefor and paying the fee required by law would subject the commissioner to an action for damages (citing supreme court in *Boyden v. Burke*, 14 How. 576). It is not, therefore, every sort of record or paper the commissioner can protect from inspection and copy. \**Ex parte Drawbaugh*, 66 O. G. 1451, C. D. 1894.

16. Files, papers, etc., in a case appealed to the court of appeals of the District of Columbia are open to the public for inspection and copy. \**Id.*

17. Where, in an interference to prove the

granting of foreign letters patent and the date and contents thereof, certified copies of the records in this office of such letters patent were introduced, *held*, that the commissioner had power to grant such certified copies and that they are proper evidence under sections 892 and 893, Revised Statutes. *Lossier v. Cowles and Cowles v. Boguski*, 71 O. G. 1616, C. D. 1895.

18. After the preliminary statements have been received and approved each party may have free access to the files and papers of the other; but if an application contains a description and claims of one or more inventions not related to the one in issue in such a manner as to affect its scope or meaning, the opposing party should not be allowed to inspect this part of the application. *Zwietusch v. Wittemann*, 74 O. G. 183, C. D. 1896.

19. It is the practice of the office to refuse to give to strangers to the record copies of pending applications without the consent of the applicants or assignees. *Ex parte Stockton*, 79 O. G. 683, C. D. 1897.

20. Some of the records and papers of the patent office are public records, and of these any person is entitled to copies upon paying the usual fee therefor; but there are others not public records, and of these no one is entitled to copies without showing that they are material evidence for him, and the commissioner of patents cannot be required to furnish copies until such showing is made. Abandoned applications are evidently of the latter character. (Section 892, Revised Statutes, construed.) *\*United States ex rel. Bulkley v. Butterworth*, Com'r of Patents, 81 O. G. 505, C. D. 1897.

21. No person is required to submit his private papers to others or produce them in court on the demand of a party to a suit on his allegation or claim that they are material evidence for such party, but only in obedience to the mandate of the court in which such suit is pending; and it is only reasonable that when a public officer has under his control a paper or document in its nature private or such as the public generally is not entitled to have access to as a public record, he should not be compellable to produce it or deliver copies of it until he has some information from the court in which the case is pending that it is required as evidence. *\*Id.*

22. The court in which a suit is pending and not the commissioner of patents is the appropriate tribunal to determine whether a given paper should be produced as evidence; and

where there is no satisfactory showing, as by a certificate of the court, that a paper is proper evidence, the commissioner of patents may refuse copies of such paper, and a writ of *mandamus* will not issue to him to furnish such copies. *\*Id.*

23. In allowing inspection or in furnishing copies of pending cases, the claims will henceforward be withheld from all save parties directly interested or their attorneys. *Ex parte Metzler*, 60 MS. D., Feb., 1897 (Fisher, Acting Com'r).

24. Affirmed upon rehearing, that certified copies of the papers composing an abandoned application may be furnished to interested and proper parties, to determine a question of title; but the papers showing the steps taken in prosecution of the case, having no bearing on the question of title, should not be furnished. *Bates Machine Co.*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

## COPYRIGHT.

- I. IN GENERAL.
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- X. MUSICAL COMPOSITIONS AND LITHOGRAPHS.
- XI. NOTICE.
- XII. PUBLICATION AND SALE.
- XIII. TITLE OF COPYRIGHTED SUBJECT.

### I. IN GENERAL.

1. As to whether the forfeiture to the United States, in section 4965, applies to anything but "painting, statue or statuary," *quære*. *\*Thornton v. Schreiber*, 42 O. G. 1165, C. D. 1888.

2. When a man takes out a copyright for any of his writings or works he impliedly agrees that at the expiration of that copyright such writings or works shall go to the public and become public property. *\*Merriam v. Holloway Publishing Co.*, 53 O. G. 1409, C. D. 1890.

3. The complainants have no special property in "Webster's Dictionary" since the copyright has expired. *\*Id.*

4. The amount of labor or skill in the production does not seem to be material if the proper subject of a copyright is produced and the producer copyrights it. \*Falk v. Brett Lithographing Co., 48 Fed. Rep. 678 (1891).

5. Following Baker v. Selden, 101 U. S. 99, the copyright for a book entitled "Eclectic Short Hand" does not protect the system when considered as such apart from the language which expresses it. \*Griggs v. Perrin, 49 Fed. Rep. 15 (1892).

(Literary merit is not a necessary element of a legal copyright. \*Drury v. Ewing, 1 Bond, 540.)

To be worthy a copyright, the thing must have some value as a composition, sufficiently material to lift it above utter insignificance and worthlessness. Drone on Copyright.

The national copyright system dates from 1790. The law now in force is substantially the law of 1870, although amended several times, notably by the act of March 3, 1891, providing for international registration, and the act of January 6, 1897, relating to performance of dramatic and musical compositions. The transfer of the copyright department to the librarian of congress was in 1870.)

## II. ASSIGNMENT AND LICENSE.

6. A copyright may be assigned as to the whole or undivided part thereof, and may become "the undivided property of joint owners." (Citing Drone on Copyright, 334.) \*Black v. Henry G. Allen Co., Scribner v. Same, 42 Fed. Rep. 618 (1890).

7. A non-resident foreigner is not within our copyright law, but he may take and hold by assignment a copyright granted to one of our own citizens. (Carte v. Evans, 27 Fed. Rep. 861.) \*Id.

8. A license in writing may be given by the proprietor of a copyright to any person, and there is no restriction upon the power of such proprietor to assign or transfer, in equity, an exclusive right to use the copyrighted article in a particular manner or for particular purposes upon such terms and conditions as may be agreed upon. In such case the legal title remains with the proprietor, and the equitable title vests in the other party. (Cases cited.) \*Id.

9. An inchoate right to a copyright may be transferred by parol prior to taking of copyright. (Cases cited.) \*Id.

10. The first edition of the work was copyrighted in the name of Charles Scribner & Co., Proprietors; and the second edition — the one now in controversy — was copyrighted in the name of Charles Scribner's Sons, Proprietors; and, since Mrs. Terhune, whose *nom de plume*

is Marion Harland, settled from time to time with the owners of the copyright for her royalties, the court will presume that her legal title as author was duly conveyed to and vested in the persons who secured the copyright, despite the fact that she was a married woman at the time the copyright was taken. \*Scribner v. Clark, 50 Fed. Rep. 473 (1892).

## III. COPYRIGHTABLE SUBJECTS.

11. The term "book" embraces every character of publication, whether a volume, pamphlet, newspaper article, calendar, or catalogue, following the interpretation in England of a similar English statute. A book of forms may be entitled to copyright protection. Original forms adapted to the requirements of a state statute relating to the sale of liquors are copyrightable. Some learning and some literary labor were required to produce them. (Citing Drone on Copyright, 208-210.) \*Brightley v. Littleton, 37 Fed. Rep. 103 (1889).

12. Since the decision of the United States supreme court in Burrow-Giles Co. v. Sarony, 111 U. S. 53, a photograph which has artistic merits is a subject of copyright. Falk v. T. P. Howells & Co., 37 Fed. Rep. 202 (1888).

13. Although there can be no copyright in the opinions of judges, or in the work done by them in their official capacity as judges, yet there is no ground of public policy on which a reporter who prepares a volume of law reports, of the character of those in this case, can, in the absence of a prohibitory statute, be debarred from obtaining a copyright for the volume, which will cover the matter which is the result of his intellectual labor. \*Callaghan v. Myers, 46 O. G. 565, C. D. 1889.

14. Even though a reporter may be a sworn public officer, appointed by the authority of the government which creates the court of which he is made the reporter, and even though he may be paid a fixed salary for his labors, yet, in the absence of any inhibition forbidding him to take a copyright for that which is the lawful subject of copyright in him, or reserving a copyright to the government as the assignee of his work, he is not deprived of the privilege of taking out a copyright, which would otherwise exist. \*Id.

15. A statistical atlas is a book of maps, tables, and printed texts, and is not simply a bundle of maps. It is properly copyrighted as a whole, and there is no necessity for copyrighting each map separately. \*Black v. Henry

G. Allen Co., Scribner v. Same, 42 Fed. Rep. 678 (1890).

16. A photograph may be the valid subject of a valid copyright for the photographer as the author of it. (Lithographic Co. v. Sarony, 111 U. S. 53.) \*Falk v. Britt Lithographing Co., 48 Fed. Rep. 678 (1891).

17. When a person submits himself or herself as a public character to a photographer for the taking a negative and the making of photographs for the photographer, the negative and the right to make photographs from it belong to him. He is the author and proprietor of the photograph, and by copyright obtains the exclusive right to make copies. (Cases cited.) \*Press Publishing Co. v. Falk, 59 Fed. Rep. 324 (1894).

18. A mere compilation of facts is protected by the copyright law, as well as original matter showing invention. The same facts could be gathered by other than the registrant, but it must be at his own expense and as the result of his own efforts. \*American Trotting Register Association v. Gocher, 70 Fed. Rep. 237 (1895).

19. A book containing credit ratings and the financial standing of stove-dealers and manufacturers, held clearly entitled to copyright. (Lamb v. Evans, 1 Ch. 218, 1893; Leslie v. Young, App. Cas. 335, 1891.) \*Ladd v. Oxnard, 75 Fed. Rep. 703 (1896).

20. Compilations, though involving only industry, and no such degree of originality as is expected from authors of repute, may be protected by the copyright statutes. \*Id.

(A compilation of information that is useful in a counting-room is a proper subject of a copyright. Bullinger v. Mackay, 15 Blatch. 550 (1879).

21. Photographs have been held copyrightable by the supreme court. \*Falk v. City Item Printing Co., 79 Fed. Rep. 321 (1897).

(Copyright protection was extended to photographs and magazines in 1865.

Copyright for playing cards sustained. Richardson v. Miller, 12 O. G. 3, C. D. 1877. A separate registration is required for each card if the designs differ.)

#### IV. NON-COPYRIGHTABLE SUBJECTS.

22. The judicial decisions of the courts are not the subject of copyright, but may be freely published by any one who chooses. It has never been authoritatively decided, however, by the courts of this country whether such de-

isions can be copyrighted by the state. The opinion in Gould v. Banks, 53 Conn. 415, undoubtedly asserts the right of the state to copyright judicial decisions. \*State of Connecticut v. Gould, 34 Fed. Rep. 319 (1888).

23. Plaintiffs made and sold prints and labels to dealers in cigars. They registered as a copyright a picture described by the title "Nosegay." On the prints sold to dealers they substituted "Opera Bouquet" for "Nosegay." *Id.*, section 3 of the act of congress of June 18, 1874, does not authorize such registration of prints and labels. (Schumacher v. Schwenke, 25 Fed. Rep. 466, distinguished.) \*Schumacher v. Wogram, 35 Fed. Rep. 210 (1888).

(A label intended for no other use than to be pasted on vials or bottles containing a medicinal preparation is not the proper subject of a copyright. \*Scoville v. Toland, 6 West L. J. 84; Coffeen v. Brunton, 4 McLean, 516.)

24. A picture designed for an article of manufacture cannot be copyrighted in view of section 3, act of congress of June 18, 1874, which provides for registration of prints or labels for articles of manufacture. \*Schumacher v. Wogram, 35 Fed. Rep. 210 (1888).

25. Speeches, letters and conversations by themselves alone are understood not to be the subjects of a copyright. (Cases cited.) \*Gilmore v. Anderson, 38 Fed. Rep. 846 (1889).

26. Complainants and defendant manufacture furniture which is not patented. Both publish books containing illustrations of their goods, several of which are strikingly similar. Both books are published and used solely as means of advertisement. The complainants cannot have a monopoly in such a case. If the illustrations could be established as intrinsically valuable as works of art independent of their use as advertisements, a very different question would be presented. In view of the doubt, preliminary injunction denied. \*Lamb v. Grand Rapids School Furniture Co., 39 Fed. Rep. 474 (1889).

27. A copyright for a form of a blank statement which the political code of California required in respect to property, held invalid. \*Carlisle v. Colusa County, 57 Fed. Rep. 979 (1893).

28. The statutes, as amended by the act of 1874, limit copyright to such cuts and prints as are connected with the fine arts. Cuts and prints of bath tubs contained in advertising sheets were not contemplated or intended as works of fine art. They are adjuncts simply to a publication connected with a useful art.

\*J. L. Mott Iron Works v. Clow, 72 Fed. Rep. 168 (1896).

29. An advertisement alone is not the subject of copyright. (Citing Drone on Copyright, p. 164.) \*Mutual Advertising Co. v. Rego, 79 O. G. 159, C. D. 1897.

30. A mechanism or device for the storage and indexing of letters is not proper subject-matter for copyright inasmuch as it is not a medium for information or intelligence. The creator of this is not an author within the meaning of the word in the constitution, nor is what he has produced a book. \*Amberg File and Index Co. v. Shea, Smith & Co., 79 O. G. 514, C. D. 1897.

31. Holmes' "The Autocrat of the Breakfast Table," was printed serially in the Atlantic Monthly, and the last part or fragment of it appeared before the title was filed by the author. *Held*, that the copyright is invalid. If the author had published part of the book only and then deposited the title, he might have had copyright protection for the remainder. \*Holmes v. Hurst, 80 Fed. Rep. 514 (1897).

## V. DEPOSITING COPIES WITH LIBRARIAN OF CONGRESS.

32. Francis A. Walker obtained a copyright for an article which was assigned for use as part of the Encyclopedia Britannica. The two copies of Walker's separate work, deposited in the office of the librarian of congress to complete the copyright, were obtained by taking to pieces a bound volume of the work, and taking the sheets which contained the articles and depositing them in the librarian's office; *held* to be sufficient compliance with the statute. \*Black v. Henry G. Allen Co., Same v. Funk, 56 Fed. Rep. 764 (1893).

33. If the copies required to be sent to librarian of congress are mailed *before* publication, they are mailed within ten days of publication. (Cases cited.) \*Falk v. Donaldson, 57 Fed. Rep. 32 (1893).

34. Under the provisions of section 4956, to make out a *prima facie* case of copyright it is only necessary for a complainant owner of a copyright to allege and show that he deposited with the librarian of congress, on or before the date of publication, a printed copy of the title-page of his book, also two copies of the book, and that he has given the lawful copyright notice. \*Osgood v. A. S. Aloe Instrument Co., 72 O. G. 418, C. D. 1895.

## VI. DRAMATIC COMPOSITION.

(This subject was first admitted to copyright in 1856.)

35. The decisions which extend the definition of "dramatic composition" so as to include situations and "scenic" effects do not cover the mere mechanical instrumentalities by which such effects are produced. (Daly v. Palmer, 6 Blatch. 264—a leading case—cited and discussed.) \*Serrana v. Jefferson, 33 Fed. Rep. 347 (1888).

36. Marie Louise Fuller obtained copyright protection for a composition or description of a stage dance and the arrangement and setting of the stage, manipulation of the lights, etc., during the dance. *Held*, that complainant's performance is not a dramatic composition within the meaning of the copyright act, since the merely mechanical movements by which effects are produced on the stage are not subjects of copyright. \*Fuller v. Bemis, 50 Fed. Rep. 926 (1892).

37. Complainants have title to copyright of the novel "Trilby," and they may restrain the production or public performance of any play or drama presenting the scenes, incidents, plot or dialogue of the said novel "Trilby," but they cannot restrain the mere use of the name "Trilby" as the title of any dramatic composition which does not present such scenes, incidents, etc. The copyright law protects the name in connection with the novel, not the name alone. \*Harper v. Ranous, 67 Fed. Rep. 904 (1895).

## VII. FALSE MARKING.

38. The language of section 4963, Revised Statutes, providing a penalty for falsely marking articles "copyrighted," is not "for each copy," and while it may be true that if upon different days, under different circumstances, separate copies are printed, each transaction thus separate would constitute a separate offense, yet when the printing of many copies is a single continuous act only one offense is committed thereby. \*Taft v. Stephens Lithographing and Engraving Co., 47 O. G. 1355, C. D. 1889.

39. The law is clear that no offense is committed when the word "copyrighted" is placed upon an article that is not the subject-matter of copyright—that cannot be copyrighted. \*Id.

## VIII. INFRINGEMENT.

40. Defendant's copied lithographic copies of a painting for which copyright had been ob-



tained, *held*, an indirect copying of the painting itself and an infringement. \*Schumacher v. Schwencke, Jr., 30 Fed. Rep. 690 (1887).

41. A compiler of a general directory is not at liberty to copy any part, however small, of a previous directory, to save himself the trouble of collecting materials from original sources. He must do that which the first compiler has done; that is, collect the materials for himself. He may, however, use the first compiler's work for purposes of verification of correctness of his own. \*List Publishing Co. v. Keller, 30 Fed. Rep. 772 (1887).

42. Merely taking extracts from a copyrighted book, merely using it, in no manner infringes upon a copyright. \*Stover v. Lathrop, 33 Fed. Rep. 348 (1888).

43. Perforated strips of paper for use in organettes can hardly be considered as sheet-music, there being no clef, no bars, no lines, no spaces nor other marks which are found in common printed music. *Held*, that such strips do not infringe the copyright for a song and musical composition entitled "Cradle's Empty, Baby's Gone," although the tune is the same in both cases. \*Kennedy v. McTammany, 33 Fed. Rep. 584 (1888).

44. The copyright protects the registrant only against transcribing and embellishing his blank forms for application for a liquor license, and does not confer a monopoly of the forms themselves. Any one else may prepare and publish forms of this nature, provided they are not copies. \*Brightley v. Littleton, 37 Fed. Rep. 103 (1888).

45. A copyright for a photograph is infringed by a design copied directly from it and stamped on leather intended for the bottom or back of a chair. \*Falk v. T. P. Howell & Co., 37 Fed. Rep. 202 (1888).

46. The defendant is not liable unless he has copied—"pirated"—the plaintiff's charts, or some part of them. If he devised the same plan in ignorance of what plaintiff had done, he has not infringed any privilege secured by the plaintiff. \*S. S. White Dental Co. v. Sibley, 38 Fed. Rep. 751 (1889).

47. A copyrighted chart showing illustrated sections of teeth so arranged as to convey information respecting their character, size, etc., is not infringed by a chart conveying to purchasers the same character of information, since neither the teeth nor the numbers accompanying them are the same as the plaintiff's, neither in fact nor appearance. Defendant has not copied and published plaintiff's chart, but has

employed simply the same plan of advertising. \*Id.

48. Plaintiff's book contained about thirty thousand Swedish words with short English definitions. Defendant's book contained about ten thousand of the same Swedish words with similar English definitions, with considerable changes in roots, terminations, etc. Each Swedish word was a topic for the composition of an English definition, and the plaintiff's copyright would protect his literary work in composing them, however short they might be upon each topic. (Citing 2 Kent, Com. 381; Callaghan v. Myers, 128 U. S. 617.) \*Chils v. Gronlund, 41 Fed. Rep. 145 (1890).

49. The consent of a copyright owner to publish the subject of copyrighted article in an encyclopedia does not authorize the publication of such article as a part of a reprint of such encyclopedia. \*Black v. Henry G. Allen Co., Scribner v. Same, 42 Fed. Rep. 618 (1890).

50. The unauthorized reprinting of eight maps from a volume of maps is an infringement. \*Id.

51. The just and proper rule of damages in this case is to ascertain the profits the defendants made by their piracy of the complainant's work and fix that as the measure of complainant's damages. \*Scribner v. Clark, 50 Fed. Rep. 473 (1892).

52. Defendants procured the manufacture of copies of complainant's pictures, and had the title and plate-mark applied in London, England. The appropriation of a part of a work is an infringement if it "contains any substantial repetitions of any material parts which are original and distinctive." The defendants omitted the mere work of the artisan and appropriated the genius of the artist. The question is not whether the article is marketable, but whether it is piratical. (Cases cited.) Copyright held infringed. \*Fishel v. Lueckel, 53 Fed. Rep. 499 (1892).

53. The defendants procured the infringing act to be done; they are therefore liable as joint tort-feasors. (Cases cited.) \*Id.

54. The allegation of defendants that they had no intention to infringe the copyright is no defense. Where infringement is otherwise established, the intention is immaterial. (Reed v. Holliday, 19 Fed. Rep. 325.) \*Id.

55. The total number of cases digested in defendant's book was nineteen thousand. The disputed paragraphs, assuming that all are pirated, were less than one per cent. *Held*, an injunction would compel the mutilation of a completed

edition, or perhaps a printing of a new edition; the damage to defendant, should an injunction issue, would be entirely out of proportion to the damage to plaintiff should the preliminary writ be refused. The effect of an injunction would be an irremediable injury. (Cases cited.)

\*West Publishing Co. v. Lawyers' Co-operative Publishing Co., 53 Fed. Rep. 265 (1893).

56. An action for infringement of a copyrighted painting cannot be maintained unless the notice required by section 4962, Revised Statutes, has been applied to the original. Merely applying it to the published reproduction will not suffice. \*Pierce & Bushnell Mfg. Co. v. Werckmeister, 72 Fed. Rep. 54 (1896).

(Decision of circuit court of appeals, reversing decision of circuit court.)

57. *Held*, the plaintiff should be protected in the name "Investor," for a trade-journal, as against the same name applied to another trade-journal. \*Investor Publishing Co. of Massachusetts v. Dobinson, 72 Fed. Rep. 603 (1896).

58. The defendant published a crude illustration or wood-cut of certain poses of the dancer Mme. Loie Fuller; but the illustration was not a copy of, nor in any wise connected with, the petitioner's photographs. *Held*, there was no infringement. \*Falk v. City Item Printing Co., 79 Fed. Rep. 321 (1897).

59. The mere circumstance that two syllabi of the same opinion are found to be expressed in identical language is not always sufficient proof that the one was borrowed from the other.\* West Publishing Co. v. Lawyers' Co-operative Publishing Co., 79 Fed. Rep. 756 (1897).

(This important case was heard by Circuit Judges Iacombe, Wallace and Shipman—circuit court of appeals, second circuit.)

60. If, however, instance after instance is found where the production is continuous, and in which identity of language is found, in technical phraseology as well as common speech, such continuous identity is suggestive. \*Id.

61. When in a suit for infringement of an advertising pamphlet the defendant's pamphlet resembles the complainant's in its advertising features merely, there is no infringement, since such features are not the subject of copyright. \*Mutual Advertising Co. v. Refo, 79 O. G. 159, C. D. 1897.

62. A demurrer on the ground of multifariousness brought against a bill in which thirty different copyrights are sued upon, each copyright covering a letter or portion of a letter in a

system of indexing, is not well taken, since the subject-matter of litigation is in a sense single.

\*Amberg File & Index Co. v. Shea, Smith & Co., 79 O. G. 514, C. D. 1897.

## IX. INTERNATIONAL.

63. Complainant's copyrighted photograph represents a German painting, the right of publication or reproduction of which was duly assigned in Germany. There is no proof that the painting itself was ever copyrighted. By the proclamation of the president of April 15, 1892, the benefit of the international copyright act of March 3, 1891, was extended to German subjects. The two copies of the photographs required to be delivered at the office of the librarian of congress were not printed from negatives made within the limits of the United States, consequently complainant's imported photographs cannot be directly protected by statute; but complainant has all the rights the artist ever had. \*Werckmeister v. Pierce & Bushnell Mfg. Co., 63 Fed. Rep. 445 (1894).

(The privilege of copyright in the United States now extends to eleven foreign governments, namely, Great Britain and her dependencies, France, Germany, Italy, Spain, Portugal, Belgium, Switzerland, Denmark, Chile and Mexico.)

## X. MUSICAL COMPOSITIONS AND LITHOGRAPHS.

(Music was brought within copyright protection by the act of 1831.)

64. Section 3 of the (international) copyright act of March 3, 1891, construed and held to distinguish musical compositions from books, so that it is not required that the copies of musical compositions to be delivered to the librarian of congress shall be manufactured in this country. \*Littleton v. Oliver Ditson Co., 62 Fed. Rep. 597 (1894).

(Circuit court.)

65. It seems clear that the term "book" in section 3 was not intended to include "musical composition." \*Id.

66. Musical compositions differ in the view of the copyright law from books as such, since the penalty for infringement was made expressly different in the act of February 3, 1831, and so stands in the present statute, act of March 3, 1891. \*Id.

67. The word "lithograph" found in the proviso in section 3 of the statute under consideration represents only a subdivision of the

matter embraced in the word "print" in the same section. \*Oliver Ditson Co. v. Littleton, 67 Fed. Rep. 905 (1895).

(Circuit court of appeals.)

## XI. NOTICE.

68. The wrong year of entry of a copyright having been inscribed on a copyrighted article, suit for injunction cannot be maintained. (Following Baker v. Taylor, 2 Blatchf. 82; Myers v. Callaghan, 5 Fed. Rep. 726, *contra*.) \*Schumacher v. Wogram, 35 Fed. Rep. 210 (1888).

69. The notice given on a photograph was "1889, copyrighted by B. J. Falk, New York." Following Callaghan v. Myers, 128 U. S. 617, the notice is sufficient. \*Falk v. Schumacher, 48 Fed. Rep. 222 (1891).

70. The plaintiff did not adopt the formula for the notice prescribed in section 4962, Revised Statutes of the United States, 1878, second edition, since he omitted the words "In the office of the librarian of congress at Washington." This omission, in view of the fact that the statute is highly penal in character and must be strictly construed, would be fatal but for section 5601, Revised Statutes of the United States, 1878. Consequently the act of June 18, 1874, is the one that must determine the sufficiency of the notice. \*Hefel v. Whitely Land Co., 54 Fed. Rep. 179 (1893).

71. Section 1 of the act of June 18, 1874, prescribes that "Copyright, 18—, by A. B." may be a sufficient notice. The notice given by plaintiff embodies these exact words with additional words that simply amplify the formula without affecting its meaning. They are hence to be regarded as surplusage. \*Id.

72. The exhibition of a card of miniature samples of photographs for obtaining orders, *held* not a publication; hence it was not necessary that the card should give notice of copyright in the language the statute prescribes. \*Falk v. Gast Lithograph and Engraving Co., Limited, 54 Fed. Rep. 890 (1893).

73. Complainant being a resident of Germany and engaged in business under the name of "Photographische Gesellschaft," the copyright notice, "Copyright, 1882, by 'Photographische Gesellschaft,'" is proper. (Scribner v. Henry G. Allen Co., 49 Fed. Rep. 854, and Lithograph Co. v. Sarony, 112 U. S. 53.) \*Werckmeister v. Springer Lithographing Co., 63 Fed. Rep. 808 (1894).

74. A notice of copyright in the following language, "Copyright, 1891. All rights re-

served," is insufficient under the law, which requires the copyright notice to state the name of the person by whom the publication is copyrighted. \*Osgood v. A. S. Aloe Instrument Co., 72 O. G. 418, C. D. 1895.

(See Jackson v. Walkie, 29 Fed. Rep. 15 — 1886.)

75. While an artist's copyrighted original painting remains unpublished, it is unnecessary to put any notice of copyright upon it. The notice is only required from the published *replica*. It is the same in the case of any design or model. \*Pierce & Bushnell Mfg. Co. v. Werckmeister, 72 Fed. Rep. 54 (1896).

76. Whoever duly obtains a copyright cannot force any right against infringers except upon giving the notice required by section 4962 as amended by the act of June 18, 1874. The necessity of this notice is to inform the public. \*Id.

77. The notice given by the plaintiff was "Copyright 93, by Bolles, Brooklyn." *Held* sufficient in view of the circumstances and the decisions of the supreme court in Lithographic Co. v. Sarony, 111 U. S. 53, 4 Sup. Ct. 279. \*Bolles v. Outing Co., Limited, 77 Fed. Rep. 966 (1897).

78. The general rule is that in legal proceedings, and in statutory notices, the full name of the party must be given for purposes of identification, and designation by the initial letter or letters of the christian name will not suffice. In the Sarony case the initials were held superfluous and the surname as sufficient, because the public were not likely to be misled by omission of the full name. \*Id.

## XII. PUBLICATION AND SALE.

(See TITLE, *infra*.)

79. A sale of a printed work prior to perfecting registration of the copyright constitutes a publication and the copyright must fail. \*Gottsberger v. Aldine Book Publishing Co., 33 Fed. Rep. 881 (1887).

80. The exhibition of a card of miniature samples of photographs for the inspection of dealers alone, for the purpose of enabling them to give orders, is not a published edition within the meaning of the statute. \*Falk v. Gast Lithograph and Engraving Co., Limited, 54 Fed. Rep. 890 (1893).

81. At the common law the artist or owner of the painting can prohibit reproductions of it until he in some way publishes it, but after publishing (without copyright) the public becomes entitled to it. (Parton v. Prang, 3 Cliff.

587.) \*Werckmeister v. Pierce & Bushnell Mfg. Co., 63 Fed. Rep. 445 (1894).

82. The sale of a painting, reserving the right of reproduction, does not bar copyright. \*Werckmeister v. Springer Lithographing Co., 63 Fed. Rep. 808 (1894).

83. The sale of the *replica* of a painting did not destroy the right to copyright. It was not a copy of the painting, but was made before the painting, for assistance to the artist in producing the painting. \*Id.

84. An illustration not taken from the painting but from a very superficial crayon sketch printed in the catalogue of the salon where the painting was exhibited, and not intended to be a copy of the painting, was not such a printing as would work a forfeiture of the right of copyright. \*Id.

85. A copyrighted painting exhibited in Berlin and Munich, *held* to have been "published" within the meaning of section 4962, Revised Statutes. \*Pierce & Bushnell Mfg. Co. v. Werckmeister, 72 Fed. Rep. 54 (1896).

(Circuit court of appeals, Judges Colt and Nelson; Judge Webb dissenting.)

86. Whatever right the author may have possessed before publication must have been at common law. The first publication is the foundation of the right under the copyright and a condition precedent to the existence of the right. \*Id.

87. If the circulation of a copyright book be "limited to friends and acquaintances, it would not be a publication; but if general, and not so limited, it would be." (Coppinger on Copyright, 3d ed.) "To constitute a publication it is necessary that the work shall be exposed for sale or offered gratuitously to the general public, so that any person may have an opportunity of enjoying that for which the copyright was intended to be secured." \*Ladd v. Oxnard, 75 Fed. Rep. 708 (1896).

### XIII. TITLE OF COPYRIGHTED SUBJECT.

88. If a publication be made under a title different in substance from that by which it was copyrighted, the departure would probably leave the publication to the public. (Drone, Copyrights, 140, 142.) \*Blume v. Spear, 30 Fed. Rep. 629 (1887).

89. A copyright is invalid if there be sufficient variance between the title as registered and the title as published. \*Daly v. Bradley, 39 Fed. Rep. 205 (1889).

90. A copyright protects the name in connection with a book, not the name alone. \*Harper v. Ranous, 67 Fed. Rep. 904 (1895).

91. Protection has never been afforded by injunction under copyright laws for the title separate from the body of the work which it is used to designate. \*Corbett v. Purdy, 80 Fed. Rep. 901 (1897).

### CORPORATIONS.

1. A corporation cannot be a resident, under the act of 1887, of a state other than that in which it was incorporated. \*Miller v. Wheeler & Wilson Mfg. Co., 57 O. G. 276, C. D. 1891.

2. It would be contrary to the well settled rules of equity to hold the defendant, who was president and general manager of the corporation, alone personally responsible for the alleged infringing acts committed by said corporation, contrary to the express instructions of the defendant and without his knowledge. (Cases collected in Linotype v. Ridder, 65 Fed. Rep. 853.) \*Stuart v. Smith, 68 Fed. Rep. 189 (1895).

3. The rule that a corporation has a distinct personality of its own and is not responsible for the personal acts of its stockholders will not apply in a case where the vender of a patent holds almost the entire stock of a defendant corporation and the facts show that he either uses such corporation as a mere cover for the transaction of his business or that there is knowledge and privity of interests between him and another stockholder, and the defendant corporation in such case will be estopped by the acts of said vender. \*National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co., 75 O. G. 1361, C. D. 1896.

(A corporation may be bound by a contract which is not under its corporate seal in a case where the law does not require it. \*Gottfried v. Miller, 21 O. G. 711, C. D. 1882 — U. S. Sup. Ct.)

### CORRECTION OF PATENTS.

1. The drawings having been interchanged in two patents, *ordered*, that the grant be canceled and new letters in proper form issued. Notice also given that the new letters patent would bear a later date than those canceled, and, if foreign patents had been obtained, the term of the United States patents would be limited thereby. *Ex parte Crawford*, 34 MS. D., June, 1887 (Hall, Com'r).

2. A court in equity has power to require

delivery of instruments obtained by fraud, for the purpose of correction or cancellation. \*United States v. American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

3. The patent had not at the date of the suit been signed by the acting secretary of the interior, but was subsequently signed by him. The circuit court dismissed the bill. Complainant took an appeal in 1885 to this court. In 1887 congress passed an act for relief of patentees, making the patent legal, valid, complete, and operative from its original date, December 28, 1880. *Held*, while a patent of the United States can be attacked for defects upon its face only by regular proceedings instituted for that purpose, and is not open to collateral attack, except where specially provided by statute, this rule applies only to such patents as have been in fact executed under proper authority, and does not apply to any others. \*Marsh v. Nichols, Shepherd & Co., 46 O. G. 239, C. D. 1889.

4. Thus, it may be shown that the patent was never executed by the person whose name appears on it, or that it was wrongly dated, or was never signed by the person who appeared to have signed it, or was signed after the official was out of office. A patent unsigned is void. \*Id.

5. Such grants, if defective from insufficient execution, may be corrected subsequently, upon application to the proper department; but the correction must be made by the existing officers of the department. \*Id.

6. The correction by the same acting secretary of the interior is sufficient, the commissioner of patents remaining the same at the date of the correction, which is the true date of the patent. \*Id.

7. In this instance the actual date of correction, being more than six months after the date written in the patent, may be shown by proof. \*Id.

8. Where the assignments referred to applications as of even date, but they bore date a day earlier, and patents issued in the name of the inventor, a certificate of correction refused, *Ex parte Wirth*, 46 MS. D. (8 G. W. D.), April 1891 (Mitchell, Com'r).

9. The commissioner of patents has no jurisdiction to alter the patent by a certificate of correction, and such certificate is wholly void. \*Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892, 52 Fed. Rep. 300.

(United States circuit court of appeals, second circuit.)

10. While the application for Edison's United States patent 223,898 was pending, a British patent was obtained dated November 10, 1879. The United States patent was granted January 27, 1880, unlimited, for the full term of seventeen years. December 18, 1883, upon the request of the party in interest, the commissioner of patents issued a certificate of correction, naming the date of the British patent aforesaid. On March 6, 1893, by petition of the parties in interest, the said certificate was canceled, this action being taken in view of a decision by the circuit court of appeals of the second circuit, declaring the former action of the commissioner to be without authority of law and therefore void. \*Edison Electric Light Co. v. Buckeye Electric Co., 59 Fed. Rep. 691 (1894).

11. After issue of the patent, the commissioner issued a "certificate of correction," stating that the said patent is limited to expire with foreign patent for the same invention. The attempted "correction" was without jurisdiction and wholly void; citing *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. Rep. 300. \*Edison Electric Light Co. v. Bloomington, 65 Fed. Rep. 212 (1894).

## CROSS-REFERENCES.

(See RESERVATION IN APPLICATION.)

1. When two or more applications are pending at the same time and each contains a disclaimer of matter in the other, and all showing, but only one claiming, the same subject-matter of invention, the issue of the patent on one application is not a bar to a patent on the other. *Ex parte Roberts*, 40 O. G. 578, C. D. 1887.

2. If the inventions are so nearly related to each other — as in case of an apparatus and process — that an application covering one invention discloses the other, applicant may fully protect his rights by incorporating in the applications cross-references, the effect of which would be the announcement that the invention claimed in the one was not the same as that claimed in the other. *Ex parte Blair*, 48 O. G. 113, C. D. 1888.

3. The examiner has the right to waive his requirement that applicant file cross-references and to take such other steps as in his judgment and discretion are necessary to remove any conflict between subject-matter of two pending applications of the same applicant. *Ex parte Donovan*, 44 O. G. 698, C. D. 1883.

4. A reference in an application for a patent to a contemporaneously-pending application for another patent for a fuller description is not permissible. *Ex parte Borgfeldt*, 49 O. G. 132, C. D. 1889.

5. A cross-reference which refers by serial numbers only to applications which may never mature into patents is not sufficient and not in compliance with rule 43. Cross-references must be of such nature that they will impart a more or less definite conception of their scope. It cannot be assumed that all applications will mature into patents, nor can it be permissible that they shall refer for purposes of construction or interpretation to instruments to which the public has no access. *Ex parte Everitt*, 49 O. G. 564, C. D. 1889.

6. A reference to another pending application for a description of the machine to which the present improvement relates does not satisfy rule 36. Applications pending in the office are no part of the prior art and may not be resorted to in order to supplement a description which would otherwise be insufficient. *Ex parte Chadwick*, 57 O. G. 124, C. D. 1891.

7. Where an applicant has two applications in the office disclosing different species of the same invention, each containing specific claims and one containing a claim broad enough to cover both species, and the one containing only specific claims has been allowed, a cross-reference disclaiming the subject-matter of the broad claim may be inserted into the allowed case under rule 78 without withdrawing it from the issue. *Ex parte Anderson*, 63 O. G. 463, C. D. 1893.

8. A cross-reference in an application to another pending application, both filed by the same party, is proper even in a case where the other application has been rejected and the rejection affirmed by the examiners-in-chief, since such rejection is not final and the application may be finally allowed on further appeal. *Ex parte Simon W. Wardwell*, 62 MS. D. 9, July, 1897.

## COURTS.

(See JURISDICTION OF.)

## DAMAGES AND PROFITS.

- I. IN GENERAL.
- II. ACCOUNTING.
- III. ACTUAL.

IV. BURDEN OF PROOF.

V. DESIGN PATENT.

VI. ESTIMATION AND MEASURE OF.

VII. ESTIMATION AND MEASURE OF; LICENSE FEES AND ROYALTIES.

VIII. EXPENSES.

IX. INTEREST ON.

X. MASTER'S REPORT.

XI. NOMINAL.

## I. IN GENERAL.

1. The assignment of a patent does not ordinarily transfer the right to damages for infringements prior to the assignment; and *held*, that a sale and assignment by an administrator, under order of court, of a number of patents belonging to the deceased, some of which had expired, the sale being for a nominal sum, contained no circumstances to vary the general rule. \**May v. Juneau County*, 41 O. G. 578, C. D. 1887.

2. Under section 4921 of the Revised Statutes, where a decree is given in a suit in equity restraining the infringement of a right secured by patent, the court may also decree a recovery of the profits arising from such infringement and the damages the plaintiff has sustained thereby. \**Asbestine Tiling and Mfg. Co. v. Hepp*, 49 O. G. 413, C. D. 1889.

3. The patentee is entitled to recover the profits made by an infringer where the article is complete in itself and is sold separately from the machine the operation of which it is intended to improve. \**Keep v. Fuller*, 42 Fed. Rep. 896 (1890).

4. On suit for infringement of patents of different dates damages need not be apportioned for infringement of each. \**Timken v. Olin*, 51 O. G. 1469, C. D. 1890.

5. Section 4921 of the Revised Statutes of the United States confers no authority upon a court of equity to increase a recovery of profits decreed against an infringer of a patent. This statute distinctly discriminates between the profits which are recoverable in a court of equity and the damages which were formerly recoverable in actions at law only, and confines the power of increasing the recovery to the latter. \**Covert v. Sargent*, 52 O. G. 1372, C. D. 1890.

6. Where an assignment of a patent was made two months after such patent had expired, nothing remained capable of assignment except the mere right of action for the recovery of damages for past infringement. Equity

has no jurisdiction. An action at law was the only adequate redress. \*Ross v. City of Fort Wayne, 58 Fed. Rep. 405 (1893).

7. A final decree making an injunction perpetual and awarding only nominal damages was rendered upon a stipulation that such decree should not be a bar to the recovery of substantial damages in a subsequent case. \*David Bradley Mfg. Co. v. Eagle Mfg. Co., 66 O. G. 315, C. D. 1894.

8. Damages can be collected from the manufacturer of a machine, and further damages from a subsequent purchaser and user of the same machine. The payment of damages for making an infringing machine does not give any right to the future use of the machine; but this may be restrained by injunction; and when the whole machine is an infringement it may be ordered to be delivered up and destroyed. (Birdsell v. Shalol, 30 O. G. 261, 112 U. S. 485.) \*United States Printing Co. v. American Playing Card Co., 72 O. G. 1499, C. D. 1895.

9. Where a patentee takes a decree for profits against a manufacturing infringer, he sets the manufactured machine free. The profits of the infringer are full compensation to the complainant for the wrong done him; but a judgment for damages covers only damages in the past and has no relation to the future. \*Id.

## II. ACCOUNTING.

10. The rights of the parties are to be determined as they stood at the commencement of the suit, and when determined the accounting should cover everything within it to the time of taking the account. \*Rogers v. Riessner, 39 O. G. 832, C. D. 1887.

11. A court in equity will require an infringer to account for the gains and profits which he has made from the use of a patented invention instead of limiting the recovery to the amount of royalties paid to the patentee by third persons. \*Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

12. Where the patent in suit had been adjudged invalid by this court in a suit against another defendant, and subsequently in this suit the court had adjudged the patent valid, the defendants must account for infringements committed after the date of the first adjudication that such patent was invalid. \*Id.

13. In this instance there can be no accounting for profits earned subsequently to the suit, which was not tenable at the date of its com-

mencement. \*March v. Nichols, Shepherd & Co., 46 O. G. 239, C. D. 1889.

14. An interlocutory decree, after finding an infringement of plaintiff's patents by defendant corporation, directed the master to take an account of the profits which had arisen or accrued to the corporation thereby; and on suggestion that the individual defendants were all the stockholders and officers of such corporation, and might, under the guise of a new name and form of a new corporation, continue to infringe, the decree further directed the master to also take an account of profits that had accrued to such individual defendants over and above the profits of the corporation. *Held*, that the decree did not direct an accounting of profits arising from infringements by other previously existing corporations, in which defendants were stockholders, or by corporations which had previously been formed in good faith and not for the purpose of evading the decree, though defendants were controlling stockholders therein. \*New York Grape Sugar Co. v. American Grape Sugar Co., 53 O. G. 277, C. D. 1890.

15. Where infringement is admitted damage is presumed, and the owner of a patent is entitled to a reference for accounting without giving specific evidence of damage. \*Campbell Printing Press & Mfg. Co. v. Manhattan Ry. Co., 60 O. G. 894, C. D. 1892.

16. A court will hesitate to compel a large additional expenditure of time by ordering an accounting in a suit which has been pending for a long time, especially when the manufacture which forms the basis of the suit has ceased and it is likely that further testimony would result in mere estimates. The court will itself determine the profits. \*Tuttle, Trustee, etc., v. Claffin, 77 O. G. 973, C. D. 1896.

## III. ACTUAL.

17. Where defendants infringe on complainant's rights, it is immaterial whether they were acting in good faith or under the supposed protection of letters patent where actual damages only are allowed. \*Timken v. Olin, 51 O. G. 1469, C. D. 1890.

18. Where the evidence shows that the article manufactured by the defendant by the use of the infringing device differs from the plaintiff's product in a material respect, and is produced by an essentially different process, and where, as a matter of fact, defendant's product is superior in quality and finish to the plaintiff's

iff's product, *held*, that there is no presumption, either of law or fact, that the actual damage done to the patentee is commensurate with the gains of the infringer. \*Royer v. Schultz Belting Co., 55 O. G. 1141, C. D. 1891.

19. The exclusive use granted by a patent is a property right, and a plaintiff in an action at law for infringement may recover actual damages therefor. \*Lee v. Pillsbury, 60 O. G. 1752, C. D. 1892.

20. The actual damages suffered by plaintiff may be arrived at by evidence showing the value of that which defendants have used, the utility and advantage of the invention of the plaintiff over the old modes or devices that have been used for working out similar results, and the saving effected thereby. \*Id.

21. Plaintiff must prove the actual damages directly or show such facts as will enable the jury to ascertain the amount, and mere opinion as to the amount of that damage cannot be considered. \*Id.

#### IV. BURDEN OF PROOF.

22. The plaintiff has the burden of proving the amount of profits the defendants have made by the use of his invention. \*Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

23. If an invention contributes only a subsidiary value to an article, it is incumbent upon the patentee as against an infringer to show affirmatively what this advantage is worth. \*Webster Loom Co. v. Higgins, 54 O. G. 888, C. D. 1891.

24. The burden is on the licensor to show that the licensee has operated under his license, and in the absence of such proof the licensor cannot recover. \*Marsh v. Quick-Meal Stove Co., 60 O. G. 1056, C. D. 1892.

25. To entitle a patentee to recover as damages for infringement the profits he would have realized if he had made the sales which were made by the infringer, he must show that he had the ability to make and that he would have made said sales but for the infringement. \*Tatum v. Gregory, 60 O. G. 1753, C. D. 1892.

26. Certain deductions from accountable profits *held* to be for defendant to clearly establish. \*Seabury v. Am Ende, 67 O. G. 401, C. D. 1894.

27. If defendants took complainant's device in its original form, the latter are entitled to the pecuniary advantage which the infringers derived from the unauthorized use of the patent. If the infringers added an improvement

they have a right to an apportionment, the burden of proof being upon them to show that a portion of the profits was the result of the improvement. \*Tuttle, Trustee, etc., v. Clafin, 77 O. G. 973, C. D. 1897.

#### V. DESIGN PATENT.

28. The act of congress (February 4, 1887) fixing a liability of \$250 against every infringer of a design patent is within the authority conferred by article 8, section 1, of the constitution, and therefore valid. \*Untermeyer v. Freund, 59 O. G. 1923, C. D. 1892.

29. The language of the act being "that hereafter, during the term of letters patent for a design, it shall be unlawful," etc., makes no exception as to cases commenced before the approval of the act. \*Id.

30. The act provides that an infringer shall be further liable for all profits in excess of two hundred and fifty dollars made from the sale "of the article or articles" to which the design is applied. *Held*, that the court cannot limit damages to the profits due merely to the design, but must take into account all profits made on the sale of the article made thereunder. \*Id.

#### VI. ESTIMATION AND MEASURE OF.

(See MASTER'S REPORT, *infra*.)

31. The value of an invention to the party using it is competent evidence on the question of damages for the infringement of a patent. \*Royer v. Coup, 39 O. G. 239, C. D. 1887.

32. Defendant infringed the patent as a participant in the unauthorized sales and became liable for the whole infringement. \*Hatch v. Hall, 40 O. G. 1343, C. D. 1887.

33. As to the comparative expense of the old process, the cost at which the defendants used it, if at all, is not conclusive evidence that the old process could not have been used at a less cost. \*Tilgham v. Proctor, 43 O. G. 363, C. D. 1888.

34. The infringer is liable for actual, not for possible, gains; for the fruits of the advantage which he derived from the use of the invention over that which he would have had in using other means then open to the public, and adequate to enable him to obtain an equally beneficial result. \*Id.

35. If there was no advantage in the use of the plaintiff's invention, there can be no decree



for profits, and the plaintiff's only remedy is by action at law for damages. \*Id.

36. If the defendants gained an advantage by using the plaintiff's invention, that advantage is the measure of the profits to be accounted for, even if from other causes the business in which that invention was employed by the defendants did not result in profit. \*Id.

37. A court of equity will itself administer full relief by awarding as an equivalent or a substitute for legal damages a compensation computed and measured by the same rule that courts of equity apply in the case of a trustee who has wrongfully used the trust property to his own advantage. \*Id.

38. When the invention relates to a new composition of matter and the infringing article is made of the patented material, and this alone, the measure of the patentee's damages may be the entire profit which he would have made. \*Welling v. La Bau, 43 O. G. 117, C. D. 1888.

39. This rule is not changed where the infringing articles are of a poorer quality than the complainant's, if they are so nearly alike in appearance as to deceive not only buyers but experts in the trade. \*Id.

40. A., one of the plaintiffs, was sub-licensee of three patents under B., another plaintiff, licensee under the inventor of the same patents at a lower royalty. One patent alone was infringed, and no evidence was produced to apportion its separate value. *Held*, no basis shown on which to compute damages, and plaintiff restricted to defendant's profit made by use of the infringing device. \*Vulcanite Pavement Co. v. American Artificial Stone Co., 45 O. G. 948, C. D. 1888.

41. The basis for estimating damages for infringement should be the amount of profit or savings made by the use of the infringing device over what could have been made by the use of devices free and open to the public. \*McMurray v. Emerson, 47 O. G. 815, C. D. 1889.

42. The rule that, "when the entire profit of a business or undertaking results from the use of the invention, the patentee will be entitled to recover the entire profits, if he elects that remedy," applied. \*Hurlbut v. Schillinger, 47 O. G. 1067, C. D. 1889.

43. The payment of a sum in settlement of a claim for an alleged infringement of a patent cannot be taken as a standard to measure the value of the improvements patented in determining the damages sustained by the owner of the patent in other cases of infringement.

\*Cornely v. Marckwald, 47 O. G. 1353, C. D. 1889.

44. The defendant used a patented solvent which was cheaper than others; the defendant thereby saved a sum which complainant is entitled to recover as a profit. \*Celluloid Mfg. Co. v. Cellonite Mfg. Co., 50 O. G. 841, C. D. 1890.

45. In a suit for infringement of a patent on lamp-burners, the evidence showed that complainants, during the time of the infringement, sold six thousand of the burners, after reducing the price, and that defendants sold only one hundred and fourteen of them. In competition with complainants, defendants sold various other kinds of burners, not protected by complainants' patent. *Held*, that the evidence was not sufficient to show that the reduction of price by complainants was caused by defendants' infringement, and they should recover only for the profits made by defendants in the infringing sales. \*Boesch v. Graff, 51 O. G. 477, C. D. 1890.

46. The statute gives \$250 as a measure of profits in cases where a less amount only can be proven, and not as a penalty above the actual profits. It seems to insist upon the idea that the amount of liability for infringement is merely a fixed measure of profits which may be decreed in equity as an incident to the jurisdiction for relief by injunction. \*Pirkl v. Smith, 52 O. G. 1372, C. D. 1890.

47. The exceptions to the master's report as to the liability of the defendants for profits upon re-argument overruled; and *held*, that upon the facts presented the defendants were not accountable for any part of their profit upon the material when it was ready for the loom included in its market value at that time, or for any part of the seller's profit in the increased production. (Case of Webster v. Carpet Co., 9 O. G. 203; 2 Ban. & A. 67, not followed.) \*The Webster Loom Co. v. Higgins, 54 O. G. 388, C. D. 1891.

48. The advantage gained by the infringer who makes and vends a patented article is measured by the value which the invention contributes to the market value of the article, and he is held accountable to that extent, unless his net profit in making and selling the article is less than the value of the invention. \*Id.

49. If the invention invests the article with its whole value as a marketable commodity, his entire gains are attributed to the invention. If it contributes only a subsidiary value, this value segregated from the independent market

value of the article is the advantage for which he is accountable. \*Id.

50. In settling an account between a patentee and an infringer, the liability of the latter for profits is measured by the advantage which he has gained by the use of the patented invention. \*Id.

51. The infringing corporation held liable for whatever profit is derived from the manufacture and sale of the chemical preparation of plaintiff's patent, notwithstanding it might have made and sold the ingredients of said preparation if it had chosen to do so, and at the same or even larger profit. \*Am Ende v. Seabury & Johnson, 54 O. G. 1268, C. D. 1891.

52. The loss entailed upon plaintiff by reason of his being compelled to reduce his price in consequence of the reduction of price made by the defendant, who was the only competitor of the plaintiff in the market, was a proper item of damages. \*Id.

53. Defendants who infringed a patented valve by the manufacture of valves commercially worthless but for the infringed invention, are liable for the profits realized by them, though the form of their valves is different from those manufactured by complainants. \*Consolidated Safety Valve Co. v. Crosby Steam Gage & Valve Co., 54 O. G. 663, C. D. 1891.

54. Where the valves manufactured by defendants also infringed another later patent, likewise owned by complainants, no injustice is done defendants in acceding to complainants' claim that all profits realized by defendants during the life of the earlier patent were solely due to the invention covered by that patent, especially in view of the fact that defendants contended that the invention embodied in the later patent is worthless; and hence, in an action for the infringement of the earlier patent, it is unnecessary for the master to find how much of defendants' profits are due to the later invention. \*Id.

55. In an action at law for infringement the measure of recovery is the actual loss or damage that the plaintiff has sustained as the proximate result of the infringement. \*Royer v. Shultz Belting Co., 55 O. G. 1141, C. D. 1891.

56. In estimating damages evidence may be given of profits, but such proof is of no avail unless further evidence is produced from which it may be legitimately inferred that, but for the infringement, the profits realized by the infringer or some definite portion thereof would have been realized by the patentee. The fact

that a defendant has made large profits furnishes in itself no basis for a correct estimate of the injury sustained by the patentee. \*Id.

57. Where defendants have infringed plaintiff's patent by the manufacture and sale of valves the entire commercial value of which lies in a feature covered by plaintiff's patent, they are liable in damages for all profits realized by them from such manufacture and sale. \*Crosby Steam Gage and Valve Co. v. Consolidated Safety Valve Co., 57 O. G. 1000, C. D. 1891.

58. The only subject of inquiry in estimating the amount of damages is the profit made by defendant on the articles which it sold at a profit and for which it received payment; and losses incurred by the defendant through its wrongful invasion of the patent are not chargeable to the plaintiff, nor can their amount be deducted from the compensation which the plaintiff is entitled to receive. \*Id.

59. In estimating profits defendant has made by use of plaintiff's device, where such device is a mere improvement upon what was known before and was open to defendant's use, plaintiff is limited to such profits as have arisen from the use of the improvement over what defendant might have made by the use of that or other devices without such improvement. \*McCreary v. Pennsylvania Canal Co., 57 O. G. 1131, C. D. 1891.

60. Where an infringer has not sold the infringed device as a separate article, but has manufactured and used it upon certain articles sold by him, the proper measure of damages is not the profits on the entire article sold, but the defendant's savings from the use of the infringed device over what was known and open to the public before, and in such a case the question of defendant's profit or loss in the sale of the entire article is immaterial. \*Sessions v. Romadka, 59 O. G. 939, C. D. 1892.

61. Where there is no license fee and nothing to show that the patentee puts his machine upon the market, he must furnish other evidence to enable the jury to come to a proximate amount of the damage which he has sustained by the infringement, and for this purpose general evidence may be resorted to. \*Lee v. Pillsbury, 60 O. G. 1752, C. D. 1892.

62. The proper measure of damages for infringement of a patent is an indemnity to the plaintiff for the loss sustained by the infringement. \*Id.

63. When a patent covers only certain features of a machine and not the entire machine,

if the patented features constitute the essential features of the machine and give it its merit, without which the machine would be valueless and unsalable, the damages and profits for infringement must be calculated on the basis of the entire machine and not merely on the patented features alone. \*Id.

64. In a suit for infringement of a patent for a lifting-jack the court decreed that complainant recover the profits made "from said infringement by the manufacture, use or sale of the improvements described" in the patent, and referred the cause to a master to take proof and report the profits made from the manufacture, use or sale "of said improvements or from said infringement." No proof was given before the order of reference was made showing that the patented feature gave the infringing machine its entire commercial value. *Held*, that the order did not and could not properly direct the finding of profits on the entire machine; and defendants having claimed at the commencement of the hearing before the master that they were liable only for the profits realized from the infringing feature, the burden was on complainant to show either that such feature gave the machine its entire commercial value or else to segregate the profits made on that feature from the profits on the machine as a whole. (45 Fed. Rep. 205, affirmed.) \*Mosher v. Joyce, 61 O. G. 153, C. D. 1892.

65. Complainant, claiming that the entire commercial value of the infringing machine was due to the patented improvement, offered no evidence to segregate the profits on that feature alone, and the master reported the profits on the whole machine. The court, on exceptions to the report, held that the entire commercial value was not due to the patented feature, and thereupon complainant moved to recommit the report for evidence of separate profits. *Held*, that it was a proper exercise of discretion for the court to refuse the motion, as complainant, with full notice of defendant's claim, had chosen to rely entirely on his own theory of the case. \*Id.

66. A sum paid by the defendant for patents under which he claims to operate and the cost of his patterns should be disallowed, as such purchases remain his property. \*Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

67. Where the entire value of the infringing machine made and sold by the defendant is due to the invention covered by the patent in suit, the plaintiff is entitled to the whole profits realized by the defendant. \*Id.

68. Although the bill for infringement was filed in 1886, the infringement continued after the filing of the bill and passage of the act of February 4, 1887. *Held*, that the complainant is entitled to the total profits resulting to the infringer to the date of the accounting (*Marsh v. Nichols*, 46 O. G. 239, 128 U. S. 605), even in the absence of proof that the entire profits were attributable to the use of the design. (Act of February 4, 1887.) \*Untermeyer v. Freund, 65 O. G. 1767, C. D. 1893.

69. While it is the law that complainants in patent cases may give evidence to show the profits realized by the defendants from use of the patented device, and thus enable the courts to measure the amount of damages, and where the whole device is infringed, it is easy to apply the rule that the profits of the defendants afford a standard measurement of damages; but when the invention is but one feature among other devices that contribute to the profits made by defendants, serious difficulties arise in applying the rule. \*Keystone Mfg. Co. v. Adams, 66 O. G. 654, C. D. 1894.

70. The conclusions reached upon this question upon consideration of the various decisions, briefly stated, are as follows: It is competent for a complainant to demand, in equity, an account of the profits actually realized by the defendant from his use of the patented device; that the burden of proof is upon the complainant; and that where the infringed device was a portion only of the defendant's machine, which embraced inventions covered by patents other than that for the infringement of which the suit was brought, in the absence of proof to show how much of that profit was due to such other patents and how much was a manufacturer's profit, the complainant is entitled to nominal damages only. (*Seymour v. McCormick*, 16 How. 480; *Rubber Co. v. Goodyear*, 9 Wall. 788; *Mowry v. Whitney*, 14 Wall. 620; *Elizabeth v. Pavement Co.*, 97 U. S. 126.) \*Id.

71. The complainant must establish the actual gains made by an infringer by the use of the patented device upon which the suit is brought (*Garretson v. Clark*, C. D. 1884, 206, 27 O. G. 524, 111 U. S. 129; *Tilgham v. Proctor*, C. D. 1888, 363, 43 O. G. 628, 125 U. S. 136), and in view of this rule it is error to permit a complainant to prove, not the defendant's profits, but those realized by other companies in the use of the patented device. This would be to allow the complainant to show what the defendant might have made, and not those profits which he actually did make. \*Id.

72. It is no doubt well settled that where a patent is for a particular part of an existing machine it is not sufficient to ascertain the profits on the whole machine, but it must be shown what portion of the profits is due to the particular invention secured by the patent in suit (*Blake v. Robertson*, 11 O. G. 877, 94 U. S. 728; *Dobson v. Hartford Carpet Co.*, 31 O. G. 787, 114 U. S. 120); but it is equally true that where the patented invention is for a new article of manufacture, which is sold separately, the patentee is entitled to damages arising from the manufacture and sale of the entire article. (*Goulds Mfg. Co. v. Cowing*, 21 O. G. 1277, 105 U. S. 258; *Hurlbut v. Schillinger*, 47 O. G. 1067, 130 U. S. 456; *Crosby Valve Co. v. Safety Valve Co.*, 57 O. G. 1000, 141 U. S. 441.) The fact that another grate of the same kind was sold at the same time does not present any argument for lessening damages. \**Warren v. Keep*, 69 O. G. 1647, C. D. 1894.

73. In actions at law for damages for the infringement of a patent the plaintiff is entitled to recover, as damages, compensation for the pecuniary loss he has suffered from the infringement without regard to the question whether the defendant has gained or lost by his unlawful acts, the measure of recovery being, in such cases, not what the defendant has gained, but what the plaintiff has lost. \**Coupe v. Royer*, 70 O. G. 779, C. D. 1895.

74. Where a patent for an improvement in carts was limited merely to a device for sustaining the foot-board, but the invention practically introduced a new cart, for which a demand at once arose, *held*, that in the absence of any proof that any carts of this form were ever constructed without the patented feature, the measure of damages for infringement was complainants' entire loss, it being impossible to separate the value of the patented cart from a cart which did not contain the invention. \**Holmes v. Truman*, 73 O. G. 448, C. D. 1895.

75. "In a suit in equity for the infringement of a patent, the ground upon which profits are recovered is that they are the benefits which have accrued to the defendants from their wrongful use of the plaintiff's invention, and for which they are liable, *ex aequo et bono*, to the like extent as a trustee would be who had used the trust property for his own advantage. The defendants, in any such suit, are therefore liable to account for such profits only as have accrued to themselves from the use of the invention, and not for those which have accrued to another, and in which they have no partici-

pation." \**Belknap v. Schild*, 74 O. G. 1121, C. D. 1896.

76. Estimates only and estimates based upon experiments by the complainants, made only in a small way, which include estimates for the expense of an unnecessary feature of a process and which make no allowance for the economies which result from a subdivision of work, such as would be employed in manufacturing for wholesale trade, are unsatisfactory. \**Tuttle, Trustee, etc., v. Clafin*, 77 O. G. 973, C. D. 1896.

## VII. ESTIMATION AND MEASURE OF, LICENSE FEES AND ROYALTIES.

77. An established license fee may be resorted to as a measure of damages. \**Jennings v. Dolan*, 38 O. G. 1018, C. D. 1887.

78. The general rule is that, where less than the whole number of claims has been infringed, evidence must be adduced to show the value of the part taken. \**Asmus v. Freeman, Same v. Alden*, 34 Fed. Rep. 902 (1888).

79. A license fee need not be uniform throughout the life of the patent, since the value of the monopoly diminishes as it approaches its close. It is sufficient that the price is uniform when the circumstances are similar. \**Id.*

80. It is a general rule in patent causes that established license fees are the best measure of damages that can be used. In this case the master excluded certain license fees as the basis of computing damages on the ground that they were practically settlements of pending litigations between the complainants and the parties taking said licenses, made with one exception after the commencement and during the pendency of this suit. *Held*, that those licenses were in full operation when the defendants elected to resume their infringing manufacture; that they are competent evidence as bearing upon the fair market value of the privilege which the infringers have wrongfully undertaken to exercise, and that the defendants took the risk of being compelled to pay damages on the basis of the rate of license thus established. \**Carey v. The Lovell Mfg. Co., Limited*, 47 O. G. 525, C. D. 1889.

81. In order that a royalty may be accepted as a measure of damages against an infringer who is a stranger to the license establishing it, it must be paid or secured before the infringement complained of; it must be paid by such a number of persons as to indicate a general acquiescence in its reasonableness by those who have occasion to use the invention, and

it must be uniform at the places where the licenses are issued. \*Rude v. Westcott, 48 O. G. 399, C. D. 1889.

82. An established license fee for the use of a patented article is sufficient to sustain a finding of damages to the amount of such fee. \*Timken v. Olin, 51 O. G. 1469, C. D. 1890.

83. The license fee is the proper measure of damages, and it is immaterial whether or not the patent is a foundation patent. \*Id.

84. In a suit at law a patentee cannot recover as damages the market value of the use of his invention, except in those cases where, by the mode of enjoyment of the monopoly, the patentee has himself established such market value by granting the use of the invention to the public for prescribed royalties or license fees. \*Royer v. Schultz Belting Co., 55 O. G. 1141, C. D. 1891.

### VIII. EXPENSES.

85. The master held to have properly refused to allow the defendant corporation, as an element of the "factory cost" of the article infringed, interest on its capital invested in the business. \*Am Ende v. Seabury & Johnson, 54 O. G. 1268, C. D. 1891.

86. The master held to have properly disallowed a certain sum for salary of the president of the defendant as an element of cost, it not being shown that the president was a salaried officer. \*Id.

87. The master properly found that the percentage for selling expenses, which should be added to the factory cost of all the goods sold by the defendant exclusive of certain goods named, was twenty-nine per cent. \*Id.

88. A lump sum claimed by defendant for "clerk hire, selling expenses, rent and insurance," resting altogether upon an arbitrary apportionment of the expenses connected with his general business, where no separate account was kept connected with the particular branch of the business employing the invention and affording no way of testing its accuracy, should not be allowed. \*Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

89. Where the infringer fails to show that the salary of the president of the infringing company was actually paid, *held*, that the salary was properly disallowed on the ground that to have allowed salaries which had never been paid would have been to permit a dividend of profits under the guise of salaries. \*Seabury v. Am Ende, 67 O. G. 401, C. D. 1894.

### IX. INTEREST ON.

90. Interest should be allowed upon the amount found due the plaintiff by this court from the date when the master's report was submitted to the court below. \*Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

91. Delay caused by the court or not attributable to the plaintiff in coming to a conclusion on a master's report where the amount of damages found by that report is confirmed ought not to deprive the plaintiff of interest on the amount found by the master. Under such circumstances the account ought to be considered as liquidated on the day when the master's report is filed. \*Crosby Steam Gage and Valve Co. v. Consolidated Safety Valve Co., 57 O. G. 1000, C. D. 1891.

92. Where the infringer's plant and real estate were used for other kinds of manufacture than the infringing article, and the evidence offered by the infringer to distinguish between the profits derived from the use of the plant and real estate for making the infringing thing and those attributable to the other sources of profit was not sufficient to enable the master to apportion the interest between the several kinds of business, *held*, that the infringer could not be allowed, as part of the cost of the infringing thing, interest on his plant and capital invested. \*Seabury v. Am Ende, 67 O. G. 401, C. D. 1894.

### X. MASTER'S REPORT.

93. The proceedings before a master have almost the same solemnity as a trial before a referee or a jury, and the familiar rule which precludes the court from setting aside a verdict which is not against the weight of evidence is to a great extent applicable. \*Welling v. La Bau, 43 O. G. 117, C. D. 1888.

94. In dealing with the exceptions to the master's report, his conclusions, depending upon the weighing of conflicting testimony, have every reasonable presumption in their favor, and are not to be modified or set aside unless there clearly appears to have been error or mistake on his part. \*Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

95. The master, having found that the complainant had failed to establish by trustworthy legal proof any basis for the computation of profits, stopped his investigations upon the ground that as the defendants had destroyed the complainant's standard there could be no

standard until the complainant voluntarily created one. \*Webster Loom Co. v. E. S. & N. D. Higgins, 48 O. G. 1119, C. D. 1889.

96. Report recommitted to master, with instructions to estimate the amount of profits in accordance with the rule stated in the opinion of Judge Wallace in a previous case. \*Id.

97. The master is the representative of the court and his findings are *prima facie* correct, and the burden of showing error on the party who excepts. "His findings are not to be set aside or modified unless there clearly appears to be error or mistake on his part." (Cases cited.) \*Keep v. Fuller, 42 Fed. Rep. 896 (1890).

98. Where, in an action to recover profits arising from the use of a patented solvent, the master in chancery found that defendant used the solvent for treating pyroxyline and during the same period treated it with other solvents, but, owing to a defect in the pyroxyline, its treatment with the various solvents resulted in a product which could not be sold at a profit, and that if defendant had not used the solvent in question it would have used others, and that, by reason of the patented solvent being cheaper, defendant saved a sum which complainant was entitled to recover as a profit. *Held*, that the conclusion of the master was correct. \*Celluloid Mfg. Co. v. Cellonite Mfg. Co., 50 O. G. 841, C. D. 1890.

99. The reason for the rule requiring objections to the findings of a master in chancery to be first made to him on the draft of his report does not fully obtain where the objection is to the principal finding of fact, as he probably would not have changed his conclusion; but it is no hardship to require of the dissatisfied party that he so state his objections, or be deemed to have waived them. \*Id.

100. Where the master is correct in his findings of fact, but errs as to conclusions of law, the rule requiring exceptions to his report is not applicable. \*Id.

101. A master's report that there was an established license fee for the use of a patented article is sufficient to sustain a finding of damages to the amount of such fee, though the evidence was oral and no license was introduced. \*Timken v. Olin, 51 O. G. 1469, C. D. 1890.

102. An exception that the master's report returned profits made by defendants, though profits were waived, is groundless where the master makes his finding on the measure of the license fee alone. \*Id.

103. Where in action for infringement the master in his report on the question of dam-

ages sustained by plaintiff did not specifically find as to the alleged superiority of a non-infringing loom over the one infringed, and it appeared that he did not intend to state his conclusions in regard to said non-infringing loom, although he might have thought that its superiority was proved, *held*, that the case should be recommitted to him in order for him to state his own conclusions from his patient study and accurate knowledge of the evidence, rather than that they should be spelled out from the answers to the defendant's requests. \*Webster Loom Co. v. Higgins, 54 O. G. 390, C. D. 1891.

104. The supreme court will not review a master's report upon objections first taken before it, the proper place for exceptions being in the court below. \*Topliff v. Topliff, 59 O. G. 1257, C. D. 1892.

105. When a master's report was based upon facts relating to an industry which has long ceased to be active, and when the time in which facts based upon the experience of actual manufacture can be ascertained has passed, it does not appear that anything will be gained by new testimony before a master upon the question of profits. \*Tuttle v. Claffin, 78 O. G. 1739, C. D. 1897.

## XI. NOMINAL.

106. However it may be as to articles wholly covered by a patent for which there is no, or no convenient, substitute, the sale of an article having a patented invention as an incidental part thereof only will not entitle the patentee to recover more than nominal damages, unless he shows what they are and furnishes a reliable basis for estimating them. \*Roemer v. Simon, 40 O. G. 1456, C. D. 1887.

107. Where complainants have failed to establish a royalty as measure of damages, and no evidence of the value of the invention to defendants is adduced, except the conjectural estimates of witnesses who had no practical knowledge of the subject, a decree for anything more than nominal damages cannot be sustained. \*Rude v. Westcott, 48 O. G. 399, C. D. 1889.

108. Complainants, after contending for and accepting a finding in an action for the infringement of the earlier patent that defendants' profits arising from the manufacture and sale of valves infringing both patents were due solely to the earlier invention, cannot be permitted to recover more than nominal damages in an action for the infringement of the later